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D E C I S I O N
of 26 January 2006

Case Number: T 0976/03 - 3.2.06

Application Number: 95907265.3

Publication Number: 0737053

IPC: A61F 13/00

Language of the proceedings: EN

Title of invention:

Apertured film/nonwoven composite for personal care absorbent articles and the like

Patentee:

KIMBERLY-CLARK WORLDWIDE, INC.

Opponent:

The Procter & Gamble Company

Headword:

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Relevant legal provisions:

EPC Art. 100(c), 123(2), 112(1)(a)

Keyword:

"Extension of subject-matter - main and auxiliary requests I to III (yes)"

"Isolation of exemplified parameter value from the context of the exemple - not allowable"

"Late filed requests - auxiliary requests IV to VI - not admitted"

"Enlarged Board of appeal - referral (no)"

Decisions cited:

T 1104/04, T 0343/90, T 1004/01

Catchword:

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Case Number: T 0976/03 - 3.2.06

D E C I S I O N
of the Technical Board of Appeal 3.2.06
of 26 January 2006

Appellant: The Procter & Gamble Company
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
21 July 2003 concerning maintenance of European
patent No. 0737053 in amended form.

Composition of the Board:

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

Summary of Facts and Submissions

- I. The appeals are from the interlocutory decision of the Opposition Division posted on 21 July 2003 concerning the maintenance in amended form of European patent No. 0 737 053, granted in respect of European patent application No. 95 907 265.3.

Claim 1 of the patent as granted reads as follows:

"A body side liner (12) for personal care absorbent articles comprising: an apertured film layer (22) superimposed and in contact with a separation layer (26), said film layer (22) defining apertures (24) therein, said film layer having a percent open area of between 10 and 30 per cent, said separation layer (26) comprising a fibrous nonwoven web having a bulk of between about 0.76 and 3.8 millimetres, a basis weight of between about 17 and 85 grams per square meter and characterised in that said web has an average pore size of between about 100 and 400 μm , said apertured film layer (22) and said separation layer (26) when used as a body side liner for a personal care absorbent article yielding a penetration rate of 12 seconds or less and a rewet which does not exceed 0.1 grams."

- II. In the decision under appeal the Opposition Division considered that the subject-matter of claim 1 of the patent as granted extended beyond the content of the application as filed. The features of claim 1 concerning a penetration rate of 12 seconds or less and a rewet not exceeding 0.1 grams were disclosed in the application as filed only in combination with the feature that the web was either a bicomponent

separation layer or a bicomponent through-air bonded carded web. However, this feature was missing in claim 1 as granted. Claim 1 in accordance with the patentee's first auxiliary request included this feature and therefore met the requirements of Article 123(2) EPC. Since it also met the requirements of Article 83, 84, 54(2) and 56 EPC, the patent could be maintained on the basis thereof.

III. The patentee and the opponent each lodged an appeal, received at the EPO respectively on 29 and 5 September 2003, against this decision and simultaneously paid the appeal fee. The statements setting out the grounds of appeal were received at the EPO on 1 December 2003 and 25 November 2003, respectively.

IV. In a communication accompanying the summons for oral proceedings pursuant to Article 11(1) of the Rules of Procedure of the boards of appeal, the Board expressed a preliminary opinion according to which it appeared that the features according to the originally filed claim 1 introduced additional subject-matter over the content of the application as filed. The latter disclosed some examples of a body side liner having values of penetration rate and rewet within the claimed ranges. However, the claims were silent about the testing conditions for determining the penetration rate and rewet values which were specified in the examples. Furthermore, it appeared that there was no basis in the application as filed from which the claimed ranges could be derived.

V. With letter dated 23 December 2005, the appellant-patentee requested maintenance of the patent as granted

or, alternatively, on the basis of one of the three auxiliary requests filed therewith. Auxiliary requests I and III were based on new sets of claims whilst auxiliary request II corresponded to the patent in the form allowed by the Opposition Division.

VI. Oral proceedings took place on 26 January 2006.

The appellant-patentee requested that the decision under appeal be set aside and that the patent be maintained as granted, or alternatively on the basis of the claims according to one of the auxiliary requests I to III filed with letter dated 23 December 2005 and IV to VI filed during the oral proceedings. As a further auxiliary request, it requested referral of the following question to the Enlarged Board of Appeal:

"Is an original disclosure of a specific value for a parameter in an embodiment of the invention and original disclosure that is important for the invention that this parameter shall be low sufficient to fulfil the requirements of Article 123(2) EPC for claiming that the parameter does not exceed the specific value?";

in case the Board should come to the conclusion that the phrase: "said apertured film layer and said separation layer when used as a body side liner for a personal care absorbent article yielding a penetration rate of 12 seconds or less and a rewet which does not exceed 0.1 grams" in any of the claims of the requests infringed Article 123(2) EPC, which conclusion would be based on considerations being in contrast to the findings in decision T 1104/04, dated January 13, 2006.

