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**Datasheet for the decision
of 31 January 2017**

Case Number: T 0511/13 - 3.2.06

Application Number: 01990861.5

Publication Number: 1349524

IPC: A61F13/47, A61F13/474

Language of the proceedings: EN

Title of invention:
DUAL-USE PANTILINER

Patent Proprietor:
KIMBERLY-CLARK WORLDWIDE, INC.

Opponents:
SCA Hygiene Products AB
Johnson & Johnson Consumer Inc.

Headword:

Relevant legal provisions:
EPC Art. 123(2), 123(3)
EPC 1973 Art. 84, 111(1)
EPC R. 111(2)
RPBA Art. 13(1)

Keyword:

Amendments - extension beyond the content of the application
as filed (no) - broadening of claim (no)

Late-filed request - admitted (yes)

Remittal to the department of first instance - (yes)

Substantial procedural violation - appealed decision
sufficiently reasoned (no)

Reimbursement of appeal fee - (no)

Decisions cited:

T 1869/10, T 2219/12, T 0005/10, T 1912/09

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

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Case Number: T 0511/13 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 31 January 2017

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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted on 21 December 2012 rejecting the opposition filed against European patent No. 1349524 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman	M. Harrison
Members:	M. Hannam
	E. Kossonakou

Summary of Facts and Submissions

I. An appeal was filed by the appellant (opponent) against the decision of the opposition division rejecting the opposition to European patent No. 1 349 524. It requested that the decision be set aside and the patent be revoked. In support of its request, the following documents new to the opposition were submitted:

D16 US-A-2 787 271

D17 WO-A-99/01094

D18 EP-B-0 667 759

D19 US-A-5 961 505

II. In its letter of response, the respondent (patent proprietor) requested that the appeal be dismissed, in the alternative that it be maintained according to one of auxiliary requests 1 to 11.

III. The Board issued a summons to oral proceedings and a subsequent communication containing its provisional opinion, in which it indicated *inter alia* that the subject-matter of claim 1 of the main request and a number of the auxiliary requests did not meet the requirement of Article 123(2) EPC. It further indicated that a lack of reasoning in the decision concerning claim 6 appeared to have resulted in a procedural violation.

IV. With letter of 30 December 2016 the respondent filed a main request and auxiliary requests 1 to 19 to replace all requests previously on file.

V. With a further letter of 11 January 2017 the respondent replaced all requests on file with a new main request and auxiliary requests 1 to 5.

VI. Oral proceedings were held before the Board on 31 January 2017, during which the respondent withdrew all its requests on file and submitted a single new request, auxiliary request 4a.

The final requests of the parties were as follows:

The appellant requested that the decision under appeal be set aside and the patent be revoked and subsidiarily that the case be remitted to the opposition division for further prosecution.

The respondent requested that the patent be maintained in an amended form according to auxiliary request 4a and that the case not be remitted to the opposition division.

VII. Claim 1 of auxiliary request 4a reads as follows:

"A pantiliner having a liquid permeable liner, a liquid impervious baffle and an absorbent core positioned therebetween, said pantiliner characterised by comprising a periphery and at least one embossed fold line (2) defining an absorbent central area (3) and two absorbent side areas (4,5), the absorbent central area extending to an end of the pantiliner so as to coincide with an end edge of the pantiliner at said end of the pantiliner, and wherein the absorbent central area (3) defined by the at least one embossed fold line (2) has sides that converge to form a narrowed end portion of the central area (3) at said end of the pantiliner, the unfolded pantiliner being hourglass-shaped, wherein said pantiliner may be adjusted in size by folding said pantiliner along said embossed fold line (2), the side areas (4,5) being foldable under a panty along the

embossed fold line (2) when used with a thong panty, wherein said at least one embossed fold line (2) does not penetrate said baffle."

