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Datasheet for the decision of 2 December 2025

Case Number: T 1638/23 - 3.2.05

Application Number: 19165778.2

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Language of the proceedings: EN

Title of invention:
Polyacrylic acid (salt)-based water absorbent resin powder

Patent Proprietor:
Nippon Shokubai Co., Ltd.

Opponent:
Stockhausen Superabsorber GmbH

Relevant legal provisions:
EPC Art. 100(c), 123(2), 84, 83
EPC R. 139

Keyword:
Grounds for opposition - added subject-matter - Main Request (yes)
Correction of error - immediately evident that nothing else could have been intended (no)
Amendments - added subject-matter - Auxiliary Request 1 (yes)
Claims - clarity - Auxiliary Request 2 (yes)
Sufficiency of disclosure - Auxiliary Request 2 (yes)

Decisions cited:
G 0003/89, G 0011/91, G 0001/10, G 0003/14

Europäisches Patentamt
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Beschwerdekammern

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Case Number: T 1638/23 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 2 December 2025

Appellant: (Patent Proprietor)	Nippon Shokubai Co., Ltd. 1-1, Koraibashi 4-chome Chuo-ku Osaka-shi, Osaka 541-0043 (JP)
Representative:	Hoffmann Eitle Patent- und Rechtsanwälte PartmbB Arabellastraße 30 81925 München (DE)
Respondent: (Opponent)	Stockhausen Superabsorber GmbH Alte Untergath 10 47805 Krefeld (DE)
Representative:	Office Freylinger P.O. Box 48 8001 Strassen (LU)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 3 July 2023 revoking European patent No. 3520978 pursuant to Article 101(2) and Article 101(3)(b) EPC.**

Composition of the Board:

Chairman	P. Lanz
Members:	C. Kujat
	M. Blasi

Summary of Facts and Submissions

I. The appeal lies from the decision of the opposition division of the European Patent Office revoking European patent No. 3 520 978 (hereinafter: the patent).

II. Notice of opposition had been filed on the grounds under Article 100(b) and (c) EPC. In the decision under appeal, the opposition division came to the conclusion that the ground for opposition under Article 100(c) EPC prejudiced the maintenance of the patent as granted. Auxiliary Request 1 was not admitted by the opposition division. Claim 1 of Auxiliary Request 2 was found to contravene Article 83 EPC.

The opposition division inter alia relied on the following piece of evidence:

D14 Operation manual Ver.08 of the Quick Thermal Conductivity Meter QTM-500

III. In preparation for oral proceedings which had been appointed in view of corresponding requests, the board issued a communication pursuant to Article 15(1) RPBA dated 1 August 2025 setting out its provisional opinion on the relevant issues. Oral proceedings were held in the presence of both parties on 2 December 2025.

IV. The appellant (patent proprietor) requested that the decision under appeal be set aside and that the opposition be rejected, i.e. that the patent be maintained as granted (Main Request), or that the decision under appeal be set aside and the patent be maintained as amended on the basis of the claims of one

of Auxiliary Requests 1 or 2 submitted to the opposition division, or Auxiliary Request 3 filed with the letter of 3 March 2025

The respondent (opponent) requested that the appeal be dismissed.

V. Claim versions

Claim 1 of the Main Request (patent as granted) reads as follows:

"A water absorbent resin powder comprising a polyacrylic acid (salt)-based water absorbent resin as a main component, the water absorbent resin powder satisfying (B):
(B) the water absorbent resin powder having a saline flow conductivity (SFC) of not less than 10 [$x10^{-7}$ $*cm^3$ $*s*g^{-1}$], as measured in accordance with the SFC test method described in the description;
characterized in that the water absorbent resin powder satisfies (A) and (C):
(A) the water absorbent resin powder containing particles smaller than 150 μm in a ratio of 0 mass% to 4.5 mass% before an impact resistance test, and the water absorbent resin powder containing, in a ratio of 0 mass% to 4.5 mass%, particles smaller than 150 μm after the impact resistance test, as measured in accordance with method (i) as defined in the description; and
(C) the water absorbent resin powder having a thermal conductivity of not more than 125 [mW/(m*K)], as measured in accordance with method (ii) as defined in the description."

