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**Datasheet for the decision
of 24 April 2007**

Case Number: T 0575/05 - 3.2.06

Application Number: 97924282.3

Publication Number: 0910321

IPC: A61F 13/15

Language of the proceedings: EN

Title of invention:
Absorbent article

Patentee:
KAO CORPORATION

Opponent:
The Procter & Gamble Company

Headword:
-

Relevant legal provisions:
EPC Art. 100(b), 123(2)

Keyword:
"Main and third to fifth auxiliary requests not allowable,
Article 100(b) EPC"
"First auxiliary request - not admitted"
"Second auxiliary request - (request for referral of question
to Enlarged Board rejected)"

Decisions cited:
G 0001/93, T 0387/01, T 0611/02

Catchword:
-



Case Number: T 0575/05 - 3.2.06

D E C I S I O N
of the Technical Board of Appeal 3.2.06
of 24 April 2007

Appellant:
(Opponent)

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Respondent:
(Patent Proprietor)

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Decision under appeal:

Decision of the Opposition Division of the
European Patent Office posted 18 April 2005
rejecting the opposition filed against European
patent No. 0910321 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: P. Alting van Geusau
Members: M. Harrison
K. Garnett

Summary of Facts and Submissions

I. The opponent (appellant) filed an appeal against the opposition division's decision of 18 April 2005 rejecting the opposition against European patent EP-B-0 910 321 and requested that the decision under appeal be set aside and that the patent be revoked.

The appellant based its appeal *inter alia* on Article 100(b) EPC.

II. With its summons to oral proceedings, the Board informed the parties of its provisional opinion. In the matter of Article 100(b) EPC, the Board noted that the patent did not disclose a test method for measuring thickness of the absorbent sheet, which thickness was defined in claim 1 as being in the range of "0.3 mm to 5 mm", thus leaving the pressure used for measuring the thickness seemingly unspecified. The Board also noted that at least claim 1 covered absorbent sheets of compressible material.

III. In further support of its arguments under Article 100(b) EPC, the appellant filed the following document:

D11: "Standard Test Method for Thickness of Nonwoven Fabrics, ASTM Designation D 5729-97".

IV. The respondent (patent proprietor) requested dismissal of the appeal as a main request. As a first auxiliary request filed during the oral proceedings of 24 April 2007, the respondent requested maintenance of the patent in amended form. Alternatively, as a second auxiliary request, the respondent requested that the

question set out in its statement, also filed during the oral proceedings, be referred to the Enlarged Board of Appeal, or alternatively that the patent be maintained in an amended form based on one of the third to fifth auxiliary requests filed with its written submissions before the oral proceedings.

V. Claim 1 of the main request reads as follows:

"An absorbent article comprising a liquid-permeable outermost, skin-contacting top layer (10, 110), a liquid-impermeable back layer (20, 120) and a liquid-retentive absorbent member (30, 130), said absorbent member is folded to form an opposing pair of absorbent barrier cuffs (40, 140) which extend along longitudinal edge portions of the absorbent article, said liquid-retentive absorbent member (30, 130) is interposed between said top layer and said back layer, characterised in that said top layer (10, 110) is secured to said liquid-impermeable back layer (20, 120) and said absorbent member (30, 130) includes an absorbent sheet (31, 131) having a thickness of 0.3 mm to 5 mm, an entire surface of said absorbent sheet (31, 131) is overlaid with said top layer (10, 110), and said cuffs (40, 140) are formed by integrally folding said absorbent sheet (30, 130) and only said top layer (10, 110), with said back layer (20, 120) being oriented in an unfolded state."

VI. Claim 1 of the first auxiliary request is the same as that of the main request with the exception that the following addition has been inserted after the wording "thickness of 0.3 mm to 5 mm":

"measured according to EN ISO 5084 of 1996 by applying a pressure of $(1 \pm 0,01)$ kPa,".

- VII. The question formulated by the respondent, as its second auxiliary request, for referral to the Enlarged Board of Appeal, reads as follows:

"Are the principles of G1/93 only applicable to amendments made during the Examination Procedure or are they likewise applicable to amendments made during the Opposition or Appeal Procedures".

- VIII. Claim 1 of the third auxiliary request adds the following features (from granted claim 4) to the end of claim 1 as granted, namely:

"wherein the top layer (10, 110) is extended beyond a perimeter of the absorbent sheet (31, 131) of the barrier cuffs (40, 140), and is secured to the back layer (20, 120) at the perimeter of the absorbent sheet (31, 131)."