VIII. The appellant's arguments may be summarised as follows:

As regards admittance of auxiliary request 4a, the jurisprudence of the Boards of Appeal suggested that such late amendments were only admitted if a new objection was raised during oral proceedings (see T1869/10) or if the request was obviously allowable (see T2219/12, T0005/10 and T1912/09); neither was the case here.

The subject-matter of claim 1 *prima facie* did not meet the requirement of Article 123(2) EPC. The core was claimed in combination with the liner and the baffle although without the further detail of the core disclosed on page 2, lines 13 to 17. The embossed fold line not penetrating the baffle was disclosed solely in combination with the forming temperature range of 40 to 80°C. The omission of the word 'slightly' before the expression 'hourglass-shaped' had no basis and led to an undisclosed intermediate generalisation of the pantiliner. A basis for the sides of the central area converging was also lacking; particularly Figs. 1 and 2 depicted the sides becoming parallel or even diverging at the end portion of the central area such that, with the figures being the basis of this feature, no basis could exist. Also the figures showed the central area extending the full length of the pantiliner which was not reflected in the claim. It was not disclosed in Fig. 1 that the central area coincided with the end of the pantiliner; whilst this appeared to be so in the Figure, this was only schematic.

The subject-matter of claim 1 also contravened Article 123(3) EPC. Claim 1 as granted was limited to a pantiliner with central and side areas; in the present claim 1 it was possible that a further area at the opposite end of the pantiliner was present.

Claim 1 was also *prima facie* unclear. The sides of the absorbent central area were not defined and could thus be the longitudinal ends of the area. It was also unclear with respect to what the end portion of the central area was 'narrowed'. How the central area 'coincided' with the end edge of the pantiliner was also not clear.

No further objections under Articles 84 or 123 EPC were apparent.

The objections raised during the oral proceedings before the opposition division under Article 100(c) EPC to the subject-matter of at least dependent claim 6 were not addressed in the appealed decision. This lack of reasoning resulted in a substantial procedural violation.

If auxiliary request 4a was to be admitted, the case should then be remitted to the opposition division for further prosecution. The additional structural features now present in claim 1 necessitated an additional search without which it was not possible to know if the objections under novelty and inventive step were complete.

IX. The respondent's arguments may be summarised as follows:

The subject-matter of claim 1 met the requirement of

Article 123(2) EPC. Page 6, lines 17 to 18 disclosed the claimed liner, baffle and core in a manner applicable to all embodiments. Page 12, lines 21 to 22 disclosed it being preferred that the embossing did not penetrate the baffle whilst several passages in the application as filed provided basis for the hourglass shape of the pantiliner. Page 11, lines 1 to 3 also indicated that variations in the shape and size of specific features of the pantiliner were possible. From the figures as a whole and the related understanding of the purpose of the invention, the converging sides of the central area forming a narrowed end portion of the central area and coinciding with the end of the pantiliner had an unambiguous basis, when the relevant disclosure was considered by a skilled person.

Regarding the objection under Article 123(3) EPC, there was no indication in the patent that the central area had to extend to the end edges; the scope of claim 1 as granted thus already included areas in addition to the central and side areas.

Claim 1 was clear. From the wording of claim 1 alone it was evident what 'coincide' meant, this being further supported from page 10 in combination with Fig. 1.

The case should not be remitted. Auxiliary request 3 as filed in response to the appeal included the feature of a narrowed end portion such that no further search was necessary. Furthermore the patent expired in only a few years time.

Reasons for the Decision

Auxiliary request 4a

1. *Admittance - Article 13(1) of the Rules of Procedure of the Boards of Appeal (RPBA)*

1.1 According to Article 13(1) RPBA, after filing the grounds of appeal or reply, any amendment to a party's case may be admitted and considered at the Board's discretion, such discretion being exercised *inter alia* in view of the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy.

1.2 The respondent filed the present auxiliary request during oral proceedings before the Board. The request thus represents a change to the respondent's complete case as defined in Article 12(2) RPBA and its admittance may be considered at the Board's discretion under Article 13(1) RPBA.

