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**Datasheet for the decision  
of 25 April 2023**

**Case Number:** T 2432/19 - 3.2.06

**Application Number:** 09156501.0

**Publication Number:** 2087873

**IPC:** A61F13/49

**Language of the proceedings:** EN

**Title of invention:**

Disposable diaper

**Patent Proprietor:**

UNI-CHARM CO., LTD.

**Opponent:**

Essity Hygiene and Health Aktiebolag

**Headword:**

**Relevant legal provisions:**

EPC Art. 100(c), 123(2)

RPBA 2020 Art. 15a(1), 13(1), 23

**Keyword:**

Right to oral proceedings in form of a videoconference (no)  
Amendments - main request and auxiliary requests 1 to 4 -  
added subject-matter (yes)  
Late-filed auxiliary requests 5 to 8 - procedural economy (no)

**Decisions cited:**

G 0001/21, G 0002/10, G 0001/93, T 0618/21, T 0758/20,  
T 0331/87, T 1852/13

**Catchword:**

1. Although the order of G 1/21 refers to an emergency situation, it follows from the *ratio decidendi* of this decision that in-person oral proceedings can only be denied under very limited conditions, even in a situation of general emergency such as a pandemic.

2. Due to the fact that videoconferences, at least with current technology, can only provide a suboptimal form of communication, parties have a right to the optimum format for oral proceedings, i.e. in-person oral proceedings, that can only be denied under very limited conditions.

3. Further, *e contrario* it also follows from the reasons underlying the Enlarged Board's decision, that parties cannot force Boards to conduct videoconferences instead of in-person oral proceedings.



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Case Number: T 2432/19 - 3.2.06

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.06**  
**of 25 April 2023**

**Appellant:** UNI-CHARM CO., LTD.  
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**Respondent:** Essity Hygiene and Health Aktiebolag  
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**Representative:** Essity Hygiene and Health AB  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 3 July 2019  
revoking European patent No. 2087873 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman** M. Harrison  
**Members:** P. Cipriano  
W. Ungler

## **Summary of Facts and Submissions**

- I. An appeal was filed by the appellant (patent proprietor) against the decision of the opposition division revoking European Patent No. 2 087 873. The appellant requested that the decision under appeal be set aside and the patent be maintained as granted or, in the alternative, on the basis of one of the first to ninth auxiliary requests.
- II. The respondent (opponent) requested that the appeal be dismissed.
- III. The Board issued a summons to oral proceedings in Haar.
- IV. With letter of 21 December 2022, the appellant requested that the oral proceedings be held by videoconference. No reasons were given for this request.
- V. The Board then issued a communication containing its provisional opinion, in which it indicated *inter alia* that the opposition ground under Article 100(c) EPC was considered to be prejudicial to maintenance of the patent as granted and that claim 1 of the first to ninth auxiliary requests were considered not to fulfil the requirement of Article 123(2) EPC. The parties were also informed that if the Board found it appropriate to do so, the oral proceedings might be held by videoconference. The parties were also asked to inform the Board if they wished to invoke any reasons against holding the oral proceedings by videoconference, for the case that the Board decided to use that format.

- VI. With letter dated 23 March 2023, the appellant filed new third to eighth auxiliary requests replacing its previous third to ninth auxiliary requests filed with the grounds of appeal. In the same letter, the appellant repeated its request for oral proceedings by videoconference and stated that it knew of no reason why the oral proceedings could not be held by videoconference.
- VII. The respondent invoked no reasons against holding oral proceedings by videoconference, but requested that the Board inform the parties as soon as possible if it decided to hold the oral proceedings by videoconference.
- VIII. Oral proceedings took place on the 25 April 2023 in person at the premises of the EPO in Haar.
- IX. Claim 1 of the main request reads as follows (with feature breakdown as seen in section C on pages 2 and 3 of the grounds of appeal):  
"1.1 A disposable diaper (1A,1B) comprising:  
a front waist region (5);  
a rear waist region (7);  
a crotch region (6) extending between said waist regions (5,7);  
a liquid-pervious topsheet (2) facing the wearer's skin;  
a liquid-impervious backsheets (3) facing away from the wearer's skin; and  
a liquid-absorbent core (4) interposed between said top- and backsheets (2,3);  
said diaper (1A,1B) being contoured by longitudinally opposite end portions (8) extending in a transverse direction (L) outside longitudinally opposite ends (4a) of said core (4) and transversely opposite side edge

portions (9) extending in a longitudinal direction (M) outside transversely opposite side edges (4b) of said core (4) wherein said front and rear waist regions (5,7) are connected to each other by means of fastening means when said diaper (1A,1B) is put on; and

**1.2** of said front and rear waist regions (5,7), at least said rear waist region (7) includes an elastically stretchable waist area (10) extending in the transverse direction (L) along its end (8) and

**1.3** elastically stretchable wing areas (11) extending outward from its transversely opposite side edge portions (9) in the transverse direction (L), said transversely opposite side edge portions (9) of said rear waist region (7) lying between said stretchable waist area (10) and said stretchable wing areas (11),

**1.4** the stretchable elasticity of said elastically stretchable waist area (10) being created by a tape-like first elastic member (16) contractibly attached to said waist region (7) along its end (8) and

**1.5** the stretchable elasticity of said elastically stretchable wing areas (11) being created by stretchy sheets (18) separately of said top- and backsheets (2,3), and

**1.6** the opposite side edge portions (9) of said rear waist region (7) being formed from transversely opposite side edge portions (2b) of said topsheet (2) and transversely opposite side edge portions (3b) of said backsheet (3);

characterized in that:

**1.7** said stretchable wing areas (11) have a transverse stretch stress higher than that of said stretchable waist area (10),

**1.8** the transversely opposite side edge portions (9) of said rear waist region (7) are substantially non-stretchable, and

**1.9** said stretchable waist area (10) is not fully stretched before said stretchable wing areas (11) are sufficiently stretched in the transverse direction (L), when said transverse stretch stresses are measured in accordance with methods as described in paragraphs [0045], [0046] and [0063] of the description."