Claim 1 of Auxiliary Requests 1 and 2 differs from claim 1 of the Main Request by the following amendment (addition underlined by the board):

"...(A) the water absorbent resin powder containing particles smaller than 150 μm in a ratio of 0 mass% to 4.5 mass% before an impact resistance test, and the water absorbent resin powder containing, in a ratio of 0 mass% to 4.5 mass%, particles smaller than 150 μm after the impact resistance test and increased by the impact resistance test, as measured in accordance with method (i) as defined in the description..."

The description of Auxiliary Request 1 differs from that of the Main Request in that the value "3.3 mm" in paragraph [0216] is replaced with "33 mm".

VI. The parties' relevant arguments can be summarised as follows.

Main Request - Amendments

Appellant (patent proprietor)

Claim 1 of the Main Request contains an allowable amendment. The claim is based on claim 1 of the divisional application which corresponds to claim 12 of the parent application. The term "increased by the impact resistance test" in claim 1 as filed may be replaced by the term "after the impact resistance test" based on paragraph [0194] of the parent/divisional application as filed. The respondent's assertion that the teaching in this paragraph only applies to water absorbent resin obtained by a method of the present invention is wrong. As the impact resistance test necessarily increases the ratio of particles smaller

than 150 µm, the feature "increased by the impact resistance test" is implicit in the language of claim 1 and can be omitted. The deletion of the feature "increased by the impact resistance test" is permissible because it passes the essentiality test. As stated during the oral proceedings before the opposition division, it is most likely that the percentage of small particles will increase, that particles will be affected and break apart, and that the percentage might remain the same since the values are measured up to one significant figure.

Respondent (opponent)

Claim 1 of the Main Request contains an unallowable amendment. The replacement of the expression "increased by the impact resistance test" by "after the impact resistance test" in claim 1 constitutes added subject-matter which is not allowable as it extends beyond the content of the (earlier) application as filed. It is part of the common general knowledge that the superabsorbent polymer by its nature is elastic and thus, may not necessarily decay resulting in more particles with a size of less than 150 µm upon the damage test. The polymer may also be agglomerated during said test. The essentiality test may justify deletion of a feature, but not replacement with another feature.

Auxiliary Request 1 - Correction under Rule 139 EPC

Appellant (patent proprietor)

Paragraph [0216] of the patent may be corrected under Rule 139 EPC because it is immediately evident that an error has occurred and what the correction should be.

In that paragraph, there is an inconsistency between a height of the gauge and the volume, i.e. a gauge marked at a height of 3.3 mm corresponds to a volume of 10 ml rather than 100 ml. Omitting the decimal point in the height of the gauge is the most straightforward correction which removes the inconsistency and yields the correct volume. The volume of 100 ml must be correct, because it is also mentioned in paragraph [0217] of the patent and in table 15-3 of document D14 as minimum sample size. It is immaterial that multiplication of the values in paragraph [0216] of the patent leads to a volume of 99 ml instead of 100 ml, because there is an error margin as the gauge mark cannot be placed with a higher precision than ± 1 mm. It therefore does not make technical sense to indicate the height to the first digit after the decimal point, e.g. 33.3 mm. To account for the error margin, the result of the calculation (99 ml) is rounded to 100 ml. With regard to the Quick Thermal Conductivity Meter QTM-500 mentioned in paragraph [0215] of the patent, its probe size of 50 x 100 mm is indicated on page 9 of document D14. Page 64 of this document mentions a vessel for powder QTM-PA1, which must be the powder container according to paragraph [0216] of the patent. By looking at this container, the skilled person realises that the length and breadth indicated in paragraph [0216] of the patent are correct. In addition to that, the skilled person could confirm these values by further information found e.g. on the internet.

Respondent (opponent)

The correction of the error proposed by the appellant is not obvious, because it is not immediately clear that none of the other parameters which contribute to the dimension of the powder container are correct or

not. The new subject-matter, i.e. 33 mm, is not directly and unambiguously disclosed which is in contrast to Article 123(2) EPC. Even if the gauge was marked at a height of 33 mm and the length and the breadth of the container would remain unamended, i.e., 30 mm and 100 mm, respectively, this only leads to a computed volume of 99 ml. In Table 15-3 of the manual D14, the powder container is shown without any dimension. Even the minimum sample size according to Table 15-3 of document D14 of 100 mm x 50 mm x 30 mm does not directly and unambiguously discloses a gauge at a height of 33 mm. For these reasons, omitting the decimal point in 3.3 mm is not a correction in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction as stipulated by Rule 139 EPC. During the oral proceedings before the board, the respondent concurred with the board's preliminary opinion expressed in the communication pursuant to Article 15(1) RPBA.