1.3 The appellant's argument, with reference to T1869/10, that in the present case no new objections had arisen during the oral proceedings such that the new request filed for the first time at oral proceedings should not be admitted, is not persuasive. Auxiliary request 4a is based on auxiliary request 2 as filed in response to the opponent's appeal. The further amendments made to claim 1 of auxiliary request 2 in the present request result from it only becoming clear in the course of the oral proceedings which features the opponent objected to as being inextricably linked in the invention according to claim 1. Whilst the appellant had objected to an unallowable intermediate generalisation being

present in claim 1 of higher ranked requests, its arguments had not been recognisably directed to the specific shape of the central area of the pantiliner and the line(s) of embossing corresponding approximately to the shape of a thong panty, but rather to a rather unspecific intermediate generalisation *per se*. Faced with such an argument, the respondent had reacted by filing a request directed to the shape of the central area and the function of the embossed lines to arrive at the definition in claim 1. When considering the previous main request, it can also be recognised that this had been directed to the features of the pantiliner expressed functionally. The Board thus sees the filing of the new request as an appropriate response to how the case had developed in the oral proceedings. This is thus not contrary to the finding in T1869/10 in which no new objection was raised at oral proceedings.

The further decisions cited by the appellant are directed to cases in which requests filed during oral proceedings were not admitted as these were not clearly and obviously allowable. Whilst the 'obvious allowability' has not been an issue decided in the present case, the filing of a new request in the present circumstances is nonetheless seen as an appropriate response to the development of the case in the course of the oral proceedings, in particular due to certain clarity objections against the main request made during the oral proceedings. Furthermore, the amendments made are not particularly complex and the appellant was offered the time it had requested to consider what objections it wished to raise against the new claim.

The Board thus found that, in view of the specific

circumstances of the case, the admittance of auxiliary request 4a should not be denied simply due to its late filing during oral proceedings.

1.4 As is established case law of the Boards of Appeal, the procedural economy referred to in Article 13(1) RPBA implies that amended requests should at least be *prima facie* allowable in order to be admitted. As regards the *prima facie* allowability of the present request, objections under Articles 123 and 84 EPC are considered.

1.5 *Article 123(2) EPC*

1.5.1 As regards the addition of the features that the pantiliner has 'a liquid permeable liner, a liquid impervious baffle and an absorbent core positioned therebetween', this has basis on page 6, lines 17 to 18, in combination with page 6, line 19, page 7, line 8 and page 7, line 24, of the WO-publication (corresponding to the originally filed international application). This portion of the application relates to the 'detailed description of the invention' and discloses the liner, the absorbent core and the baffle in general terms with respect to sanitary napkins. It is regarded to be a general disclosure relevant to all embodiments of the invention such that the incorporation of the features into claim 1 is unambiguously disclosed to the skilled person. The appellant's reference to page 2, lines 13 to 17, in which further detail of the absorbent core is provided, is under the heading 'summary of the invention', particular embodiments of which are then detailed. This passage of the description is thus indeed not the basis used for the extraction solely of the liner, baffle and core; this is provided by the referenced

passages on pages 6 and 7 above.