- X. Claim 1 of the first and second auxiliary requests and claim 3 of the third and fourth auxiliary requests are annexed at the end of this decision.
- XI. The appellant's arguments relevant to the present decision may be summarised as follows:

*Main request - Article 100(c) EPC*

Feature 1.6

Paragraphs [0009],[0010],[0016] and [0022] of the published parent application provided a basis for the diaper defined in claim 1, in which transversely opposite side edge portions 9 did not necessarily comprise fixed side portions of the leak-barrier sheet.

Paragraph [0036] disclosed that side portions of the leak-barrier sheets were "attached to" the opposite side edge portions of the diaper, and were therefore

distinct from the opposite side edge portions of the diaper.

The omission of the leak-barrier sheets from feature 1.6 of granted claim 1 passed the three-point test for compliance with Article 123(2) EPC, as set out in T 331/87, since they were not described as being essential. The leak-barrier sheets were also not functionally linked to the side edge portions.

Feature 1.6 did not provide a technical contribution to the subject-matter of the claimed invention. It was thus not to be considered as subject-matter which extended beyond the content of the application as filed within the meaning of Article 100(c) EPC as decided in G 1/93.

*First and second auxiliary requests - Article 123(2) EPC*

Paragraphs [0024] and [0028] of the published divisional application (corresponding to the paragraphs [0023] and [0027] of the published parent application which were referred to during the oral proceedings) provided a basis for the leak barrier-sheets defined in claim 1 of the first and second auxiliary requests. Paragraph [0037] of the published divisional application (corresponding to paragraph [0036] of the published parent application which was referred to during the oral proceedings) provided a basis for the amendments made to claim 1 of the second auxiliary request.

The skilled person knew that the use of leak-barrier sheets had been common for at least thirty years and that there were several other ways of forming the side



portions besides the one described in the patent. It would thus be recognised that leak-barrier sheets could be omitted without altering the invention.

*Third and fourth auxiliary requests - Article 123(2) EPC*

The features of claim 3 of the third and fourth auxiliary request were not inextricably linked with the other features of paragraphs [0030] to [0033] of the published divisional application (corresponding to the paragraphs [0029] to [0032] of the published parent application), because they were well-known to the skilled person and from the cited prior art.

*Fifth to eighth auxiliary requests - admittance*

It was reasonable to wait for the preliminary opinion of the Board before filing any auxiliary requests to deal in particular with the objections to lack of clarity, as this allowed the appellant to file convergent requests that addressed the high number of complex objections.

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

*Main request - Article 100(c) EPC*

There was no disclosure of the side edge portions being made only by the topsheet and the backsheet.

Paragraphs [0009] and [0010] of the published parent application did not disclose anything regarding the composition of the transversely opposite side edge

portions and paragraph [0016] only concerned the effect of the invention.

Paragraph [0027] of the published parent application was the only positive disclosure regarding the transversely opposite side edge portions and this only provided a basis for transversely opposite side edge portions 9 also formed from fixed side portions of the leak-barrier sheets. This was also entirely consistent with the Figures.

The topsheet, backsheet and leak-barrier sheets were bonded together to form the side-edge portions. Therefore they were all structurally linked. Further, the leak-barrier sheets being connected to the topsheet and backsheet also contributed to the structural rigidity and force segmentation such that there was also a structural and functional link between them.

*First and second auxiliary requests - Article 123(2)  
EPC*

The amendments to claim 1 of auxiliary requests 1 and 2 did not overcome the objection made under Article 123(2) EPC regarding feature 1.6 of the main request.

*Third and fourth auxiliary requests - Article 123(2)  
EPC*

Dependent claim 3 of the third and fourth auxiliary requests was extracted from its original context in paragraphs [0030] to [0033] of the published divisional application (corresponding to the paragraphs [0029] to [0032] of the published parent application ) and constituted unallowable intermediate generalizations.

*Fifth to eighth auxiliary requests - admittance*

The fifth to eighth auxiliary requests were a late and unjustified amendment to the appellant's appeal case and should not be admitted.

**Reasons for the Decision**

1. Request for oral proceedings by videoconference
  - 1.1 The Board summoned the parties to oral proceedings at the EPO premises.
  - 1.2 The appellant had however requested that the oral proceedings be held by videoconference with its letters dated 21 December 2022 and 23 March 2023 but had not given any arguments as to why the oral proceedings should take place by videoconference. At the beginning of the oral proceedings before the Board, the Chairman addressed this issue and the appellant made no further arguments in this regard.
  - 1.3 According to Article 15a(1) RPBA 2020, the Board may decide to hold oral proceedings by videoconference if the Board considers it appropriate to do so, either upon request by a party or of its own motion.
  - 1.4 From the expression "if the board considers it appropriate", it is evident that the Board has discretion to decide whether to hold oral proceedings by videoconference or not. Nevertheless, the Board is of the view that the Enlarged Board of Appeal decision G 1/21 puts certain limits on how this discretion is to be exercised.

