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D E C I S I O N
of 17 March 2005

Case Number: T 0141/03 - 3.2.6

Application Number: 94925814.9

Publication Number: 0714273

IPC: A61F 13/62

Language of the proceedings: EN

Title of invention:

Mechanical fastening tapes and method for their construction

Patentee:

KIMBERLY-CLARK WORLDWIDE, INC.

Opponent:

SCA Hygiene Products AB

Headword:

-

Relevant legal provisions:

EPC Art. 123(2), 54(2), 56

Keyword:

"Amendments - deleting all embodiments falling outside the scope of the product claims (no)"

"Novelty (yes)"

"Inventive step (yes)"

Decisions cited:

G 0009/91

Catchword:

-



Case Number: T 0141/03 - 3.2.6

D E C I S I O N
of the Technical Board of Appeal 3.2.6
of 17 March 2005

Appellant: SCA Hygiene Products AB
(Opponent) S-405 03 Göteborg (SE)

Representative: Allard, Susan Joyce
BOULT WADE TENNANT
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Respondent: KIMBERLY-CLARK WORLDWIDE, INC.
(Proprietor of the patent) 401 North Lake Street
Neenah, Wisconsin 54956 (US)

Representative: Davies, Christopher Robert
Frank B. Dehn & Co.,
European Patent Attorneys
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 2 December 2002
rejecting the opposition filed against European
patent No. 0714273 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: P. Alting van Geusau
Members: G. Pricolo
J. H. Van Moer

Summary of Facts and Submissions

I. The appeal is from the decision of the Opposition Division posted on 2 December 2002 to reject the opposition filed against claims Nos. 15 to 26 of European patent No. 0 714 273, granted in respect of European patent application No. 94925814.9.

In coming to its decision the Opposition Division considered that the evidence produced was not sufficient to prove that a diaper "Lotus Baby Ultra" allegedly identical to a sample E1 filed by the opponent was effectively produced and sold before the relevant date of the patent in suit. Furthermore, the Opposition Division held that that the subject-matter of claims 15 to 26 was novel and involved an inventive step over the relevant prior art represented in particular by document:

D1: EP-A-0 235 014.

II. The appellant (opponent) lodged an appeal against this decision, received at the EPO on 30 January 2003, and simultaneously paid the appeal fee. With the statement setting out the grounds of appeal, received at the EPO on 7 April 2003, the appellant filed further evidence in support of the alleged prior use of a "Lotus Baby Ultra" diaper in the form of an affidavit, identified as E7, of Mr Jean-Pierre Quéré.

III. 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 the views expressed by the Opposition

Division in the decision under appeal could be followed even if account was taken of the affidavit E7 filed by the appellant with the grounds of appeal.

IV. With letter dated 16 February 2005 in response to this summons, the appellant filed a further affidavit of Mr Jean-Pierre Quéré.

V. Oral proceedings took place on 17 March 2005.

The respondent (patentee) filed amended documents consisting of claims 1 to 25 replacing claims 1 to 26 of the patent as granted and a revised description, and requested that the patent be maintained with these documents together with the figures of the patent as granted.

The appellant requested that the decision under appeal be set aside and that the patent be revoked as far as claims 15 to 25 were concerned.

VI. Claim 15 reads as follows:

"A fastening tape (10) for use on a disposable absorbent garment (74), said fastening tape (10) having a width (W), a length (L), a first transverse edge (12) and a second transverse edge (14), said fastening tape (10) comprising: a first substrate (16) having a width (W'); an interlocking material (18) attached to said first substrate (16) and extending the entire width (W) of said fastening tape (10), characterized in that said interlocking material (18) is attached to said first substrate (16) by both adhesive and thermal bonds along less than its entire width (W") to form an unattached

edge and said first substrate (16) defines the width and length of said fastening tape (10)."

- VII. The appellant decided not to present any argument against the amended claims and only submitted objections in respect of the amendments made to the description. These can be summarized as follows:

According to the description of the patent in suit, the invention concerned in a first aspect a fastening tape, and, in a second aspect, a process for manufacturing a fastening tape. Since only the embodiment of Fig. 4B fell within the scope of product claims 15 to 25, all the other embodiments of a fastening tape should be deleted from the part of the description relating to the first aspect. Furthermore, there was no support in the application as filed for the introduction in the description of the statement that the fastening tape of Fig. 4A was made by the process of claim 1 and therefore this amendment contravened Article 123(2) EPC.

- VIII. In support of its request, the respondent submitted that the filing of the amended claims during the oral proceedings was justified by the appellant's submission of an affidavit of Mr Jean-Pierre Quéré about one month before the date of oral proceedings. Although the respondent denied that the evidence on file was sufficient to prove the alleged prior use of a diaper "Lotus Baby Ultra", the amendments provided a clear distinction between this diaper and the subject-matter of claim 15.

The description was amended such that it was clear that only the embodiment of Fig. 4B fell within the scope of

the product claims. As regards the introduction of the statement that the fastening tape of Fig. 4A was made by the process of claim 1, it did not contravene Article 123(2) EPC as this information was directly and unambiguously derivable from the application as filed.