- 1.5.2 The added feature that the 'embossed fold line does not penetrate said baffle' has basis on page 12, lines 19 to 23, in which this feature is discussed as preferred, and for a skilled person is clearly understood as being applicable to any embodiment of the invention. The appellant's argument that the detail regarding the temperature of embossing on page 2, line 7 and page 12, lines 26 to 27 should be included in the claim is not accepted. Firstly, the embossing temperature is a method step for forming the embossed fold line and is thus not a physical feature of a claim directed to a pantiliner. Furthermore, the disclosure of these temperatures of embossing are only preferable, even in the context of the purposes for which they are stated, since they are preceded by the expressions 'may be' and 'should be' and would therefore not be seen by the skilled person as compulsorily included in the physical disclosure of the embossed fold line.
- 1.5.3 The feature regarding the 'pantiliner being hourglass-shaped' is found to have a general basis in the application as filed. The hourglass shape is addressed in several places of the application (e.g. the brief description of the drawings on pages 2 to 3; page 11, line 4; page 13, line 21) and is seen as a general disclosure of this shape as also indicated in each of the figures. Even though the disclosures of hourglass shape on page 11, lines 2 and 4 refer to the panty shape, it is self evident that the product is intended to be adapted to such a shape. The appellant's argument that the omission of the word 'slightly' before the expression 'hourglass-shaped' led to an undisclosed intermediate generalisation is not accepted. Whilst page 10, lines 5 to 6 of the

application indeed discloses a 'slightly' hourglass shape of pantiliner, this is not an all-exclusive limitation for the shape of the pantiliner, the broader terminology 'hourglass' coming from the more general disclosure of the hourglass shape in the above referenced passages, which are equally applicable to the disclosure provided by the embodiments shown in the figures.

- 1.5.4 The feature regarding the sides of the central area 'that converge to form a narrowed end portion of the central area' has an unambiguous basis in each of the figures in particular when read in combination with page 1, lines 13 to 14 and page 10, lines 9 to 12. From these sources it is evident that the embossed fold lines themselves must converge towards one end of the absorbent central area in order for the pantiliner to be suited for use with thong panties having a narrowed rear portion (see page 1, lines 13 to 14), and that it is the general detail of these lines converging that the skilled person would recognise as being of relevance for the disclosed pantiliner in both functional and structural terms. The appellant's contention that Figs. 1 and 2 disclose the sides of the central area no longer converging as the end of the pantiliner is approached, and thus the sides not converging in these figures, is not persuasive. The narrowed end portion of the absorbent central area, according to claim 1, is located at the end of the pantiliner and the absorbent central area is stated to extend 'to an end of the pantiliner'. As a consequence any slight divergence of the sides of the absorbent central area close to the end of the pantiliner is not prejudicial to the general disclosure of the sides 'converging to form a narrowed end portion', which is seen as being directly and unambiguously derived from

the application as filed.

1.5.5 As regards the absorbent central area extending to coincide with the end edge of the pantiliner, this has a functional connection to the embossed fold lines, which define the sides of the central area, limiting lateral movement of fluid from the central area to the side areas. It thus follows that the claim includes those features of the original disclosure having a functional link to the converging sides of the central area, which central area sides are also structurally linked due to their intrinsic positional limitation by the embossed fold lines. The appellant's argument in this respect, that a schematic figure could not provide basis for this feature adopted into claim 1, is not accepted at least due to the above indicated functional connection of the embossed fold lines to the pantiliner. The skilled person is aware from page 13, lines 2 to 4, that the embossed lines help to avoid liquid run-off; as a consequence, even though just schematic, the figures showing the coincidence of the central area with the end edge of the pantiliner would be immediately seen by the skilled person as deliberately depicted in this manner, in order to maintain any liquid in the central area and avoid lateral liquid run-off.

1.5.6 The appellant's argument, that each of the figures showed the absorbent central area extending the full longitudinal extent of the pantiliner (i.e. also to the opposite end of the pantiliner even beyond the lines of embossment) and that this should thus be included in claim 1, is not accepted. The longitudinal extent of the central area does not have a structural or functional link to the features in claim 1. Other than the pantiliner of claim 1 structurally comprising the

central area, its presence over the full extent of the pantiliner is irrelevant with respect to the function of the pantiliner being adaptable to the shape of a thong panty and in particular the narrower rear portion thereof. It thus follows that the full extent of the central area towards the opposite end periphery of the pantiliner is irrelevant to the structure and function of the combination of features used to define the pantiliner and its inclusion in claim 1 would thus not be understood to belong to the direct and unambiguous disclosure of the now claimed invention when the content of the application as filed is considered by a skilled person.