- 1.5 When interpreting Article 15a RPBA 2020, it must be borne in mind that provisions of the Rules of Procedure of the Boards of Appeal are to be interpreted in a way that is compatible with the spirit and purpose of the Convention (cf. Article 23 RPBA 2020).
- 1.5.1 The Enlarged Board of Appeal set out in G 1/21 the conditions under which a party's request for in-person proceedings may be denied. Accordingly, it set out principles which follow from the spirit and purpose of the Convention and which must therefore be taken into account when exercising discretion under Article 15a RPBA 2020. The fact that Article 15a RPBA 2020 was not referred to specifically is of no relevance, since the Enlarged Board's decision was of a fundamental nature when exercising discretion on the issue of whether to hold oral proceedings via videoconference or not. Moreover it is noted that Article 15a RPBA 2020 could easily be interpreted in a restrictive manner so that it is compatible with the principles of G 1/21, which is anyway the mode of interpretation foreseen in Article 23 RPBA 2020.
- 1.5.2 Of course G 1/21 is to a large degree directed to the situation of a general emergency (such as the pandemic situation prevailing at the time of its issue), but the overall understanding of the right to oral proceedings as provided for in the EPC underlying this decision is clearly derivable from the general considerations contained in the Reasons of that decision. As detailed below, the Enlarged Board's basic reasoning used in arriving at its final conclusion is quite general and unrelated to any general emergency considerations.

1.6 In a recent case, the view has been expressed with regard to Article 15a RPBA 2020 that the exercise of discretion in deciding on the format of the oral proceedings was to be based on the criterion of the "appropriateness" of the format only - as set out in that provision -, and that no further criteria are binding for the exercise of discretion (see T 0618/21, point 2.3.1b)ii) of the Reasons). In the present Board's view, however, G 1/21 has established general criteria which need to be taken into account for the denial of a request for in-person oral proceedings, which apply not only to a situation of general emergency, but are valid also in non-emergency times.

1.7 G 1/21 states that in-person oral proceedings are the optimum format and that videoconferences - at least according to the current state of technology - do not meet this standard, i.e. **are not equivalent** to in-person oral proceedings. This is explicitly stated in G 1/21 at several junctures such as:

- point 44 of the Reasons:  
"..oral proceedings by videoconference are oral proceedings within the meaning of Article 116 EPC and, although not fully equivalent to oral proceedings held in person.."
  
- point 38 of the Reasons:  
".. communicating via videoconference cannot, at least for the time being, be put on the same level as communicating in-person.";  
"In terms of communication, in-person oral proceedings are for now the optimum format.";  
"Video technology has certainly improved in recent times, but cannot yet be said to provide the level of communication which is possible when all

participants are physically present in the same room."

- point 45 of the Reasons:

"As stated earlier, a hearing in person is the optimum format or, to use a term well known in the field of European patent law, it is the gold standard.";

"Therefore, in-person hearings should be the default option";

"Parties should only be denied this option for good reasons."

- point 46 of the Reasons:

".. at this point in time videoconferences do not provide the same level of communication possibilities as in-person oral proceedings."

1.8 Not least from the general applicability of the statements above, it is evident that this holds true regardless of the existence of an emergency situation, i.e. even in 'normal times'. The present Board considers this to be the key *ratio (ratio decidendi)* underlying G 1/21, the validity of which is not limited to any emergency situation.

The Board thus concludes that the *ratio decidendi* underlying G 1/21 at least in regard to a party's request for in-person oral proceedings cannot be simply assigned to situations of general emergency but are instead generally valid.

1.9 Due to the deficiencies in the level of communication in a videoconference compared to in-person oral proceedings, the Enlarged Board of Appeal came to the conclusion that only in a situation of general

emergency *impairing the parties' possibilities to attend in-person oral proceedings at the EPO premises* (cf. wording of the order of G 1/21) is it (exceptionally) possible to deny a party's wish to have in-person oral proceedings.

- 1.9.1 Although the concept of a situation of general emergency was thus already defined quite narrowly (indeed even restricted to those situations impairing the parties' possibilities to attend in-person oral proceedings at the EPO premises), the Enlarged Board explained by way of example which criteria are to be used in the exercise of discretion and which should in any case play no role (cf. *ibid.*, point 49 of the Reasons: "This decision should not be influenced by administrative issues such as the availability of conference rooms and interpretation facilities or intended efficiency gains.").
- 1.9.2 It follows from the above that even in the circumstances of a general emergency, the Enlarged Board of Appeal still imposed strict conditions on the possibility of denying a party's wish to hold oral proceedings in-person. *A fortiori*, it is therefore hardly justifiable why less strict requirements could apply for denying parties in-person oral proceedings in non-emergency times, in particular considering that the Enlarged Board found that videoconferences offer suboptimal communication possibilities compared to in-person hearings, that there are currently no obstacles for the parties and the members of the Board to attend the oral proceedings on EPO premises and that the Enlarged Board acknowledged in principle the parties' right to choose the format of oral proceedings (cf. *ibid.*, point 46 of the Reasons).

In addition, it must be borne in mind that the Enlarged Board justified the denial of in-person oral proceedings in order to avoid the administration of justice being seriously impaired during a pandemic (cf. *ibid.*, point 51 of the Reasons). However, comparable risks do not exist in non-emergency times. The Board therefore can only understand the decision in such a way that, in principle, oral proceedings in person can exceptionally be denied in a situation of general emergency in order to prevent serious impairment of the administration of justice.

- 1.10 In summary, the following can therefore be stated:
  - 1.10.1 Although the order of G 1/21 refers to an emergency situation, it follows from the *ratio decidendi* of this decision that in-person oral proceedings can only be denied under very limited conditions, even in a situation of general emergency such as a pandemic.
  - 1.10.2 Due to the fact that videoconferences, at least according to current technology, can only provide a suboptimal form of communication, parties have a right to the optimum format for oral proceedings, i.e. in-person oral proceedings, that can only be denied under very limited conditions.
  - 1.10.3 Further, *e contrario* it also follows from the reasons underlying the Enlarged Board's decision, that parties do not have a right to a format having deficiencies (e.g. the "shortcomings" of such a format as mentioned in G 1/21, point 40 of the Reasons), i.e. parties cannot force Boards to conduct videoconferences instead of in-person oral proceedings.



