

Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen
(D) No distribution

D E C I S I O N
of 3 May 2004

Case Number: T 0448/01 - 3.2.6

Application Number: 95913950.2

Publication Number: 0748199

IPC: A61F 13/15

Language of the proceedings: EN

Title of invention:
An absorbent article

Patentee:
SCA Hygiene Products AB

Opponent:
The Procter & Gamble Company

Headword:
-

Relevant legal provisions:
EPC Art. 54(2), 111(1)

Keyword:
"Novelty (yes)"
"Remittal (yes)"

Decisions cited:
T 0383/87

Catchword:
-

Case Number: T 0448/01 - 3.2.6

D E C I S I O N
of the Technical Board of Appeal 3.2.6
of 3 May 2004

Appellant: SCA Hygiene Products AB
(Proprietor of the patent) S-405 03 Göteborg (SE)

Representative: Harrison, Michael Charles
Albihns GmbH
Bayerstrasse 83
D-80335 München (DE)

Respondent: The Procter & Gamble Company
(Opponent) One Procter & Gamble Plaza
Cincinnati
Ohio 45202 (US)

Representative: Samuels, Lucy Alice
GILL JENNINGS & EVERY
Broadgate House
7 Eldon Street
London EC2M 7LH (GB)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 23 February 2001
revoking European patent No. 0748199 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: P. Alting van Geusau
Members: G. Pricolo
R. T. Menapace

Summary of Facts and Submissions

- I. The appeal is from the decision of the Opposition Division posted on 23 February 2001 to revoke European patent No. 0 748 199, granted in respect of European patent application No. 95913950.2.

Claim 1 of the patent as granted reads as follows:

"An absorbent article having a front part (12), a rear part (14) and an intermediate crotch part (13), such as a diaper, an incontinence guard or like article, which includes an absorbent body (1), a liquid-impermeable bottom sheet (7) joined to the absorbent body, and a top sheet (9) which is free from connection with the absorbent body over a large part of its surface and which lies proximal to the wearer's body when the article is worn, and which top sheet includes an opening (15) which extends from the rear article part into the crotch part, and elastic devices (24, 25) which are fastened to the top sheet in a stretched state and which when contracting from said stretched state cause the part of the top sheet that is not joined to the absorbent body to be distanced from said body, characterized in that the top sheet (9) includes a further opening (16) which extends from the front part (12) into the crotch part (13); and in that a piece (26) of flexible material extends transversely across the article between the absorbent body (1) and the top sheet (9) within that region (17) of the top sheet that lies between the two openings (15, 16), said piece of flexible material being fastened to the absorbent body and to the top sheet."

II. In the decision under appeal the Opposition Division considered that the subject-matter of claim 1 of the patent as granted was disclosed by document

D1: BR-A-PI 9202817-9.

In respect of the written disclosure of D1, the Opposition Division referred to the English translation D1a filed by the opponent of document D1, and considered that the structure formed by the lateral flaps 100 was equivalent to a "top sheet" and that the term "opening" in claim 1 of the patent in suit was a vague feature, "the pouches according to D1" being "evidently provided with an opening offering access in the same sense as intended by the wording of the contested patent". It added that in any case the article according to claim 1 would not involve an inventive step having regard to the teaching of D1 in combination with common general knowledge, because "the slight constructional differing features between the two solutions proposed, if recognized, would appear to be merely design options which lie within the usual capacities of the skilled engineer".

Finally, the Opposition Division disregarded the late filed auxiliary requests I and II of the patentee pursuant to "Article 71a(1) and (2), Article 114(2) and Rule 57a EPC".

III. The appellant (patentee) lodged an appeal against this decision, received at the EPO on 18 April 2001, and simultaneously paid the appeal fee. The statement setting out the grounds of appeal was received at the EPO on 13 June 2001.

IV. In an annex to the summons for oral proceedings pursuant to Article 11(1) Rules of Procedure of the boards of appeal the Board expressed its preliminary opinion that it would appear that the flaps 100 connected by the transverse element 120 could not be considered to form a top sheet as meant in claim 1 of the patent in suit.

V. Oral proceedings, at the end of which the decision of the Board was announced, took place on 3 May 2004.

The appellant (patentee) requested that the decision under appeal be set aside and that the patent be maintained as granted or on the basis of the first or second auxiliary requests filed during the present oral proceedings, or, if the subject-matter of claim 1 were found novel, that the case be remitted to the first instance for the examination of inventive step.

The respondent (opponent) requested that the appeal be dismissed and that the appellant's request for remittal to the first instance be rejected.