1.5.7 There is thus no reason to doubt that the subject-matter of claim 1 *prima facie* meets the requirement of Article 123(2) EPC.

1.6 *Article 123(3) EPC*

1.6.1 The scope of claim 1 as granted included a central area and two side areas. The appellant's argument that the central area had now been further defined thus implicitly further including in the scope of the claim a portion of the central area, or even a further portion, away from the narrowed end portion was not persuasive. In this respect it is noted that claim 1 as granted was directed to a pantiliner 'comprising a periphery and at least one embossed fold line defining a central area and two side areas'. Through the use of the expression 'comprising', it is clear that the subsequent list of features included in the pantiliner is not exhaustive. Thus, already in the scope of the claim as granted, further areas to those explicitly mentioned were included such that no extension in protection can be seen in the present claim 1 over that

of claim 1 as granted.

1.6.2 The Board thus sees no reason as to why the subject-matter of claim 1 would not at least *prima facie* meet the requirement of Article 123(3) EPC.

1.7 *Article 84 EPC 1973*

1.7.1 The appellant's argument that it was unclear what the sides of the central area were and that these could be the ends of the central area is not accepted. The sides of the central area are stated to 'converge to form a narrowed end portion of the central area' which limits the interpretation of 'the sides' to the edges of the central area, bound in their laterally outermost extent by the lines of embossing, following the essentially longitudinal orientation of the pantiliner. Although the appellant argued that sides had not previously been defined in the claim, such that the ends of the central area could also be considered to be the sides, this would not logically fit the definition in the claim that the sides had to converge to form a narrowed end portion. Thus the Board sees no lack of clarity in the definition of 'sides' as used in claim 1.

1.7.2 The appellant's argument, that it was unclear with respect to what the end portion was narrowed, is not persuasive. The skilled person would understand that the narrowed end portion of the central area is narrowed relative to the remaining regions of the central area i.e. that part of the central region away from the end portion. This interpretation, clear from the claim itself, is also supported by the skilled person's understanding of the purpose of the narrowed end portion, that being to adapt the pantiliner to a thong panty having a narrowed rear portion (see page 1,

lines 13 to 14). The claimed narrowed end portion in the pantiliner would thus reflect the narrowed shape of a thong panty to which the pantiliner may be adjusted in size.

1.7.3 The appellant's further argument that it was unclear in what way the the central area coincided with an end edge of the pantiliner is also not accepted. From each of the figures it is evident that the central area extends to the end edge of the pantiliner or, in other words, that the central area touches the end edge of the pantiliner. Even in Fig. 1, in which the central area is depicted to coincide with the end edge over a minimal distance, it is not accepted that the figurative nature of the drawing invalidates this feature from being clear, the word 'coincide' being appropriate for the depicted extent of the central area to the end edge of the pantiliner. The skilled person would thus find this definition clear, seeing the central area indeed as being at a common location with (i.e. coinciding with) the end edge of the pantiliner.

1.7.4 It thus follows that claim 1 also at least *prima facie* meets the clarity requirement of Article 84 EPC 1973.

1.8 In summary, therefore, auxiliary request 4a is found to *prima facie* meet the requirements of Article 84 EPC 1973 and Article 123 EPC.

1.9 In view of the considerations in points 1.1 to 1.8 above, the Board thus exercised its discretion and admitted auxiliary request 4a (Article 13(1) RPBA).

2. The appellant raised no objections under Articles 84 and 123 EPC on a substantive basis beyond those already raised in the *prima facie* analysis of the request. The

Board also sees no further objections in this respect. Auxiliary request 4a thus meets the requirements of Article 84 EPC 1973 and Article 123 EPC.