1.11 Hence, in a non-emergency situation, such as in the present case before the Board, where the parties are able to travel and no other restrictions exist (see G 1/21, point 49 of the Reasons), the general considerations underlying G 1/21 are to be taken into account.

It can be added that, in the present case the appellant also did not invoke any reasons which would have prevented it from attending the oral proceedings in person, and indeed it was able to do so.

1.12 As stated in G 1/21 (see e.g. points 38, 45 and 46 of the Reasons), a hearing in person is for now "the optimum format, or to use a term well known in the field of European patent law, it is the gold standard". Although oral proceedings by videoconference have proven suitable in many cases, albeit with certain disadvantages (which may depend on several factors, for example sometimes lasting longer than oral proceedings in person and requiring several hours of staring at screens leading to fatigue, etc.) that format has nevertheless regularly been used by the present Board where the parties consent to same. Nevertheless, the Board concludes that communicating via videoconference cannot, at least for the time being, be put on the same level as communicating in person.

1.12.1 In particular, the Board cannot recognise any improvements that can be said to provide the level of communication which is possible when all participants are physically present in the same room.

1.12.2 Unlike found in T 758/20 (cf. point 1.4.7(b) of the Reasons) and further elucidated in T 618/21 (cf. point 4.1.3 to 4.1.5 of the Reasons), this Board finds that

the situation for the time being has not changed since the issue of G 1/21.

1.12.3 Here it is first noted that in G 1/21 (cf. point 46 of the Reasons) the Enlarged Board held that "at this point in time" videoconferences did not provide the same level of communication possibilities as in-person oral proceedings. The point in time referred to by the Enlarged Board (G 1/21 bears the date 16 July 2021 and was issued on 28 October 2021), was thus the time when the use of "ZOOM" (i.e. the current platform still used by the Boards) had already been introduced. Furthermore, even the Enlarged Board itself used it for part of the proceedings in G 1/21 (see e.g. the summons to oral proceedings dated 1 June 2021 stating specifically that the "ZOOM" platform would be used).

1.12.4 As such, the parties rely on the same kind of hardware and software as were available at the time of G 1/21, i.e. the picture and sound quality is basically the same. The Board cannot recognize any significant improvement in the oral or visual level of communication between the parties that would result, for example, in an increased "immediacy" to the level of oral proceedings in person. The technological developments in telecommunications which may bring about this level of communication are still awaited. Some communication aspects of body language and expression, are often difficult or simply impossible to discern on camera, not least due to the limited field of view and image quality available, often only the party's face or head and shoulders being visible and the image of all parties contributing becoming even smaller as the number of parties increases. Whilst not necessarily affecting the right to be heard, these type of issues may well affect the immediacy and smooth

running of the oral proceedings which itself may cause distraction for the Board and the parties. Likewise, when interpreters are present, for example in two or three language directions, then the technology has a significant lag which again reduces immediacy even further. The advantages of the gold standard thus remain as they were at the time of decision G 1/21.

1.12.5 In addition, although the Boards have had the time and opportunity to familiarise themselves with the tools necessary for videoconferencing, this was also true at the time of issue of G 1/21. In some cases, the parties may also have acquired such familiarisation themselves, albeit some may only have recourse to videoconference oral proceedings sporadically. Obviously the Boards should ensure that factors such as the level of familiarity/experience with a particular software as such should not put a party at a disadvantage. If the parties themselves request oral proceedings by videoconference, or consent thereto, it can generally be assumed that they accept any such shortcomings that exist.

1.13 In the present case, one party requested oral proceedings by videoconference. Thus, it is necessary to consider Reasons point 46 of G 1/21, where it is stated that "The vast majority of oral proceedings are held upon request by a party. It therefore makes sense that the choice of format for these oral proceedings can be made by a party who requested them and not by the board of appeal."

1.14 For the reasons discussed under item 1.10.3 above, the "choice of format" of oral proceedings via videoconference cannot be limiting on the Board, which may always decide to hold the proceedings in person.

This is exactly the situation in the present case, where the Board, despite the request of one party did not accede to that request and maintained the format of oral proceedings as indicated in the summons, i.e. "in-person". Whilst the Board accepts that if there are no objections to holding the proceedings via videoconference, or if all parties request this, the Board can exercise its discretion to hold the oral proceedings via videoconference (as regularly happens), notwithstanding the fact that the Board must additionally consider it "appropriate to do so" (also stated in Article 15a RPBA 2020) when selecting the format.

- 1.15 In the present case, and despite the party's request, the Board found that in the circumstances of the case, and in particular in regard to the substantive issue of the "side portions" and the structural and functional aspects regarding the inclusion of the leak barrier sheets in a flexible and elastically stretchable area of the product where the "side portions" were located, the parties may well (as is often the case in the Board's experience in such technology) have resorted to detailed explanations revolving around the Figures of the published divisional and parent applications during the oral proceedings, including the movements and relative movements of various parts during wearing. Of course, it could be argued (as the Board did in T 618/21) that a party wishing to refer to such matters could simply file adapted drawings in advance. Notwithstanding the additional work required from both the Board and the other party(ies) in this regard however, experience of appeal cases in the technical field of the case in question has shown that a party wishing to explain functional effects of structural features can often do this more easily by use of the

flip chart, gradually building up features whilst explaining them in a dynamic situation of use, and of course allowing the same sketches to be used by the opposing party(ies). Likewise, filing such sketches by email during a videoconference oral proceedings, results in further delays as these are received and then distributed further by another email amongst the Board and parties (and often the interpreters), which may well break the flow of a party's submissions and which inevitably (when being displayed) reduces other available screen space used for documents or for viewing the parties. The Board also notes that the appellant itself argued that there were a high number of complex objections to be dealt with (see also point 5.3 below). Therefore, the complexity of the case also spoke for oral proceedings in person.