Auxiliary Request 2 - Clarity

Appellant (patent proprietor)

Claim 1 of Auxiliary Request 2 is clear. The term "increased by the impact resistance test" does not require that the ratio of particles smaller than 150 µm is increased by 0.1 mass% or more. It is sufficient if there is a (detectable) increase. For example, the ratio may be 0.01 mass% before and 0.04 mass% after the test (both rounded to 0 mass%). Likewise, the ratio may be 4.45 mass% before and 4.54 mass% after the test (both rounded to 4.5 mass%).

Respondent (opponent)

The feature "increased by the impact resistance test" in claim 1 of Auxiliary Request 2 is unclear. The opposition division did not consider the scenario in which the ratio of the particles before and after the test would decrease or remain constant and the consequences thereof. If the ratio of the particles decreased from 0.04 mass% prior to the test to 0.01 mass% after the test, this would be - due to the rounding-off convention and the definition in the claim - covered by the claimed scope. However, the detectable ratio reduction, which is according to the wording of claim 1 an increase, results in an inconsistency which does not comply with Article 84 EPC. This argument also applies when the ratio remains unchanged.

Auxiliary Request 2 - Sufficiency of disclosure

Appellant (patent proprietor)

The sufficiency objections against the impact resistance test and against the method for measuring thermal conductivity in claim 1 of Auxiliary Request 2 concern a method for measuring a parameter of the product, and not the product as such. These objections do not arise under Article 83 EPC, because the definition of the "forbidden area of the claim" is a matter of clarity. It is therefore necessary to show that this potential lack of clarity affects the patent as a whole, and that it is such that the skilled person is hindered from carrying out the invention. It has not been disputed by the respondent that the examples in the patent, see Examples 15 to 19 and Tables 7 to 9,

can be reproduced, and thus, the skilled person is not hindered from carrying out the claimed invention.

Respondent (opponent)

The impact resistance test and the thermal conductivity in claim 1 of Auxiliary Request 2 do not meet the requirements of Article 83 EPC. In the respondent's view, the A-29 mayonnaise bottle required for the impact resistance test according to feature (A) of claim 1 was not available, and the solid content of the resin powder, the calibration of the thermal conductivity meter and the increase in bulk specific gravity of the resin powder in the context of thermal conductivity according to feature (C) of claim 1 were not sufficiently disclosed. In the letter of 3 May 2024, the respondent disputed that the examples in the patent satisfy the parameter of claim 1. Asked by the board during the oral proceedings, the respondent did not dispute that the examples in the patent can be carried out. The respondent argued that the claims only contain information about some properties of the resin, so the skilled person must know what to do in order to ascertain whether a product falls under the scope of these claims, which was regarded an issue of sufficiency. The respondent also put forward that the examples in the patent must be reworked in order to find out which glass container must be used in the impact resistance test. With regard to the thermal conductivity measurement in condition (C) of claim 1 of Auxiliary Request 2, the determination of the solid content, the calibration of the device used to measure the thermal conductivity and also how the bulk specific gravity is increased by 10 ± 2 % are not disclosed in a manner sufficient and clear to be carried out by the skilled person.

Reasons for the Decision

1. *Main Request - Amendments - Article 100(c) EPC*

The appellant disputes the opposition division's finding that there is added subject-matter in granted claim 1, see paragraphs 2 to 9 of the impugned decision.

1.1 During the oral proceedings before the board, both parties refrained from further comments and referred to their written submissions. The statement of grounds of appeal of 9 November 2023, the appellant's letters of 10 April 2024, 29 May 2024, 17 July 2024 and 3 March 2025, as well as the respondent's submissions of 11 March 2024, 3 May 2024 and 18 June 2024 had been received before the board issued its communication pursuant to Article 15(1) RPBA on 1 August 2025, and thus, were considered by the board in its communication. In this communication, the board was of the preliminary opinion that the subject-matter of claim 1 of the Main Request extended both beyond the content of the earlier application as filed and the application as filed. The board presented the following preliminary view (see paragraphs 6.1 to 6.3 of the communication):

"6.1 Claim 1 of the Main Request is based on claim 1 of the application as filed or claim 12 of the earlier application as filed. In particular, the feature "the water absorbent resin powder containing, in a ratio of 0 mass% to 4.5 mass%, particles smaller than 150 µm and increased by the impact resistance test" was replaced with the feature "the water absorbent resin powder

containing, in a ratio of 0 mass% to 4.5 mass%, particles smaller than 150 µm after the impact resistance test" (emphasis added by the board). The appellant refers to paragraph [0194] of the application as filed as a basis for the amendment and argues that the impact resistance test necessarily increases the ratio of these particles, and thus, the feature directed to that increase is implicit in the language of claim 1.

