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**Datasheet for the decision
of 5 April 2011**

Case Number: T 1414/08 - 3.3.06

Application Number: 97310473.0

Publication Number: 0851061

IPC: D21H 21/22

Language of the proceedings: EN

Title of invention:

Soft, bulky single-ply tissue paper and method for its
manufacture

Patentee:

Georgia-Pacific Consumer Operations LLC

Opponent:

KIMBERLY-CLARK WORLDWIDE, INC.

Headword:

Tissue paper/GEORGIA PACIFIC

Relevant legal provisions:

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Relevant legal provisions (EPC 1973):

EPC Art. 69, 83, 84

Keyword:

"Sufficiency of disclosure (yes) - ambiguity of end values of
a claimed range is a matter of definition under Art. 84 EPC"

Decisions cited:

G 0002/88, T 1886/06, T 0611/02

Catchword:

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Case Number: T 1414/08 - 3.3.06

D E C I S I O N
of the Technical Board of Appeal 3.3.06
of 5 April 2011

Appellant: Georgia-Pacific Consumer Operations LLC
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Respondent: KIMBERLY-CLARK WORLDWIDE, INC.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 25 June 2008
revoking European patent No. 0851061 pursuant
to Article 102(1) EPC 1973.

Composition of the Board:

Chairman: P.-P. Bracke
Members: G. Dischinger-Höppler
U. Tronser

Summary of Facts and Submissions

I. This appeal is from the decision of the Opposition Division to revoke the European patent No. 0 851 061 concerning a soft, bulky single-ply tissue paper and a method for its manufacture. Claim 1 as granted has the following wording:

"1. A soft, single ply-tissue product formed by conventional wet pressing of a cellulosic web, adhering said web to a Yankee dryer and creping the web from the Yankee dryer, said single-ply tissue including

- (a) a temporary wet strength agent comprising an organic moiety, and
- (b) nitrogenous softener agent,

and said single-ply tissue having a serpentine configuration, and low sidedness, a basic weight of at least 24.4 g/m^2 (15 lbs/3000 sq. ft.) ream, a specific total tensile strength of between 8.4 and 41.9 N/m per g/m^2 (between 40 and 200 grams per three inches per pound per 3000 square foot) ream, a cross direction specific wet tensile strength of between 0.576 and 4.2 N/m per g/m^2 (between 2.75 and 20 grams per three inches per pound per 3000 square foot) ream, the ratio of MD tensile to CD tensile of between 1.25 and 2.75, a specific geometric mean tensile stiffness of between 0.314 and 2.0 N/m/percent strain per g/m^2 (between 0.5 and 3.2 grams per inch per percent strain per pound per 3000 square foot) ream, a friction deviation of less than 0.25, and a sidedness parameter of less than 0.3."

Independent Claim 18 relates to a tissue product having the properties mentioned in Claim 1 which comprises hardwood, softwood, recycled and/or refined fiber and a specific amount of a selected temporary wet strength agent and a selected cationic nitrogenous softener/debonder. Independent Claim 54 relates to a roll of single ply tissue having a plurality of bosses and the properties mentioned in Claim 1. Independent process Claim 58 relates to a process for the manufacture of a tissue product having the properties mentioned in Claim 1 and comprising specific process steps.

Dependent Claims 2 to 17 and 19 to 53 relate to preferred embodiments of the product of Claim 1 and/or Claim 18. Dependent Claims 55 to 57 relate to preferred embodiments of the roll of Claim 54 and dependent Claims 59 to 68 relate to preferred embodiments of the process of Claim 58.

II. A notice of opposition had been filed against the granted patent, wherein the Opponent sought revocation of the patent on the grounds of Article 100(b) EPC for insufficient disclosure of the invention (Article 83 EPC) and of Article 100(a) for lack of novelty and inventive step (Articles 54 (1)(2) and 56 EPC).

In relation to the issue of sufficiency of disclosure, the following documents amongst others were cited by the Patent Proprietor:

D6 ASTM Standard D 828-93, "Standard Test Method for Tensile Properties of Paper and Paperboard Using Constant-Rate-of-Elongation Apparatus" and

D9 ASTM Standard D 829-97, "Standard Test Methods for Wet Tensile Braking Strength of Paper and Paper Products.

The Opponent filed amongst others document

D19 Experimental data.