- 1.16 For the reasons discussed above, the Board did not change the format of the oral proceedings, which remained as summoned.
  
2. Main request - Article 100(c) EPC  
  
Feature 1.6 of claim 1
  
- 2.1 The following feature (feature 1.6) was added to claim 1 during examination:  
  
- the opposite side edge portions (9) of said rear waist region (7) being formed from transversely opposite side edge portions (2b) of said topsheet (2) and transversely opposite side edge portions (3b) of said backsheet (3).
  
- 2.2 The appellant argued that paragraphs [0009], [0010], [0016] and [0022] of the published parent application

provided a basis for the diaper defined in claim 1, in which (unlike paragraph [0027]) the transversely opposite side edge portions 9 do not necessarily comprise fixed side portions of the leak-barrier sheet.

The Board does not accept this argument. There is no disclosure of opposite side edge portions formed only by a topsheet and a backsheet. Paragraphs [0009] and [0010] constitute a disclosure of a diaper according to the invention with the features of claim 1 as filed, but not with all the further features of claim 1 as granted. These two paragraphs concern the arrangement of different areas, regions and portions of a diaper and do not disclose anything about the composition of the side edge portions, i.e. whether they are formed by any sheets such as the topsheet, backsheet or leak-barrier sheets.

Similarly, paragraph [0016] is concerned with the functional effect which is achieved by the side edge portions (which can generally speaking be explained as being to segmentalize and restrain the tensile force exerted on the stretchable wing areas) but which does not disclose any way in which the side edge portions are actually composed.

Paragraph [0023] also does not disclose anything regarding the structure of the side edge portions being formed by a topsheet and a backsheet, and simply discloses that a pair of leak barrier-sheets are attached at the side edge portions of the diaper. None of these paragraphs, however, disclose opposite side portions formed by a topsheet and a backsheet.

Only paragraph [0027] addresses specifically the composition of the side edge portions of the embodiment

and this paragraph discloses side edge portions being made of transversely opposite side edge portions of a topsheet, transversely opposite side edge portions of a backsheet and fixed side portions of the leak-barrier sheets. This is the only positive disclosure regarding the composition of the side edge portions.

There is thus no explicit basis in the originally filed application for feature 1.6, i.e. for more general opposite side portions consisting only of a topsheet and a backsheet, without leak-barrier sheets.

- 2.3 The appellant also argued that feature 1.6 was an inevitable consequence of the claim. According to the appellant, a skilled person considering at least features 1.1 and 1.3 of claim 1 as filed would derive directly and unambiguously that the opposite side edge portions of the diaper are formed by transversely opposite side edge portions of the topsheet and transversely opposite side edge portions of the backsheet, in the front waist region, in the rear waist region and in the crotch region of the diaper, irrespective of other components (such as leak-barrier sheets) being present or not.

This argument is not convincing. Features 1.1 and 1.3 define the position of the transversely opposite side edge portions in relation to the other components of the diaper such as the core, the stretchable waist area and the stretchable wing areas. They do not define anything in regard to the composition of the transversely opposite side edge portions from which the skilled person could derive that the side edge portions are formed by opposite side edge portions of the topsheet and of the backsheet.

2.4 The appellant also argued that the leak barrier sheets were not an essential feature for the functioning of the diaper and were not functionally linked to the other sheets. Further, the omission of the "leak-barrier sheets" from feature 1.6 of granted claim 1 passed the three-point test for compliance with Article 123(2) EPC, as set out in T 331/87.

2.4.1 The Board is not persuaded by these arguments either. First, the topsheet, backsheet and leak-barrier sheets are overlapped and bonded together to form the side edge portions. They are thus structurally linked. Further and as stated in paragraph [0027], this bond contributes to making the side edge portions non-stretchable, which is determinant in segmentalizing and restraining the tensile force exerted on the stretchable wing areas, as explained in paragraph [0016]. The leak-barrier sheets are therefore also functionally linked to the topsheet and the backsheet to render the side edge portions non-stretchable and to achieve this segmentalization. The leak-barrier sheets are therefore functionally and structurally linked to the other sheets.

2.4.2 As to the appellant's argument that the leak-barrier sheets were not presented in the application as filed as essential, the Board finds that this is not the relevant standard for assessing whether an amendment fulfils the requirement of Article 123(2) EPC.

In its decision G 2/10, and summarising long standing case law of the Boards of Appeal, the Enlarged Board of Appeal found that the test to be applied is whether the skilled person would, using common general knowledge, regard the claimed subject-matter as explicitly or implicitly, but directly and unambiguously, disclosed



in the (parent) application as filed (Reasons 4.5.4). This is commonly referred to as the "gold standard" when considering amendments.

The appellant did not provide any reasons why the Board should deviate from this standard, such that any other test can only assist in answering the relevant issue, but not substitute it. In this sense, the so-called "essentiality test" according to T 331/87 was found to be potentially in contradiction with the "gold standard" (see e.g. T 1852/13, Reasons 2.2.3) and the Board also does not see a reason to use it here. The degree of relevance/essentiality is thus not relevant for assessing whether an amendment introduces subject-matter which extends beyond the content of the application as filed or not.

- 2.5 The appellant also argued that paragraphs [0023] and [0036] disclosed the leak-barrier sheets as being attached to the opposite side edge portions of the diaper, which was distinct from being part of the opposite side edge portions of the diaper.

However, the Board sees no contradiction here. The skilled person reading the description understands that the side edge portions of a diaper represent locations (i.e. in the area of the side edges) of a diaper such that any component of the diaper which extends into or crosses these locations (side edge areas) is also considered to form part of them.