- IX. Claim 1 of the fourth auxiliary request adds the following features (from granted claim 10) to the end of claim 1 as granted, namely:

"wherein said barrier cuffs (40, 140) have a height of 1 to 30 mm, and elastic members (50, 150) are provided inside side edges of said barrier cuffs (40, 140) located along the longitudinal direction of said barrier cuffs such that said barrier cuffs are shrunk along the longitudinal direction of said barrier cuffs over a prescribed length."

X. Claim 1 of the fifth auxiliary request was identical to claim 1 of the main request.

XI. Regarding matters relevant to the decision, the appellant argued essentially as follows:

The parameter used in claim 1 of the main, first and third to fifth requests defined the thickness of the absorbent sheet simply as "0.3 mm to 5 mm". The requirements of Article 100(b) EPC were not met, since no test method was described in the patent indicating how to measure the sheet thickness. This was essential in this case for carrying out the invention, because the materials of the absorbent sheets exemplified in paragraph [0025] of the patent included highly compressible materials such as fluff pulp. Depending on the pressure applied, vastly differing thickness results would occur. There was no single method or commonly accepted method used in the technical field; instead there were many known methods including those in

D9: "DIN EN ISO 5084 Bestimmung der Dicke von Textilien und textilen Erzeugnissen, Oktober 1996",

D10: "ISO 9073-2, Textiles - Test methods for nonwovens - Part 2: Determination of thickness, Second edition 1995-03-15",

and in D11.

The patent did not indicate which test method was to be used and the test pressure applied varied greatly

between the test methods; D11 used a pressure of 4.14 kPa while D9 was unspecific, quoting a value merely of 1kPa or less ("1kPa oder weniger"). There were also many other test pressures commonly used in the technical field, each of which would give different results.

As regards the first auxiliary request, there was no basis in the filed application for the introduction of a particular test method. In fact, no test method was disclosed at all. The amendment was not immediately allowable under at least Article 123 EPC, and the request was late-filed. The request should therefore not be admitted.

As regards the second auxiliary request, the findings of G1/93 were not relevant to the present case. Also, even if the question were answered in the positive, this was not relevant to the outcome of the appeal as technically meaningful information was being added to the claim.

XII. The respondent's arguments relevant to the decision can be summarised essentially as follows:

EPO Case Law does not require a method of measuring a parameter to be defined in the claims or the description. The Guidelines C-III, 4.10a notes that one such case is where a particular method is commonly used. In the present case, no method is disclosed in the patent but in such a case the skilled person would know that the commonly used ISO standard in D9 should be applied. The ISO standard would indeed be the standard to be used, and not another standard such as

in D11, because the present case concerned a European patent and the appropriate European standard must therefore be used. The pressure in D9 was not unspecific, since although D9 stated a value of 1kPa or less, D9 at the same time recommended that the value 1 kPa be used (D9, Section 8.1); the test should be carried out simply as specified. This was all the skilled person needed. Also, the exact value of pressure to be used in D9 was not of great importance, since the pressure of 1 kPa was itself very low. The appellant had not shown that different pressures would provide results differing to any appreciable degree.

The thickness range was furthermore not only limited by a parameter, but was also described in terms of its intended function as explained in column 6, lines 17 to 29 of the published patent.

The appellant's objection related to clarity of the claim and to the alleged difficulty of judging whether or not a third party product would fall within the claim scope or not; this was simply a risk for the proprietor and not an Article 100(b) EPC matter.

The same arguments in this regard also applied equally to the third to fifth auxiliary requests.

Regarding the first auxiliary request, the introduced terminology defined the test method to be used and in so doing merely limited the technical parameter of the thickness range defined in the claim. The test method however did not itself provide any technical contribution to the claim. Decision G1/93 made clear that a feature which merely limited a claim but did not

provide a technical contribution thereto was allowable without contravening Article 123(2) EPC. It was irrelevant that G1/93 related to the text of a granted patent following an amendment made during examination, because no reason existed for treating the present limitation differently merely because appeal proceedings were involved. This was the only meaningful interpretation which could be given to the decision, because the decision did not exclude amendments made in opposition or appeal proceedings. The amendment introduced by way of the first auxiliary request was anyway within the content of the application as filed, by virtue of it relating to a European application to which European measurement standards must apply. Document D11 related to a non-European standard. The request should therefore be admitted into proceedings.