6.2 The board is not convinced of this alleged implicit limitation, since claim 1 is directed to identical numerical ranges of from 0 to 4.5 mass% (or 4.54 mass% in view of the appellant's argumentation about rounding-off, see paragraph 4 on page 6 of its statement of grounds of appeal) before and after the impact resistance test. Further, the appellant's reference to the essentiality test (which the board does not consider applicable in the present case due to the "gold standard" of a direct and unambiguous disclosure, see also decision G 2/10, OJ EPO 2012, 376, point 4.3 of the Reasons) seems to contradict the argument of an implicit limitation. Why does a deletion need to be justified by means of the essentiality test if the deleted feature is implicit? Furthermore, it appears that the appellant admits that the percentage of small particles is not always increased by the impact resistance test (page 2 of the letter of 10 April 2024, second full paragraph: "it is most likely that the percentage ... will increase"; page 3 of that reply, last paragraph: "the ratio of the fine particles does not necessarily have to be larger"). Therefore, the board has doubts that it is directly and unambiguously derivable that the deleted feature is implicit in the language of claim 1.

6.3 The board's preliminary conclusion on non-allowability of the amendments in the Main Request is not based on the respondent's argument that a 10g sample might not be representative for the resin after the impact resistance test, or on the appellant's argument that the feature directed to condition (B) in claim 1 refers to the ratio of the particles and not to individual particles, or the appellant's reference to the essentiality test. The contested admission of these arguments into the appeal proceedings therefore at present does not need to be addressed."

1.2 The board has reconsidered all the legal and factual aspects of the case. In particular, the board does not consider paragraph [0194] of the application as filed as a potential basis for the amendment. Said paragraph reads:

"(4-8) Ratio of particles smaller than 150 μm after impact resistance test
In order to improve a heat retaining property, handleability in fabricating disposable diapers, and liquid permeability, the water absorbent resin powder obtainable by the present invention after an impact resistance test contains particles smaller than 150 μm preferably in a ratio of 0 mass% to 4.5 mass%, more preferably in a ratio of 0 mass% to 4.0 mass%, still more preferably in a ratio of 0 mass% to 3.5 mass%, particularly preferably in a ratio of 0 mass% to 3.0 mass%, and most preferably in a ratio of 0 mass% to 2.5 mass%."

In the absence of an explicit reference to a method in paragraph [0194], the board concurs with the appellant that this paragraph does not exclusively apply to water absorbent resin obtained by a method of the present

invention. However, the paragraph is directed to water absorbent resin powder "obtainable by the present invention". This reference establishes a link between said paragraph and the invention defined in claim 1 of the application as filed. This is confirmed by paragraph [0023] of the application as filed, which also contains a definition of the invention, see the last sentence in the preceding paragraph [0022] of the application as filed (*"That is, the present invention encompasses the following inventions:"*). As both claim 1 of the application as filed and paragraph [0023] of the application as filed contain the expression "increased by the impact resistance test", the reference to the present invention in paragraph [0194] of the application as filed effectively incorporates this expression into the paragraph. As a consequence, paragraph [0194] of the application cannot justify the deletion of the expression "increased by the impact resistance test".

1.3 The board therefore concludes that the subject-matter of claim 1 of the Main Request extends both beyond the content of the earlier application as filed and the application as filed.

2. *Auxiliary Request 1 - Correction of paragraph [0216] - Rule 139 EPC*

The appellant requested a correction of the description under Rule 139 EPC, thereby replacing the value 3.3 mm in paragraph [0216] of the patent with 33 mm. It is common ground that these values refer to the height of the gauge mark in the powder container for the thermal conductivity measurement.

2.1 According to Rule 139 EPC, linguistic errors, errors of transcription and mistakes in any document filed with the European Patent Office may be corrected on request. However, if the request for such correction concerns the description, claims or drawings, the correction must be obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction.