- 2.6 The appellant further argued that feature 1.6 was a well-known feature that did not add to the technical contribution of claim 1 and merely limited the protection conferred. As a consequence, by virtue of the decision G 1/93, the maintenance of the patent

should not be prejudiced by the inclusion of feature 1.6, even if this feature was found not to be originally disclosed.

The Board does not accept this argument. Feature 1.6 defines the components that build the side edge portions (and which contribute to segmentalizing and restraining the tensile force (as discussed above under point 2.4.1)). Therefore, the feature makes a technical contribution to the claimed subject-matter and does not fall under the exception of G 1/93.

2.7 Lastly, the appellant argued that because leak barrier sheets had been well known to the skilled person for some 30 years, a skilled person would know that they could be omitted or included merely as an option, whereby the skilled person would recognise side portions in the patent as being both with or without these sheets. Again, however, the mere fact that they are known does not mean that they can be included or excluded in every circumstance. As mentioned above, paragraph [0027] is the only description of how the side portions are formed, in this case including the leak barrier sheets. Whether, in the particular case at hand, the skilled person would recognise implicitly that they could be omitted is simply unknown. There is certainly no statement to that effect, and the structural nature of the side portions as explained above is only disclosed in their presence. Whether it would be obvious or not to remove the leak barrier sheets is also not a relevant criteria when deciding this issue.

2.8 The amendments made to claim 1 before grant do therefore result in subject-matter which extends beyond the content of the parent application as originally

filed, such that the ground for opposition under Article 100(c) EPC is prejudicial to maintenance of the patent. Thus, the main request is not allowable.

3. First and second auxiliary requests - Article 123(2) EPC

3.1 Claim 1 of auxiliary request 1 has been amended with regard to claim 1 of the main request *inter alia* by the introduction of the following features:

- a pair of leak-barrier sheets (12) being attached to the opposite side edge portions (9) so as to extend in the longitudinal direction; and

- [in that the opposite side edge portions (9) of said rear waist region (7) are also formed from] respective fixed side portions (12a) of the leak-barrier sheets (12) extending outward in the transverse direction beyond transversely opposite side edges (4b) of the core (4).

3.2 The appellant argued that paragraphs [0024] and [0028] of the published divisional application (corresponding respectively to the paragraphs [0023] to [0027] of the published parent application which were referred to during the oral proceedings) provided a basis for these amendments.

The Board does not accept this. Paragraph [0028] of the published divisional application not only discloses that the opposite side edge portions of said rear waist region are formed from respective fixed side portions states but further that these fixed side portions 12a of the leak-barrier sheets "will be described later". Paragraph [0028] of the published divisional

application and subsequent paragraphs, such as paragraph [0037] (which corresponds to paragraph [0036] of the published parent application referred to during the oral proceedings), describe these portions and the manner in which they are arranged with the side edge portions more specifically. In this regard, it should be remembered that the description paragraphs referred to are all related to a single embodiment, with a large number of structurally and functionally interconnected features.

3.3 Somewhat similar to its argument on the main request, the appellant further argued that the skilled person knew that leak-barrier sheets had been common for some thirty years and that, because of this, there were several other alternative methods of attachment besides the one described in paragraph [0037] of the published divisional application. The skilled person would then allegedly understand that the arrangement described in paragraph [0037] was optional.

3.3.1 This argument is also not persuasive. Whilst it may be true that leak-barrier sheets made in a variety of ways may have been known in the prior art, the test to be applied is whether the skilled person would, using common general knowledge, regard the claimed subject-matter as explicitly or implicitly, but directly and unambiguously, disclosed in the divisional application as filed (see point 2.4.2 above).

In the same way as found above for claim 1 of the main request that the parent application only directly and unambiguously discloses side edge portions formed with the inclusion of leak-barrier sheets, the parent and divisional applications as originally filed do not disclose any other arrangement of leak barrier sheets

besides the one in paragraph [0037] of the published divisional application, nor is it stated that this arrangement is optional or otherwise not relevant. The skilled person reading the divisional application as a whole would only directly and unambiguously derive leak-barrier sheets attached according to the sole embodiment described in this regard, to which paragraph [0037] also belongs.

3.3.2 Claim 1 of auxiliary request 2 has been amended with regard to claim 1 of auxiliary request 1 by the introduction of the following features:

- the leak-barrier sheets (12) respectively have fixed side portions (12a) extending between the front and rear waist regions (5, 7) in the longitudinal direction along the opposite side edge portions (9), movable portions (12b) normally biased to rise up above the topsheet (2) and extending between the front and rear waist regions (5, 7) in the longitudinal direction and longitudinally opposite fixed end portions (12c) lying on the longitudinally opposite end portions (8), respectively, and collapsed inward in the transverse direction of the diaper;

3.4 The appellant argued that paragraph [0037] of the published divisional application provided a basis for these amendments.

The Board is not persuaded by this argument. The leak-barrier sheets described in paragraph [0037] are much more specific and include, for example, that the fixed end portions 12c are permanently bonded to the outer surface of the respective end portions 2a of the topsheet 2 or that elastic members 28 extending in the longitudinal direction are contractibly attached to the

movable portions 12b in the vicinity of distal ends of these movable portions 12b wherein each of the elastic members 28 is wrapped with a part of the movable portion 12b and intermittently and permanently bonded to the movable portions 12b by means of adhesive.

None of these aspects is defined as a feature of claim 1 of auxiliary request 2. No other basis was given for omitting these aspects, such that the Board concludes the amendment extends beyond the content of the application as filed.

3.5 At least for this reason, the subject-matter of claim 1 of auxiliary requests 1 and 2 does not fulfil the requirement of Article 123(2) EPC. Auxiliary requests 1 and 2 are not allowable.