Reasons for the Decision

1. The appeal is admissible.

2. *Amendments*

2.1 Claims 1 to 14 are identical to claims 1 to 14 of the patent as granted.

The combination of features of claim 15 finds its basis in the application as filed (see claims 32, 33, 39, 41 thereof). Compared to claim 15 as granted, claim 15 is restricted by the inclusion of the features of granted claim 23 according to which the interlocking material is attached to the first substrate by both adhesive and thermal bonds.

Claims 16 to 25 correspond to claims 16 to 22 and 24 to 26 of the patent as granted.

Accordingly, the amendments made to the claims do not give rise to objections under Article 123(2) or (3) EPC.

2.2 The description is amended by inclusion of the statement that the embodiment of the fastening tape of Fig. 4A is "made by the process of claim 1" (col. 3,

lines 37 to 39). Although this information is not explicitly disclosed in the application as filed, the features of the fastening tape of Fig. 4A are those that are obtained as a direct result of a manufacturing process carried out in accordance with the definition of claim 1 and therefore the above-mentioned information is, although implicitly, clearly and unambiguously derivable from the application as filed. Accordingly, its inclusion in the description does not contravene Article 123(2) EPC.

- 2.3 With the remaining amendments, consisting in particular in the introduction of statements according to which the embodiment of a fastening tape of Figs. 1 to 3 falls outside the scope of the patent in suit, the description is adapted to be consistent with the claims.

Contrary to the appellant's submissions, there is no necessity of further amending the description by deleting all the embodiments of a fastening tape that fall outside the scope of product claims 15 to 25. Since the description recites that the embodiment of Figs. 1 to 3 is "outside the scope of the claims, shown for illustrative purposes", it is clear for the skilled person that even if this embodiment is in the description, it is not covered by any of the claims. As regards the fastening tape of the embodiment of Fig. 4A, which does not comprise thermal bonds and thus falls outside the scope of claim 15, it is the result of a process according to claim 1 (see point 2.2 above) and therefore serves the purpose (Rule 27(e) EPC) of describing in detail at least one way of carrying out the invention underlying claim 1. Furthermore, the products directly obtained by the process of claim 1

fall within the scope of protection attached to the patent in suit (Article 64(2) EPC) and therefore the embodiment of Fig. 4A appropriately illustrates a product which, if produced by the claimed process, is protected by the patent in suit.

2.4 Accordingly, the description as amended complies with the requirements of the EPC.

3. *Novelty, inventive step*

3.1 In the present case it is appropriate to first discuss novelty and inventive step over the available prior art without considering the alleged prior use of a diaper "Lotus Baby Ultra".

3.2 Since none of the cited documents discloses a fastening tape for use on a disposable absorbent garment having all the features of claim 15, its subject-matter is found to be novel over the available prior art. In particular, none of the available documents discloses a fastening tape in which an interlocking material is attached to said first substrate by both adhesive and thermal bonds.

3.3 The latter feature has the technical effect of producing a system of attachment that possesses both good shear adhesion and good peel adhesion (see paragraph [0033] of the patent in suit) and thus contributes to the problem underlying the patent in suit of providing improved fastening tapes (see paragraph [0005]). Since in the cited documents there is neither a disclosure of using both adhesive and thermal bonds at the same time nor a hint that the

- attachment of an interlocking material to a substrate could be improved by applying both adhesive and thermal bonds, the solution according to claim 15 is not obvious to a person skilled in the art and therefore involves an inventive step (Article 56 EPC).
- 3.4 The subject-matter of dependent claims 16 to 25 concerns further embodiments of the fastening tape according to claim 15 and likewise is novel and involves inventive step.
- 3.5 Since also in the allegedly prior used diaper "Lotus Baby Ultra" the feature concerning the attachment of the interlocking material to the substrate by both adhesive and thermal bonds is absent, the above-mentioned conclusions in respect of novelty and inventive step are valid even if such diaper would form part of the state of the art in accordance with Article 54(2) EPC. The question of whether this is effectively the case can thus be left aside for the purposes of the present decision.
- 3.6 In fact, novelty and inventive step were no longer in dispute even over the alleged prior use.
4. Since the Board has neither obligation nor power to examine and decide on the maintenance of a European patent except to the extent to which it was opposed (see G 9/91), and claims 1 to 14 of the patent in suit were not opposed, the validity of these claims is not under discussion.
5. Therefore, claims 1 to 25 together with the description as filed during oral proceedings of 17 March 2005, and

the drawings of the patent as granted, form a suitable basis for maintenance of the patent in amended form.

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 with the order to maintain the patent on the basis of the following documents:

claims: 1 to 25 filed during oral proceedings of 17 March 2005;

description: columns 1 to 22 filed during oral proceedings of 17 March 2005;

drawings: figures 1 to 14 of the patent as granted.

The Registrar:

The Chairman:

M. Patin

P. Alting van Geusau