VI. In support of its requests the appellant relied essentially on the following submissions:

A sheet could be regarded as provided with an opening only if the opening was surrounded with material of the sheet itself. In other words, such an opening was a hole in the sheet. D1 disclosed a diaper having an upper layer on top of which were provided two longitudinally extending and transversely spaced strips which formed two side flaps and which were connected by

a transverse elastic element. The side flaps together with the transverse elastic element thus formed a piece having the shape of an H. Since they were not surrounded by material, the open portions of the H could not be regarded as openings but rather as cut-outs. An objective of D1 was specifically to avoid the prior art constructions of diapers including top sheets with a hole: D1 described them as sophisticated and expensive. Moreover, D1 did not disclose that the transverse elastic element, which corresponded to the piece of flexible material of the article claimed in the patent in suit, was fastened to the absorbent body. Therefore, the subject-matter of claim 1 of the main request was novel.

Remittal of the case to the first instance was justified because the decision under appeal dealt in a very general manner with the issue of inventive step and did not take into account any specific features distinguishing the claimed subject-matter from the absorbent article of D1. Furthermore, inventive step was not discussed during the oral proceedings held before the Opposition Division.

VII. The respondent essentially argued as follows:

The lateral flaps 100 of D1 together with the flexible transverse element 120 formed two pouches 135 and 145 for receiving urine and faeces. Since claim 1 of the patent in suit did not require the top sheet to be formed from a unitary piece of material, the lateral flaps together with the transverse element formed a top sheet having, in correspondence with the pouches, a front opening and a rear opening as defined in claim 1.

Furthermore, D1 disclosed in the embodiment of Figures 11 and 12 that the flexible transverse element was fastened to the top sheet and to an upper layer 60 placed on top of the absorbent body 70. This construction corresponded to that shown in Figure 5 of the patent in suit, where the piece of flexible material 26 was attached to the top sheet 9 and to an upper layer 8 provided on top of the absorbent body 5. Thus, the requirement of claim 1 of the patent in suit that the piece of flexible material be fastened to the absorbent body could not be regarded as implying a direct connection between the piece of flexible material and the absorbent body. Therefore, D1 disclosed an absorbent article having all the features of claim 1 of the patent in suit.

Remittal of the case to the first instance was not justified because the appealed decision already dealt in a brief but sufficient manner with the question of inventive step. The fact that no specific feature distinguishing the subject-matter of claim 1 from the absorbent article of D1 was identified by the Opposition Division did not justify a remittal, because it was quite common for the boards of appeal to discuss inventive step on the basis of a delimitation of the claimed subject-matter over the prior art different to that made by the first instance, without a remittal being necessary for this reason. Furthermore, the public interest called for not further delaying a final decision in respect of the patent in suit which dated back about 10 years. The respondent acknowledged that there was no discussion about inventive step during the oral proceedings held before the Opposition Division.

Reasons for the Decision

1. The appeal is admissible.
2. *Novelty*
 - 2.1 Since it has not been contested that D1a is an accurate English translation of the original Brazilian patent publication D1, reference is made to the passages in the text of D1a in the following assessment of the disclosure of D1.
 - 2.2 Using the wording of claim 1 of the patent in suit, D1 discloses, in the embodiments of Figures 1 to 7 which have been relied upon by the Opposition Division (see page 4 of the decision under appeal), a diaper having a front part (23), a rear part (21) and an intermediate crotch part (22) which includes an absorbent body (70), a liquid-impermeable bottom sheet (80) joined to the absorbent body, a top sheet (60, called "upper layer" in D1a) which is free from connection with the absorbent body over a large part of its surface and which lies proximal to the wearer's body when the article is worn (see page 9 of D1a), elastic devices (90) which are fastened to the top sheet (60) in a stretched state and which when contracting from said stretched state cause the part of the top sheet that is not joined to the absorbent body to be distanced from said body (see D1a, page 11, 4th paragraph), and a piece (120, called "transverse elastic element" in D1a) of flexible material extending transversely across the article between the absorbent body (70) and the top sheet (60) within that region (17) of the top sheet

that lies between the two openings (15, 16), said piece of flexible material (120) being fastened to the top sheet (60; see D1a, page 11, 3rd paragraph).

As can be seen in Figures 1 and 4 of D1, the upper layer 60, which is e.g. a nonwoven voile of polypropylene (D1a, page 9, last paragraph), has no openings. Furthermore, in the embodiments under consideration, the transverse elastic element 120 is not fastened to the absorbent body. In fact, the transverse elastic element is not attached to the absorbent body in order to allow the former to rise with the upper layer 60 for creating the elevation 150 which is necessary for forming, when the diaper is in the arched form that it takes when the elastic components are contracted, two separate front and rear pouches 135 and 145 (see D1a, page 12, 3rd, 5th and 6th paragraphs) for receiving urine and faeces. These pouches cannot be regarded as openings in the top sheet.

