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**Datasheet for the decision
of 21 December 2010**

Case Number: T 1151/09 - 3.2.06

Application Number: 02253919.1

Publication Number: 1269955

IPC: A61F 13/496, A61F 13/15

Language of the proceedings: EN

Title of invention:
Pants-type disposable wearing article

Applicant:
UNI-CHARM CORPORATION

Opponent:
Paul Hartmann AG

Headword:
-

Relevant legal provisions:
EPC Art. 83

Keyword:
"Sufficiency (no) - no instruction available how to construct
the claimed article"

Decisions cited:
-

Catchword:
-



Case Number: T 1151/09 - 3.2.06

DECISION
of the Technical Board of Appeal 3.2.06
of 21 December 2010

Appellant:
(Patent Proprietor)

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(Opponent)

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Decision under appeal:

Decision of the Opposition Division of the
European Patent Office posted 24 March 2009
revoking European patent No. 1269955 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: P. Alting van Geusau
Members: G. de Crignis
K. Garnett

Summary of Facts and Submissions

- I. European patent No. 1 269 955, granted on application No. 02253919.1, was revoked by the opposition division by decision announced during the oral proceedings on 4 March 2009 and posted on 24 March 2009.

Claim 1 as granted has the following wording:

"A pants-type disposable wearing article comprising a chassis member (2) forming front and rear waist regions (M1, M3) opposed to each other and a crotch region (M2) positioned between these waist regions and a liquid-absorbent member (12) extending across said crotch region (M2) into said front and rear waist (M1, M3) regions, a waist hole (5) and a pair of leg-holes (6) below said waist-hole (5) and wherein a plurality of waist-surrounding elastic members(9) extending in a waist-surrounding direction (X) are secured in a stretched state to said chassis member (2) in at least one of said front and rear waist regions (M1, M3) and said chassis member (2) is provided with a plurality of gathers (10) generated by contraction of said waist-surrounding elastic members (9), characterized in that said waist-surrounding elastic members (9) are arranged between a peripheral edge (5a) of said waist-hole (5) and the crotch region (M2) and are arranged to be spaced one from another at a given distance in a longitudinal direction of said article substantially in parallel to said peripheral edge (5a) said gathers (10) being formed at regular intervals by repeated patterns of troughs (10b) and crests (10a) of said chassis member (2) in said waist-surrounding direction (X) extending in said longitudinal direction (Y) from said waist-hole (5) to said crotch region (M2) and perpendicularly to said waist-surrounding elastic members (9), wherein gaps (17) formed

between crests (10a) and a wearer's torso are continuously formed in the longitudinal direction (Y) from the crotch region (M2) to the waist-hole (5) in generally straight lines, and wherein a shrinkage in the waist-surrounding direction (X) of said chassis member (2) in said regions (M1, M3) having said waist-surrounding elastic members (9) is in a range of 35-80% per unit length."

- II. The decision of the opposition division was based on the finding that there was no clear and unambiguous teaching on how to construct the claimed pants-type diaper having the claimed regular gathers. In particular the skilled person was not considered to be in a position to know how to provide the chassis member with a plurality of gathers producing straight gaps which should be generated by contraction of the waist-surrounding elastic members. It followed that the invention was not disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 100(b) EPC).

- III. On 2 June 2009 the appellant (patent proprietor) filed an appeal against this decision and simultaneously paid the appeal fee. A statement setting out the grounds of appeal was received at the European Patent Office on 3 August 2009.

- IV. In a communication annexed to summons to oral proceedings, the Board pointed to a lack of convincing evidence and arguments to overcome the finding which had led to the decision of the opposition division.

- V. Oral proceedings were held on 21 December 2010.

The appellant requested that the decision under appeal be set aside and that the patent be maintained as granted, alternatively on the basis of the first or second auxiliary requests filed with the grounds of appeal or on the basis of one of the third or fourth auxiliary requests filed with letter of 19 November 2010.

The respondent requested that the appeal be dismissed.

Claim 1 of the first auxiliary request differs from claim 1 of the main request in that the subject-matter of claim 2 as granted (and as originally filed) is included.

Claim 1 of the second auxiliary request differs from claim 1 of the first auxiliary request in that the subject-matter of claim 6 as granted (and as originally filed) is added.

Claim 1 of the third auxiliary request differs from claim 1 of the first auxiliary request in that the subject-matter of granted (and originally filed) claim 5 is added. A further independent claim is included in this request.

The fourth auxiliary request differs from the third auxiliary request by being restricted to independent claim 1.

VI. The arguments of the appellant may be summarised as follows:

The opinion of the opposition division leading to the revocation of the patent was based upon an incorrect understanding of the knowledge of the skilled person.

The patent in suit disclosed how to manufacture the gathers and gaps of the claimed article. The specification of the patent in suit referred in col. 6, l. 31 to 35 to the fact that pre-formed elastic members should be applied. Pre-formed elastic members were commercially available and could be bought by the manufacturer of such panties. The elastic action of such elastic members was merely a matter of specifying the wanted properties. Figure 6 demonstrated the regular gathers and gaps obtained by such pre-formed elastic members. Hence, there was sufficient information in the specification and accordingly, there was no lack of sufficiency.

