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**Datasheet for the decision  
of 12 April 2011**

**Case Number:** T 1671/09 - 3.2.06

**Application Number:** 01114559.6

**Publication Number:** 1234564

**IPC:** A61F 13/551

**Language of the proceedings:** EN

**Title of invention:**

Envelope for containing adhesive sanitary towels for women and production process

**Patentee:**

Plastik S.p.A.

**Opponent:**

Huhtamaki Forchheim Zweigniederlassung der Huhtamaki  
Deutschland GmbH & Co. KG  
The Procter & Gamble Company

**Headword:**

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**Relevant legal provisions:**

RPBA Art. 12, 14  
EPÜ Art. 54

**Keyword:**

"Novelty (no)"  
"Late-filed request (not admitted)"

**Decisions cited:**

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**Catchword:**

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Case Number: T 1671/09 - 3.2.06

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.06  
of 12 April 2011

**Appellant:** Plastik S.p.A.  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 16 June 2009  
revoking European patent No. 1234564 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- I. European patent No. 1 234 564, granted on application No. 01114559.6, was revoked by the opposition division by decision announced during the oral proceedings on 19 February 2009 and posted on 16 June 2009.

Claim 1 underlying this decision has the following wording:

"Process for manufacturing a film suitable for making an envelope for containing adhesive sanitary towels for women characterised in that said film is wound in reels and in that the side of said film which is to form the envelope inner surface (5) is printed, by usual flexographic or rotogravure methods, with liquids having physical and chemical properties which render them similar to the usual printing inks, said liquids being able to stably deposit, on the treated film, suitable quantities of non-stick materials, preferably of silicone nature in a dotted form which can be freely modified in shape and density."

Claim 4 underlying the decision reads as follows:

"An envelope, indicatively of a polyethylene film for containing adhesive sanitary towels for woman, whereby the side of said film which is to form the envelope inner surface (5) is provided with a quantity of non-stick material, advantageously of silicone nature, characterised in that the non-stick material is spread on said side of said film by flexographic or rotogravure printing, and in that said non-stick material is distributed in dotted manner, so that those

surface regions which do not contain it offer a removal and retention action on excess adhesive and generally a reduction in the adherence of the usual adhesives applied to the sanitary towel."

The decision of the opposition division was based on the finding that the European patent met the requirements of Articles 123 (2) and (3) EPC and that the ground of opposition under Article 100 (b) EPC did not prejudice the maintenance of the patent. The subject-matter of claim 1 was considered to be novel with regard to:

D4 US-A-5 061 535,

D6 EP-A-0 307 578 and

E3b EP-A-1 097 878 (relevant according to Article 54(3) EPC),

whereas the subject-matter of claim 4 was not considered to be novel over the disclosure in E3b.

II. On 10 September 2009 the appellant (patent proprietor) filed an appeal against this decision and on the same day paid the appeal fee. A statement setting out the grounds of appeal was received at the European Patent Office on 14 October 2009 together with an amended main request.

III. In a communication annexed to a summons to oral proceedings sent on 13 December 2010, the Board indicated that the new request did not appear formally allowable.

IV. Oral proceedings were held on 12 April 2011. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the

basis of the main request filed with the grounds of appeal, alternatively on the basis of the auxiliary request filed during the oral proceedings.

The respondents requested that the appeal be dismissed.

Claim 1 according to all current requests differs from claim 1 as submitted in the opposition proceedings in that the term "suitable" has been deleted in line 1.

In comparison to claim 4 of the request underlying the appealed decision, claim 4 according to the main request before the Board has an amended characterising portion which reads [*amendments in italics*]:

"characterised in that the non-stick material is spread on said side of said film *by means of usual printing methods, in particular* flexographic and rotogravure printing, and in that said non-stick material is distributed in dotted manner, so that those surface regions *between the dots* which do not contain it offer a removal and retention action on excess adhesive and generally a reduction in the adherence of the usual adhesives applied to the sanitary towel."

The auxiliary request filed during the oral proceedings was based on the main request but omitting claim 4.

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

The subject-matter of claim 4 was novel. E3b did not disclose a silicone ink placed on a substrate by a

printing technique "in a dotted manner". The triangular pattern shown in its Figure 5 represented a coating. The inventive concept of the claimed subject-matter referred to avoiding excess adhesive material being transferred to the panties. This concept was reflected in claim 4 by the final functional feature but not present in the disclosure of E3b.

Claims 1 to 6 submitted as an auxiliary request did not include the former claim 4 and hence the subject-matter of the claims was novel. Inventive step should be discussed with regard to the problem set out in the patent in suit.

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

The subject-matter of claim 4 lacked novelty over the disclosure in Figure 5 of E3b which showed a pattern of triangles which represented dots according to the interpretation given to the term "dot" in paragraph [0012] of the description of the patent in suit. This particular interpretation meant that the dots disclosed in the patent in suit and claimed in claim 4 could not be distinguished from the triangular "dots" shown in Figure 5 of E3b. Although E3b referred generally to coatings, screen printed or sprayed dots of various sizes could not be distinguished from such dots applied by other coating or printing techniques.

The auxiliary request submitted during the oral proceedings was late-filed. No reason was given for not filing such requests earlier. It should not be admitted

into the proceedings: Articles 13 (1) and (3) of the Rules of Procedure of the Boards of Appeal.