2.2 The board notes that the passage which should be corrected under Rule 139 EPC was already incorrect in the application as filed (paragraph [0238]) and in the text on which the patent was granted. It appears that correction under Rule 139 EPC of the patent as granted could not be requested (see G 1/10, OJ EPO 2013, 194, Reasons 9 to 11). However, Auxiliary request 1 comprises not only a corrected text of the description but also an amendment to claim 1. In the appellant's favour, the board accepted that Rule 139 EPC can be applied in the circumstances of the current case and, furthermore, considered Auxiliary request 1 as an amendment within the meaning of Article 123(2) EPC (see also G 1/10, supra, Reasons 13).

2.3 The board concurs with the appellant in that the dimensions of the powder container and its volume according to paragraph [0216] of the patent do not match. These dimensions, i.e. a length of 30 mm, a breadth of 100 mm and a gauge at 3.3 mm, translate into a powder volume of 30*100*3.3 = 9.900 mm^3. This is an order of magnitude lower than the volume of 100 mL (which equals 100.000 mm^3) also indicated in said paragraph. In view of this difference, the board accepts that paragraph [0216] of the patent contains an error. However, the requested correction does not meet the requirements of Rule 139, second sentence, EPC as

it is not immediately evident what the correction of this error should be.

2.4 According to established jurisprudence, see Case Law of the Boards of Appeal ("CLBA"), 11th edition 2025, II.E.4.2.3 a), the threshold in Rule 139, second sentence, EPC, that nothing else would have been intended, implies that there is only one single plausible replacement – the one which the skilled person would have deduced from those parts of the application which made up the disclosure of the invention, i.e. the description, claims and drawings. In the present case, the above requirement is not met for two different reasons:

2.4.1 The board accepts that the volume of 100 mL in paragraph [0216] is correct, because the same volume is mentioned in paragraph [0217] of the patent in connection with a scale mark, which the board understands as the gauge mark according to paragraph [0216]. The volume of the powder in the powder container is calculated by multiplying the length, the breadth and the height of the gauge mark, i.e. the length of 30 mm, the breadth of 100 mm and the height of 3.3 mm according to paragraph [0216] of the patent. As the volume is a product of three factors, any of these factors could contain an error. This implies six options for correcting the mistake, i.e. three options for correcting only a single factor, two options for correcting two factors, and a further option for correcting all three factors of the product. In the present case, the length of 30 mm, the breadth of 100 mm and/or the height of the gauge mark of 3.3 mm in paragraph [0216] of the patent could therefore be corrected in six different ways. Contrary to the appellant's view, the board is not convinced that the

exclusive correction of the height of the gauge mark, i.e. the replacement of 3.3 mm with 33 mm by omitting the decimal point in the height of the gauge, is the only plausible replacement. As pointed out by the appellant during the oral proceedings before the board, a probe of the type PD-11 is used with the Quick Thermal Conductivity Meter QTM 500 mentioned in paragraph [0215] of the patent when thermal conductivity of an electrically non-conductive material such as the water absorbent resin powder according to the patent is measured. This is confirmed by the manual D14, see the second paragraph on page 8 (*"...by using PD-11 only one sample piece is required. Sensor PD-13 ... is used for sample of electrically conductive material."*). The PD-11 probe, however, has a probe face of 50 * 100 mm, and document D14 states that samples of the same size as the probe face or of smaller size can be measured, see the first paragraph on page 9 of the document. The bottom surface of the powder container obtainable from the values in paragraph [0216] of the patent is 30 * 100 mm, which is already smaller than the size of the probe face according to document D14. Therefore, it cannot be ruled out that the actual bottom surface of the powder container would be larger or smaller if any of the length of 30 mm or the breadth of 100 mm according to paragraph [0216] contained a further mistake. For example, a breadth of 100 mm in combination with a corrected length of 50 mm and a corrected gauge mark of 20 mm will also result in a powder volume of 100 mL. The correction proposed by the appellant therefore may not be considered the only plausible replacement.

2.4.2 This conclusion is not altered by the appellant's reference to document D14 and the QTM-PA1 powder vessel mentioned on page 64 of that document. According to

established jurisprudence, see CLBA, II.E.4.1 corrections under Rule 139, second sentence, EPC are special cases of an amendment within the meaning of Article 123 EPC and fall under the prohibition of extension laid down in Article 123(2) EPC, see opinion G 3/89, OJ EPO 1993, 117, and decision G 11/91, OJ EPO 1993, 125. While paragraph [0237] of the application as filed (which corresponds to paragraph [0215] of the patent) contains a reference to the Quick Thermal Conductivity Meter QTM 500, which is subject of the manual D14, there is no further information in the application as filed about the dimensions of the powder container of the QTM 500 device, and in particular not about the location of the gauge mark in that powder container. The board is therefore not convinced that the skilled person would derive the above correction directly and unambiguously from the application as filed.