Evidence for the fact that such pre-formed elastic threads existed was filed in form of

E1 T. Odijk; "Stiff chains and filaments under Tension"; Macromolecules 1995, 28, page 7016.

This page provided academic considerations concerning the deformational behaviour of polymeric materials. It should be admitted into the proceedings since it was only during the oral proceedings before the board that the necessity for such evidence had become apparent.

VII. The arguments of the respondent may be summarised as follows:

The skilled person did not know how to obtain the claimed article (Article 100(b) EPC). In particular, for a panty including the usually applied elastic threads it is not possible to apply them in a stretched condition and then obtain gathers which extend in the

claimed straight lines. Neither appropriate elastic members nor a claimed article has ever been provided by the appellant. There was no guidance whatsoever for the skilled person as to how to arrive at such an article. Hence, the patent in suit did not disclose the invention sufficiently clearly or completely for it to be carried out by a skilled person.

The document E1 was filed only during the discussion in the oral proceedings, accordingly, it was late-filed and should not be admitted into the proceedings.

Reasons for the Decision

1. The appeal is admissible.
2. *Main request - sufficiency*
 - 2.1 The decision of the opposition division was based upon the fact that no information is available in the patent in suit as to how contraction of the elastic members leads to the claimed regular structure of gathers.
 - 2.2 Concerning the gathers and the related gaps in straight lines of the pants-type article, the description of the patent in suit refers to application of the elastic members in a stretched state to the nonwoven layers forming the chassis, whereby the subsequent contraction of the elastic members (see *inter alia* paragraphs [0006, 0014, 0016]) leads to regular gathers having straight gaps. However, the elastic members are not specified with reference to their structural or dimensional characteristics in the patent in suit.

2.3 In order to overcome this objection, the appellant relied upon the patent in suit as allegedly disclosing pre-formed elastic members and referred for corresponding support to col. 6, l. 31 - 35 (paragraph [0025]) of the patent in suit:

"The waist surrounding elastic members 9 take alternatively patterns of crests and troughs in the waist-surrounding direction, thus making the chassis member 2 undulate repeatedly in the waist-surrounding direction."

Such pre-formed elastic members were allegedly commercially available. Additionally, the appellant relied upon the disclosure of Figure 6.

2.3.1 However, no evidence has been provided that pre-formed elastic members were commercially available for the intended use, nor that such pre-formed elastic members would contract in a manner to form regular gathers irrespective of any specific adhesive attachment to the sheets. E1, filed during the oral proceedings in support of such an argument, does not concern any identifiable commercially available elastic members but refers to academic theoretical considerations not even addressing the products at issue. Hence, it is not relevant for the present proceedings and as a late-filed document it was not admitted.

2.3.2 The Board also cannot accept the appellant's interpretation of the above cited paragraph (point 2.3). Its wording is quite general and explains what should happen when the elastic members contract. It does not disclose pre-formed elastic members as enabling a

regular repetition of generally straight-lined gaps (crests and troughs).

2.3.3 Moreover, this paragraph has to be considered in combination with the disclosure in paragraph [0046] of the patent in suit, which specifies that the waist-surrounding elastic members are secured to the nonwoven layers by applying hot melt adhesive via coating patterns, including spiral or spray pattern. The percentage of the coated area with such adhesive should be in a range of from 20 to 80% of the total surface area of the elastic member. It is further explained that

"if the percentage of the adhesive coated area is less than 20%, it is a likelihood that the waist-surrounding elastic members 9 might fall off from the nonwoven fabric layers 7,8 ..."

"if the percentage of the adhesive coated area exceeds 80%, ..., contraction of the waist-surrounding elastic members 9 would be obstructed by the presence of adhesive."

This disclosure rather confirms the dependency of undulations on the percentage of area coated by adhesive rather than on a pre-forming of the elastic member.

2.3.4 Consistent with the content of this paragraph is the disclosure in paragraph [0033], corresponding to the last feature of claim 1, that the shrinkage rate of the chassis member should be in a specific range in order to obtain a regular, gather-like configuration. Considering the application of pre-formed elastic members, such shrinkage rate would be of lesser influence on the gather-like configuration.

2.3.5 Figure 6 cannot serve as evidence for the elastic thread members being pre-formed either. It is not explained how exactly the elastic member is joined to the non-woven layers (7, 8) in order to obtain such a regularly undulated structure. Accordingly, such an idealized drawing is not sufficient evidence for the availability of such a structure. Moreover, Figure 6 has to be considered in combination with the disclosure in paragraph [0033] and [0046], cited above, which are in contradiction to pre-formed elastic members.

2.4 For these reasons, the disclosure of the patent in suit is to be regarded as insufficient within the meaning of Article 100(b) EPC.

3. *Auxiliary requests*

3.1 The further amendments to claim 1 (inclusion of the subject-matter of claims 2, 5 and/or 6) in auxiliary requests 1 to 4 do not have the effect of getting round the above finding, since none of these added features sufficiently disclose the nature of the elastic members or the provision of the gathers and the gaps. Hence, the finding concerning the main request also applies to all the auxiliary requests.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar

The Chairman

M. Patin

P. Alting van Geusau