The appellant-opponent requested that the decision under appeal be set aside and that the patent be revoked.

- VII. Important for this decision is that claim 1 of auxiliary requests I to III includes the following wording, which is also present in claim 1 as granted (main request):

"said apertured film layer (22) and said separation layer (26) when used as a body side liner for a personal care absorbent article yielding a penetration rate of 12 seconds or less and a rewet which does not exceed 0.1 grams".

This wording is amended in claim 1 of auxiliary requests IV to VI by deletion of the expression "when used as a body side liner for a personal care absorbent article", so as to read as follows:

"said apertured film layer (22) and said separation layer (26) yielding a penetration rate of 12 seconds or less and a rewet which does not exceed 0.1 grams".

- VIII. Insofar as they are relevant to the present decision, the submissions of the appellant-patentee in respect of its requests can be summarized as follows:

The features of claim 1 concerning a penetration rate of 12 seconds or less and a rewet not exceeding 0.1 grams were not a generalization of isolated values taken arbitrarily from the examples. On the contrary, good penetration rate and low rewet were important

features of the invention which were qualitatively disclosed in the general part ("Summary of the invention") of the description of the patent in suit, and quantitatively specified in the examples. In particular, example 1b specifically disclosed a penetration rate of 12 seconds and a rewet of 0.1 grams. In this respect, reference was made to decisions T 343/90 and T 1104/04, where it was allowed to generalise a specific value of an example to create a generic range therefrom. If the Board found that the inclusion of the above-mentioned features in claim 1 infringed Article 123(2) EPC, then it was justified to refer the question submitted in writing during oral proceedings to the Enlarged Board of Appeal, because such a finding of the Board would be in contrast to the findings in case T 1104/04. It was a fact that the application as filed disclosed different values of penetration rate and rewet for examples 1b and 2b in which the same samples were used. However, the skilled person would readily recognize that example 2b was erroneous. Thus, example 2b could be deleted from the specification of the patent in suit. Furthermore, the skilled person would recognize that the features concerning a penetration rate of 12 seconds or less and a rewet not exceeding 0.1 grams were not bound to any specific material. Indeed, he would consider the examples in their context in the remainder of the application as filed. In particular, the materials and forming processes referred to in the examples were only some among the several possibilities disclosed in the application as filed. It was therefore clear that they did not determine the effect of the corresponding embodiment to a significant degree. In particular, a penetration rate of 12 seconds or less and a rewet not

exceeding 0.1 grams could also be obtained by taking materials different than those specifically disclosed in connection with the examples.

Moreover, claim 1 was directed to a body side liner and could not be seen as restricted to a personal care absorbent article including a body side liner, even taking into account the fact that it included the wording "when used as a body side liner for a personal care absorbent article". This wording merely provided an indication of the intended use. It was a fact that in all the examples of the application as filed the values of penetration rate and rewet were measured when the body side liner was used in combination with the chassis of a sanitary napkin known under the appellation Kotex® Maxi Pad. This implied that a Kotex® Maxi Pad chassis had to be used as a reference support when carrying out the test procedure for measuring the penetration rate and rewet for a given body side liner, in order to see whether it fell under the scope of claim 1. However, this did not imply that there was no basis in the application as filed for claiming a body side liner independently on, i.e. not in combination with, a Kotex® Maxi Pad chassis.

IX. The appellant-opponent refuted these arguments and submitted that the values of penetration rate and rewet given in the examples of the application as filed could not be taken as a basis for the general definition of claim 1 of the patent in suit. A penetration rate of 12 seconds and a rewet of 0.1 grams were disclosed only in example 1b which referred to one specific embodiment of the alleged invention. These values, which defined the upper limits of the ranges for the penetration rate

and the rewet referred to in claim 1, could not be isolated from the other essential features, such as the materials constituting the body side liner and the provision of a Kotex® Maxi Pad chassis, of the specific embodiment according to example 1b. Accordingly, claim 1 of the patent as granted, which did not include all these essential features, introduced subject-matter extending beyond the content of the application as filed and therefore was not allowable. The auxiliary requests were not admissible because filed late during the appeal proceedings. Anyway, claim 1 according to all the auxiliary requests was not allowable under Article 123(2) EPC for the same reasons given in respect of claim 1 of the patent as granted.