2.4.3 The board is also not convinced that the mere mentioning of the Quick Thermal Conductivity Meter QTM 500 in paragraph [0237] and the statement "[a] powder container of the device..." in paragraph [0238] of the application as filed (corresponding to paragraphs [0215] and [0216] of the patent which were relied upon by the appellant during the oral proceedings before the board) constitutes a reference which could include further information about the QTM 500 device into the disclosure of the application. The reason is that such incorporation by reference is only possible for documents, see CLBA, II.E.4.2.1, but document D14 (or any other document) is not mentioned in that paragraph.

2.4.4 Nevertheless, and assuming arguendo that the reference in paragraph [0215] of the patent would incorporate further information about the QTM 500 device into the

application, even then the above correction cannot be derived directly and unambiguously. The board concurs with the appellant that page 64 of document D14 mentions a vessel for powder QTM-PA1, which then could be considered the powder container according to paragraph [0216] of the patent. However, document D14 is silent about the dimensions of the QTM-PA1 powder container. During the oral proceedings before the board, the appellant put forward that the skilled person, by looking at this container, would realise that the length and breadth indicated in paragraph [0216] of the patent are correct, or that the skilled person could confirm these values by searching further information e.g. on the internet. In the board's view, the subjective assessment of the container of D14 by the skilled person or a further piece of information found e.g. on the internet to supplement the information in document D14 speak against a direct and unambiguous disclosure of the length and breadth of the powder container of the QTM 500 device. Therefore, even the hypothetical incorporation by reference of the content of document D14 into the application as filed does not directly and unambiguously disclose the proposed correction.

2.5 Summarising the above, there are several plausible options for correcting the mistake, and the proposed correction cannot be deduced from those parts of the application which make up the disclosure of the invention. Thus, the request for correction does not meet the requirements of Rule 139 EPC. Furthermore, as the proposed correction is not directly and unambiguously derivable from the application as filed, Auxiliary Request 1 does not meet the requirements of Article 123(2) EPC either.

3. *Auxiliary Request 2 - Clarity - Article 84 EPC*

3.1 The respondent considers claim 1 of Auxiliary Request 2 unclear because the rounding-off convention implied that the ratio of the particles before and after the test could decrease or remain constant. As this would be covered by the claim, the feature "increased by the impact resistance test" in claim 1 of Auxiliary Request 2 results in an inconsistency which does not comply with Article 84 EPC.

3.2 During the oral proceedings before the board, both the appellant and the respondent referred to their written submissions. The parties' written submissions had been received before the board issued its communication pursuant to Article 15(1) RPBA, see above, and thus, were considered by the board in its communication. In this communication, the board was of the preliminary opinion that independent claim 1 of Auxiliary Request 2 is clear. The board presented the following preliminary view (see paragraph 7 of the communication):

"7. The board is of the preliminary view that the feature "(A) the water absorbent resin powder containing particles smaller than 150 µm in a ratio of 0 mass% to 4.5 mass% before an impact resistance test, and the water absorbent resin powder containing, in a ratio of 0 mass% to 4.5 mass%, particles smaller than 150 µm after the impact resistance test and increased by the impact resistance test" in independent claim 1 of Auxiliary Requests 1 and 2 is clear. In the board's view, the mandatory increase after the impact resistance test may be smaller than 0.1 mass%. In that case, it would be 'invisible' due to rounding up to one decimal place."

3.3 The board has reconsidered all the legal and factual aspects of the case. The board's preliminary view presented above is not altered by the respondent's argument that there is a scenario in which the ratio of the particles before and after the test would decrease or remain constant. The mandatory increase of the ratio of particles smaller than 150 µm excludes a decreasing or constant ratio, and thus, this scenario is not covered by the claim.

3.4 The board therefore concludes that the feature "increased by the impact resistance test" does not render claim 1 of Auxiliary Request 2 unclear.