4. Third and fourth auxiliary requests - Article 123(2) EPC

4.1 Claim 3 of the third and fourth auxiliary requests reads as follows:

"The diaper according to Claim 1 or 2, wherein said stretchy sheets (18) each comprise a pair of breathable hydrophobic fibrous nonwoven fabric layers (20) and a breathable liquid-impervious stretchy plastic film (21)-sandwiched between the nonwoven fabric layers (20), the nonwoven fabric layers (20) being formed with a plurality of gathers rising and falling in the thickness direction of the diaper (1A), and the nonwoven fabric layers (20) and the film (21) having respective surfaces opposed one to another which overlap and are intermittently bonded one to another at a plurality of heat-sealing spots rather evenly distributed in a dotted pattern, the bonding of the

nonwoven fabric layers (20) to the film (21) being achieved using a welding technique such as heat-sealing or sonic sealing, or intermittently bonded together using adhesive."

4.2 Dependent Claim 3 of the third and fourth auxiliary requests corresponds to claim 3 as granted. This dependent claim was introduced during prosecution of the application. The Board had addressed this objection already in the Board's communication under Article 15(1) RPBA 2020 (see point 2.2).

4.3 The appellant argued that paragraphs [0030] and [0031] of the published divisional application (which correspond to paragraphs [0029] and [0030] of the published parent application referred to during the oral proceedings) provided a basis for this claim. Further, the appellant argued that paragraphs [0031] and [0034] of the published divisional application (which correspond to paragraphs [0030] and [0033] of the published parent application) disclosed alternative arrangements of wing areas such that the skilled person would understand that the disclosure of paragraphs [0031] and [0032] was one of several options and thus could be claimed as a dependent claim.

These arguments are not persuasive. Whilst the skilled person reading the description would recognize that paragraphs [0031] and [0034] of the published divisional application belonged to alternative arrangements of wing areas, the wing areas disclosed in paragraphs [0031] and [0032] form a disclosure of more specific wing areas 11 together with paragraph [0030], the content of which is not reflected in the dependent claim. No other basis for its omission was proffered. Without such features, the

subject-matter is an unallowable intermediate generalization of the content of the application as originally filed.

4.4 Leaving the question of admittance of the third and fourth auxiliary requests aside (the admittance of these requests into the appeal proceedings having been contested by the respondent), the subject-matter of claim 3 of the third and fourth auxiliary requests does not fulfil the requirement of Article 123(2) EPC for the reasons stated above. The third and fourth auxiliary requests are thus not allowable.

5. Fifth to eighth auxiliary requests - admittance

5.1 The fifth to eighth auxiliary requests were filed with letter dated 23 March 2023 in an amendment to the appellant's appeal case made after the summons to oral proceedings.

5.2 The Board considered whether to admit the amendments in light of Article 13(1) RPBA 2020, which stipulates that any amendment to a party's appeal case may be admitted only at the Board's discretion. This discretion is to be exercised in view of, *inter alia*, the current state of the proceedings, whether the amendment is detrimental to procedural economy, the suitability of the amendment to resolve the issues which were admissibly raised and whether the party has demonstrated that any such amendment, *prima facie*, overcomes the issues raised by another party in the appeal proceedings or by the Board and does not give rise to new objections.

5.3 The appellant argued (orally) that it was reasonable to wait for the preliminary opinion of the Board in this



case, as this would allow the appellant to file convergent requests addressing the large number of complex objections. It also argued that it considered the risk of not overcoming an objection was higher than the risk of not having a request admitted.

- 5.3.1 Again, these arguments are not persuasive. The respondent replied to the statement of grounds of appeal in a letter dated 6 March 2020, in which it already raised all the objections to the auxiliary requests which the Board then addressed in its preliminary opinion, including *inter alia* the clarity objection regarding the expressions "effectively utilized" and "appropriately constrict" (see point 4.4.1 of that opinion).
- 5.3.2 According to the established Case Law of the Boards of Appeal, even when considering the previous RPBA 2007 (see Case Law Book, 10th Edition, section V.A.5.4.2a)), parties are expected to react at the earliest possible moment for reasons of procedural economy and an amendment at a late stage in the proceedings is justifiable if it is an appropriate and immediate reaction to unforeseeable developments in the previous proceedings which do not lie in the responsibility of the party submitting the amendment. The revised RPBA 2020 further reinforce the importance of procedural economy.
- 5.3.3 Given that all the objections and arguments were already presented with the complete case of the respondent in its reply dated March 2020 at the latest, even if the Board were to agree that the subject-matter is complex and that there are a large number of objections, the Board finds that the appellant had ample time (in the present case approximately three

years) to consider and address these issues before issue of the summons, and should certainly have done so before issue of the Board's communication under Article 15(1) RPBA 2020.

Moreover, these new requests contain extensive amendments (not just related to overcoming the lack of clarity objections) raising new issues which the respondent, on the other hand, had only about a month to consider.

5.3.4 Further, the Board cannot find any reason that might have justified the appellant waiting for the Board's preliminary opinion and notes that there is no absolute requirement to file convergent requests and that this may even be inappropriate depending on the specific circumstances of the case.

5.4 For all the above reasons, the Board exercised its discretion under Article 13(1) RPBA 2020 not to admit the fifth to eighth auxiliary requests into the proceedings.