III. In its decision, the Opposition Division reasoned that due to the absence in the patent of any precise method of measurement for the claimed strength parameters, a skilled person would be unable both, to establish which tissue products fall under the scope of the claims and to reliably prepare the claimed product.

IV. Upon requests made by both parties, oral proceedings before the Board were held on 5 April 2011.

V. The Patent Proprietor (now Appellant) argued in essence that on the basis of the information in the patent, a skilled person would use a suitable standard method, e.g. those illustrated in documents D6 and D9, for measuring dry and wet tensile strengths and adapt that method so that it fits within the limits of precision of repeatability given therein. It was pointed out that the standard methods allowed deviation from the testing procedure, for example in sample size or rate of jaw separation.

VI. The Respondent (former Opponent) presented in essence the following arguments:

- According to the established case law of the Boards of Appeal, sufficiency of disclosure

required that a skilled person is in a position to put the invention into effect across the whole scope of a claim and, therefore knows the limits of that scope.

- In the present case, the parameter of tensile strength was an essential feature. Therefore, a high accuracy for the claimed values was needed. Variable parameters like jaw speed or elongation speed significantly affected the measurement as was shown in the experiments of D19. However, the patent failed to disclose a specific test method.

- There was no teaching in the patent to use any of the existing standard tests for measurement; to the contrary the sample size and shape used in the patent were completely different from those used in the standards.

- Further, it was known from document D6 that elongation speeds had to be higher in the case of high stretch papers, so that the skilled person did not know what to do even if the standard test disclosed in this document was used. This applied the more so to papers with different stretch in MD and CD direction.

- Finally, failure of the patent to provide sufficient information for a skilled person to put the invention into effect across the whole scope of the claims was also due to the fact that the examples of the patent all report tensile strength values within the lower part of the claimed broad range only.

VII. The Appellant requests that the decision under appeal be set aside and that the case be remitted to the Opposition Division for consideration of the grounds of novelty and inventive step.

The Respondent requests that the appeal be dismissed or the case be remitted to the Opposition Division for consideration of the grounds of novelty and inventive step.

Reasons for the Decision

1. The gist of the Respondent's objection concerning lack of sufficiency consists in that an ambiguity with respect to the end values of the range for the dry and wet tensile strengths of the claimed tissue product arises from the fact that there exist different standard tests and different possibilities for carrying out those tests which all produce different results of measurement. Since the patent in suit did not disclose which specific method of measurement had to be applied, the ranges of tensile strength mentioned in the claims were undefined.

Apart from that, the standard methods did not use the sample size required in the patent in suit so that a skilled person would not use any of those methods.

As a result and contrary to the established Case Law of the Boards of Appeal as illustrated in T 611/02, a skilled person was unable both, to put the invention into effect across the whole scope of the claims and to

determine whether he is working within the forbidden area of the claims or not. Hence, the patent in suit did not meet the fundamental requirements under Article 83 EPC or respectively Article 100 b) EPC.

2. According to Article 100 b) EPC an opposition may be filed on the ground that a European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. In other words, a European patent shall fulfil the same requirements as defined in Article 83 EPC for a European patent application.
3. The Board observes that sufficiency of disclosure might be questionable if specific values of an unusual parameter are formulated in a patent as essential to the invention but no method of measuring that parameter is either known in the art or disclosed in the patent (Case Law of the Boards of Appeal of the European Patent Office, 6th edition, 2010, chapter II.A.3.d), first paragraph).
4. In the present case, the parameter in question is tensile strength, hence not unusual. Whilst being true that no specific method of measuring this parameter is disclosed in the patent in suit, there exist in the art several standardised test methods for determining the dry and wet tensile properties of paper and paperboard including tensile strength. There is no doubt that variations in the test conditions, e.g. the sample size, the jaw speed or elongation speed, have an influence on the result of the measurement. However, as it is known from the standard methods that deviations from the specified conditions are possible, in particular

deviations in sample size and jaw speed (e.g. document D6, page 105, paragraph 12.1.5; document D9, page 113, paragraph 13.1.3), a skilled person had no reasons not to use any of those well-known test methods.

Hence, the problem to be considered here boils down to the fact that, depending on the method of measurement, there exists an uncertainty as to the actual end values of the range for the tensile strength mentioned in the independent claims.

This problem remains the same, however, even if a specific method of measurement was disclosed in the description since the claims would not be restricted to that method.