Reasons for the Decision

1. The appeals are admissible.
2. *Objection under Article 100(c) (main request)*
 - 2.1 In the general description ("Summary of the Invention") of the application as filed it is disclosed (page 3, lines 30 to 35) that "*an important parameter of the present invention is that the fibrous nonwoven web separation layer be lofty in nature so as to allow the combination aperture film and separation layer to have good penetration rates for absorbed fluids and low rewet values so that the fluid, once absorbed, does not flow back to the surface of the product*". The importance of achieving low penetration rate and rewet values is further emphasized by the statement in the description of Example 3 (page 19, lines 12 to 15)

according to which "*improved penetration rates and rewet properties are achievable with the present invention when compared to conventional nonwoven covers and film covers alone*".

However, there is no mention in the application as filed of any preferred penetration rate and/or rewet values. In fact, the general teaching according to the disclosure of the application as filed consists in achieving an improvement of penetration rate and rewet by combining, in a body side liner, specific apertured film and separation layers, not however, in **achieving specific low values** of penetration rate and rewet.

- 2.2 In the examples (pages 16 to 20 of the application as filed), different samples of body side liners placed on top of but not glued to a Kotex® Maxi Pad chassis have been prepared and the values of penetration rate and rewet have been measured (Tables I to III) according to the test method described on pages 12 and 13 of the application as filed. Sample 1b of Example 1 consists of an apertured Sultex film (see page 6, lines 23 to 27) and a 41 gsm through-air bonded bicomponent spunbond web separation layer referred to as Bico SB, made from 3 denier polyethylene/polypropylene side-by-side fibres (page 16, lines 30 to 32). For this sample 1b, a penetration rate of 12 s and a rewet of 0.1 gms are indicated in Table I. For sample 2b of Example 2, which is identical to sample 1b of Example 1, different values are indicated in Table II, namely a penetration rate of 11.7 s and a rewet of 0.03 gsm. For the other samples of Example 2 in accordance with the invention (samples 2c, 2e, 2f, 2h, 2i) different combinations of materials are used (sample 2c is a Sultex film with a

27 gsm through air bonded carded web referred to as TABCW, sample 2e is a Mitsui film with the Bico SB separation layer, sample 2f is the Mitsui film with the TABCW separation layer, sample 2h is a AET film with the Bico SB separation layer, and sample 2i is the AET film with the TABCW separation layer), and different values of penetration rate and rewet are indicated for them in Table II. Among the samples of Example 3 only samples 3b and 3c are in accordance with the invention. Although they correspond to samples 2b and 2c of Example 2, different results of penetration rate and rewet are indicated in Table III. However, a different version of the Kotex® Maxi Pad chassis is used in Example 3, namely the European version (see page 19, line 22) rather than the U.S. version as in Examples 1 and 2 (page 16, line 26; page 18, line 4).

Therefore, it is clear from the examples that the values of penetration rate and rewet depend on the materials of which the components (apertured film layer and separation layer) of the body side liner are made, and on the support used (in particular on whether the U.S. or the European version of the Kotex® Maxi Pad is used).

2.3 Accordingly, having regard to both the general disclosure and the examples of the application as filed, the skilled person would come to the conclusion that the specific values of 12 s for the penetration rate and of 0.1 g for the rewet are closely associated with the features of sample 1b, namely a body side liner consisting of a combination Sultex apertured film and 41 gsm through-air bonded bicomponent spunbond web separation layer, and with the features of the test

procedures for determining the penetration rate and the rewet, in particular the feature concerning the use of a Kotex® Maxi Pad chassis (U.S. version). Consequently, the skilled person would consider that the specific values of 12 s for the penetration rate and of 0.1 g for the rewet cannot be detached from these features to form a basis for a generalized definition of claim 1 in which (in accordance with the undisputed reading of claim 1 made by the appellant-patentee's) said specific values are not associated to any particular apertured film and separation layer among the many possible selections allowed by the wording of claim 1 (which requires a film layer having a percent open area of between 10 and 30 per cent, and a separation layer comprising a fibrous nonwoven web having a bulk of between about 0.76 and 3.8 millimetres, a basis weight of between about 17 and 85 grams per square meter and an average pore size of between about 100 and 400 μm).

For this reason, the subject-matter of claim 1 extends beyond the content of the application as filed.

- 2.4 The Board notes that the specific values of 12 s for the penetration rate and of 0.1 g for the rewet in claim 1 are not associated either with any features of the test procedures for determining the penetration rate and the rewet. However, since the claim already falls for the above-mentioned reason, it is unnecessary to consider the argument submitted by the appellant-patentee in respect of this latter issue, namely that the claim must be interpreted on the basis of the description as including the features of the test procedures, in particular the use of a Kotex® Maxi Pad chassis.