Regarding the question for the Enlarged Board as made in the second auxiliary request, this question met the requirements of Article 112 EPC because an important point of law had arisen which affected the outcome of the present case. If decided in the respondent's favour, this would show that the first auxiliary request should be admitted into proceedings.

Reasons for the Decision

1. Main request

Article 100(b) EPC

Claim 1 defines a thickness range of "0.3 mm to 5 mm", without any test method being stated regarding the way in which the thickness parameter is measured. The lack

of a disclosed method in the patent itself is undisputed.

Materials which may be used to form the absorbent sheet in claim 1, as specified for example in paragraph [0025] of the patent, include compressible materials. Fluff pulp sheets or certain other fibrous sheets, particularly those including high loft material, are well known to be highly compressible. The pressure used in any test method for measuring thickness of easily compressible products is thus of the utmost importance, because the thickness varies inversely with the pressure applied. Confirmation of this well known fact can for example be found in D11, item 5.3, which notes that "the thickness values of most nonwoven fabrics will vary considerably depending on the pressure applied to the specimen" and that "it is essential that the pressure be specified when discussing or listing any thickness value".

Furthermore, the invention as defined in claim 1 has a lower end point of thickness of 0.3 mm. Thus the lower limit of the thickness range concerns a very small thickness dimension, the measurement of which requires substantial measurement accuracy. If the pressure used in the measurement method is unknown, the skilled person is unable to determine whether an article is within the scope of claim 1 or not (see also e.g. T 387/01, item 2.2.1; T 611/02, item 3). Particularly at the lower end of the claimed range, this determination would be particularly problematic. Thus, while the Board acknowledges that some degree of measurement value variation will occur in all measurement methods and is to be included within the

measurement value, the complete lack of information as to what load is to be applied when measuring a compressible sheet leads to a degree of uncertainty which is entirely unacceptable for a skilled person trying to establish which sheets might fall within the claims.

The respondent has argued that the disclosure of a specific method is not needed, and has referred to the Guidelines for Examination C-III, 4.10a(ii). This section states that, "(t)he method of and means for measurement of the parameter values need not however be in the claims when: (ii) a person skilled in the art would know which method to employ, e.g. because there is only one method, or because a particular method is commonly used;". However, it should be noted first that the Guidelines in this section relate to what is required in the claims, and not to what is required in the specification as a whole to meet the requirements of Article 83 EPC. Even if it were accepted *arguendo* that the same requirements would apply equally to the description, the skilled person is still unable to know, due to the lack of guidance from the description, which method he should employ amongst the many commonly used methods available. D9 and D11, relating to standardised test procedures, are merely two examples of several recognised standard methods. Even between these two methods, a considerably different pressure is used, D9 using an undefined pressure of some value below 1kPa and D11 using approximately 4.14 kPa. Still further methods exist in this technical field, such as those using optical measurement in an uncompressed state or methods involving applying a pressure corresponding to that expected during use of the

product (such as adult or infant users of absorbent articles).

The respondent asserts that the ISO standard as stated in D9 would be used because the present case concerns a European patent and the ISO standard is a European standard. The Board however does not concur with the respondent. Firstly, the mere fact that a European patent is involved does not mean that a European standard was ever intended to be read into the disclosure, in particular because the industry, also the absorbent article industry in Europe, recognises a variety of different methods for such testing. Albeit of secondary importance, the fact that the applicant was a Japanese company and that it filed the application as a PCT application covering not only the designation "EP" but also "US", does not support the respondent's conclusion regarding the implicit disclosure of a European standard. Additionally, even if the ISO standard according to D9 were to be applied, this ISO standard itself states in item 3.1 that the thickness is to be measured with a pressure of 1kPa or less ("ein Druck von 1 kPa oder weniger"). This latter statement in D9 leaves the skilled person with a choice to make as to which pressure is to be used. Without guidance in the patent, the skilled person is unable to make such a determination.