3. *Procedural violation*

3.1 From page 1 of the minutes of the oral proceedings before the opposition division, it is evident that an objection under Article 100(c) EPC was raised by the opponent to claim 6 as granted, specifically due to the dependency of granted claim 6 'from any preceding claim' having no basis in the claims and description as originally filed. The opposition division's decision is however silent on this objection, stating in point 2.1.4 that the claims of the main request meet the requirement of Article 123(2) EPC (sic).

3.2 With letter of 15 January 2013 the opponent identified the lack of reasoning in the opposition division's decision with respect to claim 6. To this the opposition division responded with reference to paragraph 2.1.1 of its decision. This paragraph however does not deal explicitly with the basis for the dependency of granted claim 6, nor can it be inferred therefrom.

3.3 The opposition division's decision is therefore deficient in that it lacks reasoning with respect to the objection raised under Article 100(c) EPC to claim 6 as granted, contrary to the requirement of Rule 111(2) EPC. This lack of reasoning is a procedural violation, since the opponent was deprived of any reasoning for the decision in respect of the opponent's objections to claim 6.

3.4 The appellant withdrew its request for the appeal fee to be reimbursed and no reasons of equity were apparent to the Board for a decision with a different outcome. Whilst a procedural violation can be recognised in the absence of a reasoned decision on the objection to claim 6 as granted and the added subject-matter arising out of its dependency on claims 1 to 5, the claim was removed in the request before the Board and the appellant had also appealed under the same opposition ground, successfully, as regards claim 1. Absent any further argument from the appellant, the Board also does not conclude *ex officio* that the procedural violation was a substantial procedural violation since it did not prevent the applicant from formulating an appeal against the rest of the decision. It follows that the requirements of Rule 103(1)(a) EPC are not fulfilled.

4. *Remittal to the department of first instance*

4.1 According to Article 111(1) EPC 1973, when deciding on an appeal, the Board may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution.

4.2 In the exercise of such discretion, in the present case an important aspect is that the opposition division decided on the allowability of the claims as granted which differ markedly from the claims of the present request. Having been filed at oral proceedings before the Board, the appellant has also been unable to prepare its objections to the new claims which, significantly, may require an additional search for relevant new prior art disclosing the newly added features. It is also noted that documents D16 to D19,

as filed by the appellant with its grounds of appeal, were also not on file before the opposition division at the time of it taking its decision.

4.3 The respondent's argument that auxiliary request 3 as filed in response to the appeal included the feature of a narrowed end portion is not persuasive in the case not being remitted. Claim 1 of auxiliary request 3, referred to by the respondent, included a feature to 'a narrowed rear portion', which related to the thong panty, rather than to a 'narrowed end portion of the central area' of the pantiliner itself as now claimed. It thus cannot be held that the appellant should have initiated a search to this feature at the time when the response to the appeal was filed as it was directed to a different feature (i.e. the narrowed rear portion of the thong panty) and thus anyway met with an Article 123(2) EPC objection, albeit the intention of that particular feature to functionally define structural features of the pantiliner was recognisable.

4.4 The respondent's further argument that minimal time remained until lapse of the patent and that remittal would simply further delay a final decision is not accepted. The patent lapsing in the near future is not a persuasive argument not to remit the case under these circumstances. When balanced against the need for the proceedings to be fair and the appellant being given sufficient time to prepare its objections to a new request, which included features not taken from the claims, the Board sees it as appropriate to remit the case allowing the appellant to carry out an additional search and to thus adequately deal with the amendments made to claim 1 during the oral proceedings before the Board.

4.5 Therefore the Board avails itself of its power under Article 111(1) EPC 1973 to refer the case back to the department of first instance for further prosecution.

4.6 For the avoidance of doubt, the Board has not decided on the allowability of claim 1 of auxiliary request 4a with respect to all requirements of the EPC, but merely that claim 1 of the request is not open to objection under Article 123 EPC and Article 84 EPC 1973.

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:



A. Wolinski

M. Harrison

Decision electronically authenticated