Therefore, in the embodiments of Figures 1 to 7, D1 does not disclose the features of claim 1 of the patent in suit that the top sheet includes an opening which extends from the rear article part into the crotch part, that it includes a further opening which extends from the front part into the crotch part, and that the piece of flexible material is also fastened to the absorbent body.

- 2.3 The opposition division considered that the lateral flaps 100 of the diaper of D1 were equivalent to a top sheet because they were located on the upper surface of the absorbent article. The respondent additionally argued that the lateral flaps 100 together with the

transverse elastic element 120 formed the top sheet of the absorbent article.

In the Board's view, the lateral flaps 100, even in combination with the transverse elastic element, cannot be regarded as the top sheet of the diaper in the sense in which the term "top sheet" is normally understood in the art, i.e. essentially as the upper layer of the diaper which when in use contacts the wearer and is disposed in facing relation with the bottom sheet to sandwich the absorbent body between the top sheet and the bottom sheet. In fact, the lateral flaps 100 of the diaper of D1 correspond to the generally known "barrier flaps" or "containment flaps" disposed onto the top sheet of the prior art's diapers in order to avoid leakage on the diaper's sides.

Moreover, if it is considered that the lateral flaps 100 together with the transverse element 120 form a structure which represents a top sheet, then in the embodiments of Figures 1 to 7 also the upper layer 60 must be considered to form part of such top sheet structure for the following reason. The transverse element 120 is affixed to the upper layer 60 on the side (lower side; see page 10 of D1a, 3rd paragraph) opposite the side on which the lateral flaps 100 are disposed and is thus only indirectly connected to the lateral flaps 100 through the connection with the upper layer 60. Therefore, the combination of lateral flaps 100 and transverse element 120 requires the presence of the intermediate upper layer 60. However, such unitary structure forming a "top sheet" does not have openings.

Furthermore, the combination of lateral flaps 100 and transverse elastic element 120 in the embodiments of Figures 1 to 7 forms a structure being substantially H-shaped, the H having arms with a small width compared to their length (each flap 100 is formed by a strip, see D1a, page 10, penultimate paragraph). This particular structure cannot be regarded as a sheet having two openings. In fact, a structure of this form could generally be obtained by providing two substantially large and opposed cut-outs in a sheet, not two openings or holes, i.e. apertures surrounded by material of the sheet.

- 2.4 Finally, the respondent referred to the embodiment of Figures 11 and 12, which differs from the embodiments of Figures 1 to 7 in particular because the transverse elastic element 120 is provided above upper layer 60 rather than below, and because a nonwoven hydrophobic screen 122 is provided between the lateral flaps 100, the transverse elastic element 120, and the upper layer 60. However, also in this embodiment the structure comprising the lateral flaps 100 and the transverse elastic element 120, which in the respondent's view constitutes the top sheet, apart from not being a top sheet in the sense in which this term is normally understood in the art, is substantially H-shaped and thus for the reasons given above cannot be regarded as being a sheet having front and rear openings. Therefore, also in the embodiment of Figures 11 and 12 the element corresponding to the top sheet of the absorbent article of claim 1 of the patent in suit is the upper layer 60 which has no openings. Furthermore, it follows from this that the feature of claim 1 according to which a piece of flexible material extends between the

absorbent body and the top sheet is not present in the embodiment of Figures 11 and 12, because there is nothing between the absorbent body (70) and the top sheet (upper layer 60).

2.5 The other available documents do not disclose an absorbent article having all the features of claim 1 of the patent in suit. In fact, novelty has been contested only in respect of the prior art document D1.

2.6 For these reasons, the subject-matter of claim 1 of the patent as granted, in accordance with the appellant's main request, is found to be novel (Article 52(1), 54(2) EPC).

3. *Remittal to the first instance*

The Board takes note of the fact acknowledged by both parties that the question of inventive step was not discussed during the oral proceedings held before the Opposition Division. Pursuant to Article 116 EPC a party has a right to argue its case orally before the relevant department of the EPO (see e.g. T 383/87). When requesting remittal to the first instance the appellant indicated that it intended to exercise this right in respect of the ground of opposition of lack of inventive step. Under these circumstances, irrespective of whether the findings of the Opposition Division in the decision under appeal (point 6 of the decision) can be regarded as a formal decision in respect of inventive step, remittal to the first instance as requested by the patentee as appealing party is justified also in order to give to the patentee the opportunity of being heard orally in respect of

inventive step by two instances before a final decision, which may be against the patentee, is taken on that matter.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for continuation of the opposition proceedings.

The Registrar:

The Chairman:

M. Patin

P. Alting van Geusau