5. The Respondent pointed to the second sentence of Article 69(1) EPC by arguing that the description should be used to interpret the claims.

Article 69(1) EPC relates to the extent of protection conferred by a European patent of patent application. According to the Protocol on the Interpretation of Article 69 EPC which was adopted as an integral part of the EPC to provide a mechanism for harmonisation of the various national approaches to the interpretation and determination of the protection conferred by a patent, this should be done so as not to overestimate either the literal wording of the claims or the general inventive concept disclosed in the description (see also G 2/88, OJ EPO 1990, 93, reasons No. 2.1, 3.3 and 4.).

6. However, this does not mean, that the scope of protection conferred by a claim is limited by the description.

In decision G 2/88, the Enlarged Board of Appeal was concerned with questions relating to Article 123(3) EPC with respect to a change in category from a claim for a physical entity to a claim for a second non-medical use. The Board took the view that upon proper interpretation within the terms of Article 69 EPC such a use claim would implicitly contain a functional feature as a technical feature (reasons No. 9).

It was held that the use claim which was in effect a claim to a physical entity only when it is used in the course of the particular physical activity (of the use) conferred less protection than a claim to a physical entity per se which conferred absolute protection upon such physical entity, no matter where it exists and what is its context (reasons No. 5).

7. Transferred to the present case, where a tissue product is claimed and different methods of measuring the tensile strength of that product are known in the art which give different results, this means that the end values of the range for the tensile strength remain ambiguous, irrespective of whether a specific test method is disclosed in the patent or not.

In other words, if - for the purpose of sufficiency of disclosure - it was a requirement that a person skilled in the art must know the scope of the claims, the disclosure of the claimed subject-matter would be

insufficient except where a complete method was included in the claim.

8. The Board notes that the scope of protection as defined in Article 69 EPC may have some relevance for the purposes of Articles 84 EPC and 123(3) EPC which both mention the protection sought for or conferred by a patent. In contrast, Article 83 EPC concerning sufficiency of disclosure is completely silent about that issue.

For these reasons, the Board takes the view that under the present circumstances the question of whether a skilled person can know what is covered by the claims is a question of definition of the claimed subject-matter, hence Article 84 EPC, rather than of sufficiency of disclosure (Article 83 EPC).

9. The Board further observes that the question of whether a skilled person is able to carry out the invention within the full scope of the claims is based on an assumption that their scope might extend to undisclosed variants. However, such doubts have to be substantiated by verifiable facts (see also e.g. T 1886/06, reasons no. 1.4.2).

No evidence in this respect has been presented by the Respondent. On the contrary, it has been shown by way of the Respondent's experiments D19 that there exists a correlation between the measured tensile strength value and the jaw speed which can be varied within wide limits and adapted according to circumstances.

10. Hence, the Board is of the opinion that the ambiguity of the end values of the ranges concerning tensile strength of the presently claimed tissue product is not a matter to be addressed under Article 83 EPC but a question of Article 84 EPC which requires that the claims shall define the matter for which protection is sought and be clear and concise as well as supported by the description. Due to the thus reduced significance of the values, this means that in opposition and appeal proceedings more prior art may be considered for the assessment of novelty and inventive step, namely that concerning tissue products which when measured in a technically reasonable way according to any of the known test methods give strength values within the claimed range.

11. Concerning sufficiency of disclosure, the Board observes that a skilled person is not only in a position to measure the strength of the tissue product but also that the patent contains the information required for producing that product (Claims 58 to 68, paragraphs 32 to 69 and examples). The latter has not been contested by the Respondent.

The Board, therefore, concludes that the patent satisfies the requirements of Article 100(b) EPC.

12. Remittal

The patent was revoked on the grounds of Article 100(b) EPC. Whether the patent meets the other requirements of the EPC, in particular those of Articles 54(1)(2) and 56 EPC, has not yet been established.

Since it is the function of appeal proceedings to give a judicial decision upon the correctness of a separate earlier decision taken by a first-instance department (Case Law of the Boards of Appeal, 6th ed. 2010, VII.E.1), the Board finds it appropriate to make use of its power under Article 111(1) EPC and remits the case to the first instance for further prosecution, thereby allowing the respective request of both parties.

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 for further prosecution.

The Registrar:

The Chairman:

D. Magliano

P.-P. Bracke