In section 8.1 of D9, a recommended pressure of 1 ± 0.01 kPa is mentioned, but this is not a definitive value for the test method, as the standard states that any value below 1 kPa can be used and the test report ("Prüfbericht") in item 10d) specifically requires the applied pressure to be stated. Thus, the Board's

findings in this matter remain unchanged by the respondent's arguments. The Board also cannot agree with the respondent's further argument that no appreciable difference would result when applying pressures anywhere up to 1 kPa, since this is contrary to the common general knowledge that highly compressible materials in this technical field are compressed to a very high degree even at low pressures.

Additionally, it may be added that the materials to which the test of D9 applies are textiles and textile products, yet examples of the materials intended to be covered in the patent (see e.g. paragraph [0025]) include *inter alia* "absorbent paper" and "a sheet obtained by interposing superabsorbent polymer between paper or nonwoven fabric in an overlaid configuration", not falling within such a category. The ISO standard test of D9 was thus not intended for such materials.

Summarising, a skilled person cannot know, from the disclosure in the patent, which measurement method should be employed to establish the claimed thickness parameter, nor which measurement conditions might be used for any chosen method.

The burden on the skilled person in trying to carry out the invention as claimed based on the content of the patent as granted is therefore undue, since the skilled person is unable, with any reasonable degree of certainty, to know when an article would lie within the scope of the claim, since without the disclosure of a test method for its measurement, the defined parameter has no sufficiently defined technical meaning within the technical field concerned.

The respondent's further argument that Article 100(b) EPC was not at issue here, but instead that the appellant's arguments related merely to whether third party products could be shown to fall within the claim or not, does not convince the Board. Whilst it may be correct that the burden of proof is on a proprietor in certain circumstances to show that a product falls within the claims in an infringement proceedings and thus fulfils the thickness parameter feature of claim 1, this does not release the proprietor from its burden of providing sufficient disclosure in the patent itself to allow the skilled person to carry out the invention at least with reasonable certainty.

Lastly, the respondent's argument that the patent at column 6, lines 17 to 29 (paragraph [0022]) gives additional information for arriving at a material sheet within the claims by means of the intended function and which does not rely on parameters, does not assist the respondent's case further. This portion of the description merely explains that if the thickness is less than 0.3 mm, it is difficult to provide improved fitting and increased absorption capacity, and if it is greater than 5 mm the rigidity of the sheet would be increased such that the fitting is spoiled. This consequently does not add anything but entirely subjective and vague requirements for the sheet, which would be fulfilled both by more or less highly compressed sheets. There is also no indication of the way in which these subjective criteria could guide the skilled person in deciding which particular thickness test should be applied in order that the products would

or would not correspond to the thickness parameter requirements in claim 1.

The main request is thus not allowable with respect to Article 100(b) EPC.

2. First auxiliary request

This request was filed during the oral proceedings. The request is thus late-filed, in particular because the objection which the amendment serves to overcome was already made in the appellant's appeal grounds and was also mentioned in the Board of Appeal's annex to the summons. Thus, when deciding on whether or not to admit the request into proceedings, the Board must first decide whether such a late-filed request, in accordance with established case law of the Boards of Appeal, would appear to be immediately allowable. If such is not the case, the request should not be admitted.

In the present case, the requirements of Article 123(2) EPC are not met by the subject matter of claim 1 of this request.

The terminology concerning the test method which is introduced into claim 1 by way of this request, limits the thickness parameter to that measured by a specific method. The terminology thus appears to provide the thickness parameter with sufficient technical meaning for a skilled person to carry out the invention as claimed. The introduced terminology however has no explicit basis in the application as filed; neither the method nor the stated pressure are explicitly disclosed. The respondent has not disputed the lack of

an explicit disclosure but instead argued that the method to be used is, necessarily and implicitly, the European standard (as in D9) due to the fact that a "European" patent is under consideration. In the respondent's view, a disclosure of the introduced terminology is consequently to be understood as being implicitly within the content of the filed application. As already explained above in item 1 however, the mere fact that a European patent is being dealt with does not automatically provide a presumption that a European standardised measurement method should apply. Indeed, the Board concludes that a skilled person has no means of identifying, from the disclosure within the content of the filed application, which measurement method of those known is to be applied, nor which pressure should be used in any such method, as no method and no method conditions at all are disclosed and several different methods using different pressures (e.g. the methods of D10 and D11) are available. Thus, there is no unambiguous explicit or implicit basis in the application as filed for introduction of the specific method according to EN ISO 5084 of 1996.