## **Reasons for the Decision**

1. The appeal is admissible.
2. Main Request - Claim 4 - Amendments

The characterising portion of claim 4 has been amended with regard to the subject-matter of claim 4 as upheld by the opposition division. A reference to "usual printing methods" (consistent with the subject-matter of claim 4 as granted) and the term "between the dots" has been added. Although neither amendment is related to the reasons in the appealed decision, it is not necessary to discuss these formal requirements further, since the principal reason underlying the appealed decision (lack of novelty) has not been overcome, as set out in the following.

3. Main request - claim 4 - novelty
  - 3.1 E3b discloses a film for a packing material (see the title), which film can be used as an envelope for sanitary napkins (claim 12, Figures). A release coating - preferably of a silicone nature (claim 6) - is applied to one side of the film, which side forms the interior side when applying a sanitary napkin. Figure 5 shows a triangular pattern of release coating in the central longitudinal area of the film.

- 3.2 The appellant was of the view that the subject-matter of claim 4 differs from the disclosure of E3b in that in E3b there is no disclosure of a printing method and the resultant pattern of dots.
- 3.3 In this respect it must be pointed out that the patent in suit does not limit the meaning of "dots" to a specific interpretation. The terms "dotted" and "dots" are not particular precise, so that it is legitimate to resort to the description to reach a better understanding of their meaning (Article 69 EPC, and protocol thereto). According to the description in paragraph [0012], although in Figures 2 to 5, the "printed" silicone *"is shown as uniformly distributed circles, silicone application by printing enables other geometrical figures to be used, and their distribution and/or size to be varied. An example of a printed figure different from a circle could be a rhombus; such a figure would in fact be advantageous in differentiating the silicone between the longitudinal axis and transverse axis of the film in reels, used for forming the containing envelopes."* Hence, not only are small circular figures to be regarded as dots but also other geometric figures, of varying sizes.
- 3.4 The Board therefore cannot accept the appellant's restricted interpretation of dots as meaning only tiny printed circles. Although this may be the usual understanding in the field of printing, the meaning of this term in the patent has been deliberately broadened via the description. The triangular patterns shown in Figure 5 of E3b fall within this broad meaning.



- 3.5 The subject-matter of claim 4 refers further to any "usual printing methods" and thus includes screen printing. Although the disclosure in E3b does not specify the coating method which is used to apply the triangular patterns to the film layer, no evidence has been presented that a screen-printed coating could be distinguished from any other kind of coating leading to such triangular patterns. Therefore, the claimed envelope having such a pattern cannot be clearly and unambiguously distinguished from the envelope disclosed in E3b.
- 3.6 Hence, all the structural features of the claimed envelope are disclosed in E3b and the subject-matter of claim 4 is not novel (Article 54 (3) EPC).
- 3.7 The further reference by the appellant to the functional feature ("so that those surface regions between the dots which do not contain it offer a removal and retention action on excess adhesive and generally a reduction in the adherence of the usual adhesives applied to the sanitary towel") is not linked to any structural feature but concerns rather the intended use. However, the subject-matter of claim 4 is related to an envelope and not to its use. Moreover, the removal and retention action on excess adhesive is dependent on further unspecified features such as the kind and quantity of adhesive applied and the degree to which the surface regions which do not contain release material. Additionally, such a functional feature merely describes a desired intention without any means for obtaining the result. This unspecified functional feature also applies for all prior art envelopes to a

certain degree and cannot distinguish the claimed envelope from any prior art envelope.

4. *Auxiliary request(s)*

4.1 According to Article 12 (2) RPBA, the statement of grounds of appeal and the reply shall contain a party's complete case. According to Article 13 (1) RPBA, any amendments to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the Board's discretion, which shall be exercised in view of *inter alia* the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy.

4.2 In the auxiliary request filed during the oral proceedings, the claims were limited to the process claims. However, this limitation was not caused by anything which arose for the first time during the oral proceedings but was designed to get around the finding of the opposition division that the subject-matter of claim 4 lacks novelty. Accordingly, such limitation could have been made when filing the appeal. Moreover, such limitation would inevitably have led to inventive step issues of a kind which had not previously formed part of the subject matter of the appeal.

4.3 Moreover, in the wording of the subject-matter of claim 1, the term "suitable" has been deleted although no process step for manufacturing an envelope is present. It had already been pointed out in the communication annexed to the summons that such a deletion was not considered allowable. The appellant did not give any reasons justifying such a deletion and

also did not explain why such a deletion would overcome the raised objections concerning inventive step.

4.4 During the oral proceedings the appellant offered to limit the auxiliary request further by deleting all claims except claims 1 to 3. It was argued that since these claims were limited to claims already present in the proceedings they should be allowed into the proceedings.

4.5 Irrespective of whether the eventual request were to have been based on claims 1 to 6 or just on claims 1 to 3, the request would not have been clearly allowable. Hence, having regard to the need for procedural economy, the Board did not exercise its discretion under Article 13(1) RPBA to allow the appellant to change its case by introduction of such late-filed requests into the proceedings.

## **Order**

### **For these reasons it is decided that:**

The appeal is dismissed.

The Registrar

The Chairman

M. Patin

P. Alting van Geusau