## **Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:



D. Grundner

M. Harrison

Decision electronically authenticated

Claim 1 of the first auxiliary request

**Auxiliary Request 1**

1. A disposable diaper (1A, 1B) comprising:

a front waist region (5);

a rear waist region (7);

a crotch region(6) extending between said waist regions(5,7);

a liquid-pervious topsheet (2) facing the wearer's skin; a

liquid-impervious backsheets (3) facing away from the wearer's skin, and a liquid-absorbent core (4) interposed between said top- and backsheets (2,3);

said diaper (1A,1B) being contoured by longitudinally opposite end portions (8) extending in a transverse direction(L) outside longitudinally opposite ends (4a) of said core (4) and transversely opposite side edge portions (9) extending in a longitudinal direction(M) outside transversely opposite side edges (4b) of said core (4) wherein said front and rear waist regions (5,7) are connected to each other by means of fastening means when said diaper (1A,1B) is put on; and

of said front and rear waist regions (5,7), at least said rear waist region (7) includes an elastically stretchable waist area (10) extending in the transverse direction (L) along its end (8) and elastically stretchable wing areas (11) extending outward from its transversely opposite side edge portions (9) in the transverse direction (L), said transversely opposite side edge portions (9) of said rear waist region (7) lying between said stretchable waist area (10) and said stretchable wing areas (11);

the stretchable elasticity of said elastically stretchable waist area (10) being created by a tape-like first elastic member (16) contractibly attached to said waist

region (7) along its end (8) and the stretchable elasticity of said elastically stretchable wing areas (11) being created by stretchy sheets (18) separately of said top- and backsheets (2,3),

a pair of leak-barrier sheets (12) being attached to the opposite side edge portions (9) so as to extend in the longitudinal direction;

and the opposite side edge portions (9) of said rear waist region (7) being formed from transversely opposite side edge portions (2b) of said topsheet (2), transversely opposite side edge portions (3b) of said backsheet (3) and respective fixed side portions (12a) of the leak-barrier sheets (12) extending outward in the transverse direction beyond transversely opposite side edges (4b) of the core (4); characterised in that:-

said stretchable wing areas(11) have a transverse stretch stress higher than that of said stretchable waist area(10), the transversely opposite side edge portions (9) of said rear waist region (7) are substantially non-stretchable, and said stretchable waist area (10) is not fully stretched before said stretchable wing areas (11) are sufficiently stretched in the transversely direction(L),when said transverse stretch stresses are measured in accordance with methods as described in paragraphs [0045] and, [0046] and [0063] of the description.

Claim 1 of the second auxiliary request

**Auxiliary Request 2**

1. A disposable diaper (1A, 1B) comprising:

a front waist region (5);

a rear waist region (7);

a crotch region(6) extending between said waist regions(5,7);

a liquid-pervious topsheet (2) facing the wearer's skin; a

liquid-impervious backsheet (3) facing away from the wearer's skin, and a

liquid-absorbent core (4) interposed between said top- and backsheets (2,3);

said diaper (1A,1B) being contoured by longitudinally opposite end portions (8) extending in a transverse direction(L) outside longitudinally opposite ends (4a) of said core (4) and transversely opposite side edge portions (9) extending in a longitudinal direction(M) outside transversely opposite side edges (4b) of said core (4) wherein said front and rear waist regions (5,7) are connected to each other by means of fastening means when said diaper (1A,1B) is put on; and

of said front and rear waist regions (5,7), at least said rear waist region (7) includes an elastically stretchable waist area (10) extending in the transverse direction (L) along its end (8) and elastically stretchable wing areas (11) extending outward from its transversely opposite side edge portions (9) in the transverse direction (L), said transversely opposite side edge portions (9) of said rear waist region (7) lying between said stretchable waist area (10) and said stretchable wing areas (11);

the stretchable elasticity of said elastically stretchable waist area (10) being

created by a tape-like first elastic member (16) contractibly attached to said waist region (7) along its end (8) and the stretchable elasticity of said elastically stretchable wing areas (11) being created by stretchy sheets (18) separately of said top- and backsheets (2,3),

a pair of leak-barrier sheets (12) being attached to the opposite side edge portions (9) so as to extend in the longitudinal direction;

the leak-barrier sheets (12) respectively having fixed side portions (12a) extending between the front and rear waist regions (5, 7) in the longitudinal direction along the opposite side edge portions (9), movable portions (12b) normally biased to rise up above the topsheet (2) and extending between the front and rear waist regions (5, 7) in the longitudinal direction and longitudinally opposite fixed end portions (12c) lying on the longitudinally opposite end portions (8), respectively, and collapsed inward in the transverse direction of the diaper;

and the opposite side edge portions (9) of said rear waist region (7) being formed from transversely opposite side edge portions (2b) of said topsheet (2), transversely opposite side edge portions (3b) of said backsheet (3) and respective fixed side portions (12a) of the leak-barrier sheets (12) extending outward in the transverse direction beyond transversely opposite side edges (4b) of the core (4); characterised in that:-

said stretchable wing areas(11) have a transverse stretch stress higher than that of said stretchable waist area(10), the transversely opposite side edge portions (9) of said rear waist region (7) are substantially non-stretchable, and

said stretchable waist area (10) is not fully stretched before said stretchable wing areas (11) are sufficiently stretched in the transversely direction(L),when said transverse stretch stresses are measured in accordance with methods as described in paragraphs [0045] and, [0046] and [0063] of the description.

Claim 3 of the third and fourth auxiliary requests

3. The diaper according to Claim 1 or 2, wherein said stretchy sheets (18) each comprise a pair of breathable hydrophobic fibrous nonwoven fabric layers (20) and a breathable liquid-impervious stretchy plastic film (21) sandwiched between the nonwoven fabric layers (20), the nonwoven fabric layers (20) being formed with a plurality of gathers rising and falling in the thickness direction of the diaper (1A), and the nonwoven fabric layers (20) and the film (21) having respective surfaces opposed one to another which overlap and are intermittently bonded one to another at a plurality of heat-sealing spots rather evenly distributed in a dotted pattern, the bonding of the nonwoven fabric layers (20) to the film (21) being achieved using a welding technique such as heat-sealing or sonic sealing, or intermittently bonded together using adhesive.