2.5 The above discussion is based on the assumption that Example 1 effectively discloses, in connection with sample 1b, a penetration rate of 12 seconds and a rewet of 0.1 grams. However, as mentioned above (point 2.2), the application as filed discloses different values of penetration rate and rewet for the identical sample 2b of Example 2. In particular, sample 2b has a rewet of 0.03 g which is substantially different from the rewet of 0.1 g of sample 1b. The appellant-patentee submitted that the values given for sample 2b were erroneous and that this would be readily recognized by a skilled person. However, the Board cannot find any basis in the application as filed which would allow to objectively recognize for which of samples 1b and 2b erroneous values of penetration rate and rewet are indicated in the application as filed. This ambiguity in the values of penetration rate and rewet for identical samples implies that there is also no clear and unambiguous disclosure in the application as filed for the association of the values of penetration rate of 12 seconds and rewet of 0.1 grams with the specific apertured film and separation layers of sample 1b.

2.6 Therefore, the ground for opposition under Article 100(c) prejudices the maintenance of the European patent in the form as granted.

3. *The auxiliary requests I to III*

3.1 Since auxiliary request II corresponds to the patent in the form as maintained by the Opposition Division and the amendments to the claims according to the auxiliary requests I and III, which were filed sufficiently in

advance of the oral proceedings, were made in reaction to the objections raised by the Board in the communication accompanying the summons for oral proceedings, these requests are admitted in the present appeal proceedings.

- 3.2 Claim 1 according to all the auxiliary requests I to III includes the feature of claim 1 of the patent as granted according to which "said apertured film layer and said separation layer when used as a body side liner for a personal care absorbent article yielding a penetration rate of 12 seconds or less and a rewet which does not exceed 0.1 grams". Since, as explained above, the values of 12 s for the penetration rate and of 0.1 g for the rewet cannot be detached from the specific features of the examples to form a basis for a generalized definition in which said specific values are not associated to any particular apertured film and separation layer amongst the various possibilities falling within the scope of claim 1, as it is the case for claim 1 according to all the auxiliary request, the subject-matter of this claim extends beyond the content of the application as filed. Accordingly, the auxiliary requests do not meet the requirements of Article 123(2) EPC and are therefore not allowable.

4. *The auxiliary requests IV to VI*

In view of the fact that they were filed at a late stage during the oral proceedings and of the fact that they are not clearly allowable (the amendments made do not remove the cause of non-compliance with the requirements of Article 123(2) EPC since the feature concerning a penetration rate of 12 seconds or less and

a rewet which does not exceed 0.1 g is still present in claim 1 of all these requests), auxiliary requests IV to VI are not admitted in the appeal proceedings in application of Rule 10b of the Rules of procedure of the Boards of Appeal (OJ 3/2003).

5. *Referral of a question to the Enlarged Board of Appeal*

5.1 Although the wording of the question which the appellant-patentee's requested to refer to the Enlarged Board of Appeal pursuant to Article 112(1)(a) EPC is somewhat unclear, it is clear from the written text accompanying the question, in particular the reference to decision T 1104/04, and from the appellant-patentee's submissions during oral proceedings, that the question concerns the issue of whether it is allowable to generalise a specific value of an example to create a generic range therefrom.

However, the relevant issue in the present case is whether it is allowable **to isolate a specific value from the concrete context of an example** in which it is disclosed in combination with particular features to form a basis for a generalized limit in a claim without taking into consideration those particular features. Accordingly, since the relevant issue in the present case is not specific to the creation of a generic range in a claim on the basis of a specific value disclosed in an example, the question submitted by the appellant-patentee is irrelevant to the present decision.

5.2 Finally, the Board notes that the present decision is not in contrast with other decisions of the boards of appeal, in particular decision T 343/90 referred to by

the appellant-patentee. In decision T 343/90 (see point 2.2 of the reasons), the Board took the view that the values of viscosity taken from the examples could be isolated from the other data given in the examples **because they were not to be seen only in the context** of these other data. The factual situation in the present case is different, because the values of penetration rate of 12 s and of rewet of 0.1 g **can only be seen in the context** of the specific data of Example 1b. A similar situation arose for example in case T 1004/01 (see in particular point 3.4 of the reasons), where the Board took the view that a specific value of a parameter (peel strength) could not be detached from the exemplified products to form a basis for a generalized lower limit of the claimed parameter range.

As regards the decision T 1104/04 of 13 January 2006 referred to by the appellant-patentee, a written decision was not yet available when the decision in the present case was pronounced. However, it could be inferred from the appellant-patentee's submissions that the Board in that case allowed the value of a parameter disclosed in an example to be used as the lower limit of a range in the independent claim. However, as explained above, this is not the issue in question in the present case. Nor is the Board in the present case arguing that, as a general rule, the value of a parameter taken from the examples cannot be isolated from the other data given in the examples. In fact, this might be allowable under certain circumstances, such as those underlying decision T 343/90.

5.3 Therefore, the request to refer a question to the Enlarged Board of Appeal is refused.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:

M. Patin

P. Alting Van Geusau