Additionally, as also mentioned in item 1 above, the pressure to be used in the EN ISO 5084 test (D9) is stated as being 1kPa or less ("1kPa oder weniger"), thus allowing a range of pressures below 1kPa from which to select. The selection of the pressure 1 ± 0.01 kPa thus relates to a selection from the quoted method, for which selection there is also no unambiguous basis. The fact that a pressure of 1 ± 0.01 kPa is mentioned as being recommended does not mean that this pressure must be used, nor that it would even be implicitly suitable

for all material sheets (covered by claim 1) which are to be measured.

The respondent further argues that the requirements of Article 123(2) EPC are met because the amendment introduced is merely limiting for the scope of claim 1, but in itself provides no technical contribution to the claim and thus should be allowed in accordance with the findings as stated in G1/93 (see e.g. headnote, item 2).

Firstly, regarding the lack of technical contribution provided by the amendment, the Board is not convinced by the respondent's argument. The introduced terminology is the only terminology which gives sufficient technical meaning to the thickness parameter for a skilled person to carry out the invention as claimed. Thus it makes a technical contribution to the claimed subject matter. For this reason alone, G1/93 would not be applicable to the present case.

Secondly, nothing in decision G1/93 indicates that its findings should relate generally to cases where an introduced feature lacks a technical contribution and merely limits claim scope. Instead, G1/93 is specifically related to cases where a granted claim contains a feature which was not within the content of the filed application. This does not correspond to the facts of the present case which is instead concerned with amendments being made to a granted patent by the introduction of a feature that was not disclosed in the filed application.

Thus, the findings made in G1/93 cannot change the Board's conclusions on the matter of Article 123(2) EPC.

Since the subject matter of proposed claim 1 would therefore fail to meet at least the requirements of Article 123(2) EPC, the request is not admitted into proceedings for the reasons that it is late-filed and is not immediately allowable.

3. Second auxiliary request

The Board concludes that the conditions in Article 112(1) EPC for referring the question, posed in the respondent's second auxiliary request, to the Enlarged Board of Appeal, are not met for the following reasons:

One of two conditions must exist to justify the referral of a question to the Enlarged Board, these being stated in the opening paragraph of Article 112(1) EPC, namely "in order to ensure a uniform application of the law" or "if an important point of law arises".

As regards the first of these conditions, the respondent's formulated question itself does not need to be answered to ensure uniform application of the law. No contradictory decisions or the like have been cited which would support such an argument, nor can the Board see that any exist.

As regards the second of these conditions, no important point of law arises. Even if the respondent's proposed question were to be answered in the positive, this

would not assist the respondent's case as regards e.g. the first auxiliary request, because the Board has already concluded that a technical contribution is indeed provided by the introduced terminology. Further, the Board in any event sees no reason which could lead to an interpretation that the Enlarged Board of Appeal's findings in G1/93 should apply to cases in opposition appeal proceedings where the proprietor is seeking to introduce wording for which there is no basis within the content of the application as filed. Merely because the Enlarged Board of Appeal decision did not exclude this possibility is irrelevant; the Enlarged Board dealt with an entirely different situation. In the matter dealt with in G1/93, the Enlarged Board of Appeal was faced with a different set of legal circumstances, namely a situation where a feature which had not been within the content of the application as filed had already been introduced into a claim before grant and could not, after grant, simply be removed, due to the requirements of Article 123(3) EPC. The respondent's interpretation of G1/93 that it should in some way extend to cases such as the present one is thus without basis.

The request for referral of a question to the Enlarged Board is thus rejected.

4. Third to fifth auxiliary requests:

In response to the objection under Article 100(b) EPC, the respondent relied on the same arguments as presented with regard to the main request. The conclusions reached in respect of the main request thus apply equally to the claims of the third, fourth and

fifth auxiliary requests, since the thickness parameter "0.3 mm to 5 mm" is still present in all these requests.

It may be added that although further amendments to claim 1 have been introduced by way of the third and fourth auxiliary requests, those amendments do not serve to further define or limit the thickness parameter as defined in granted claim 1 and thus cannot affect the finding on Article 100(b) EPC.

The third to fifth auxiliary requests are therefore not allowable with respect to Article 100(b) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The request to refer a question to the Enlarged Board of Appeal is rejected.
3. The patent is revoked.

The Registrar:

The Chairman:

M. Patin

P. Alting van Geusau