4. *Auxiliary Request 2 - Sufficiency - Article 83 EPC*

The appellant disputes the opposition division's finding that the set of claims of Auxiliary Request 2 contravenes the requirements of Article 83 EPC, see paragraphs 12 to 16 of the impugned decision.

4.1 During the oral proceedings before the opposition division, the appellant argued that the impact resistance test in claim 1 of Auxiliary Request 2 is sufficiently disclosed at least by way of examples 15 to 19 of the patent. From that, the appellant concluded that the objection under Article 83 EPC was not applicable since an ambiguity in a claim could only result in such an objection if the invention could not be carried out at all over the whole scope of the claim, see the last section in paragraph 15 of the impugned decision. This is confirmed by the minutes of the oral proceedings before the opposition division, see the fourth paragraph on page 5. Further, during these oral proceedings, the respondent seems to have confirmed the appellant's view that the examples could

be carried out, see the statement *"O also argued that while the preparation of the resin is possible, the impact resistance test..."* in the second paragraph on page 6 of the minutes of the oral proceedings before the opposition division. This was summarised by the appellant in the statement of grounds of appeal, see the second paragraph on page 11: *"It has not been disputed by the opponent that the examples in the patent (cf. Examples 15 to 19 and Tables 7 to 9) can be reproduced. I.e., the skilled person is not hindered from carrying out the invention."*. During the oral proceedings before the board, the respondent did not maintain the view that the examples cannot be carried out.

The board therefore reaches the conclusion that the water absorbent resin powder according to claim 1 of Auxiliary Request 2 can be manufactured, at least according to examples 15 to 19 in paragraphs [0273] to [0285] of the patent.

4.2 During the oral proceedings before the board, the respondent argued that the claims of Auxiliary Request 2 only contain information about some properties of the resin, so the skilled person must know what to do in order to ascertain whether a product falls under the scope of these claims. Contrary to the respondent, the board does not regard this an issue of sufficiency, but of the "forbidden area" of a claim. In the board's view, the definition of the "forbidden area" of a claim should not be considered as a matter related to Article 83 EPC, but rather as a potential lack of clarity of the claim, see also CLBA, II.C.8.2.2a. Pursuant to the decision G 3/14 of the Enlarged Board of Appeal, in considering whether, for the purposes of Article 101(3) EPC, a patent as amended meets the

requirements of the EPC, the claims of the patent may be examined for compliance with the requirements of Article 84 EPC only when, and then only to the extent that the amendment introduces non-compliance with Article 84 EPC. In the present case, both feature (A) directed to the impact resistance test and feature (C) directed to the thermal conductivity of the water absorbent resin powder were already contained in granted claim 1, see the Main Request. A (potential) lack of clarity, i.e. a non-compliance with Article 84 EPC in the terms of the decision G 3/14, of the corresponding features in claim 1 of Auxiliary Request 2 may not be examined by the board, because it is not introduced by an amendment.

4.3 Apart from the objection against the A-29 mayonnaise bottle required for the impact resistance test according to feature (A), and the objections in the context of thermal conductivity according to feature (C) against the solid content of the resin powder, the calibration of the thermal conductivity meter and the increase in bulk specific gravity of the resin powder, the respondent did not raise any further objection against Auxiliary Request 2 concerning the issue of sufficiency of disclosure. In the absence of such objections, the respondent has not convinced the board that Auxiliary Request 2 does not meet the requirements of Article 83 EPC.

5. The board concludes that the impugned decision was right to hold that the ground for opposition under Article 100(c) EPC is prejudicial to the maintenance of the patent in its granted form, and that the correction of the error in paragraph [0216] of the patent according to Auxiliary request 1 does not meet the requirements of Rule 139 EPC. The board adds that this

request does not meet the requirements of Article 123(2) EPC either. The board also concludes that claim 1 of Auxiliary Request 2 is clear within the meaning of Article 84 EPC, and that the patent discloses the invention defined in claim 1 of Auxiliary Request 2 in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art within the meaning of Article 83 EPC.

Therefore, the patent can be maintained as amended in the form of Auxiliary Request 2 pursuant to Article 101(3)(a) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the opposition division with the order to maintain the patent as amended with the following documents:
   - claims 1 to 7 of Auxiliary Request 2 filed on 23 March 2023
   - description: paragraphs [0001] to [0292] of the patent specification
   - drawings: sheets 1/6 to 6/6 of the patent specification.

The Registrar: The Chairman:

N. Schneider P. Lanz

Decision electronically authenticated