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Boards of Appeal

Chambres de recours

Case Number: T 0500/95 - 3.2.2

D E C I S I O N
of 20 October 1998 correcting errors in the decision
of the Technical Board of Appeal 3.2.2
of 7 August 1998

Appellant: Mölnlycke AB
(Opponent) S-405 03 Göteborg (SE)

Representative: Hyltner, Jan-Olof
Norens Patentbyrå AB
P.O. Box 10198
100 55 Stockholm (SE)

Respondent: McNeil-PPC, Inc.
(Proprietor of the patent) Van Liew Avenue
Milltown
New Jersey 08850 (US)

Representative: Groening, Hans Wilhelm, Dipl.-Ing.
Boehmert & Boehmert
Franz-Joseph-Strasse 38
80801 München (DE)

Decision under appeal: Interlocutory decision of the Opposition Division
of the European Patent Office posted 10 April
1995 concerning maintenance of the European
patent No. 0 330 206 in amended form.

Composition of the Board:

Chairman: W. D. Weiß
Members: D. Valle
C. Holtz

In application of Rule 89 EPC the decision given on 7 August 1998 is hereby corrected as follows:

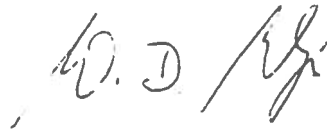
Page 10, in the "Order", point 2(b) third line, replace the year "1997" with the year "1998".

The Registrar:



N. Maslin

The Chairman:



W. D. Weiß

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D E C I S I O N
of 7 August 1998

Case Number: T 0500/95 - 3.2.2

Application Number: 89103203.9

Publication Number: 0330206

IPC: A61F 13/15

Language of the proceedings: EN

Title of invention:

Sanitary napkin having elastic shaping means

Patentee:

McNeil-PPC, Inc.

Opponent:

Mölnlycke AB

Headword:

-

Relevant legal provisions:

EPC Art. 54, 85, 123

Keyword:

"Claim 1 - clarity (yes)"
"Novelty (yes) (with amendments)"

Decisions cited:

G 0009/92, T 0161/82

Catchword:

-



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Summary of Facts and Submissions

I. The appellant (proprietor of the patent lodged an appeal on 14 June 1995 against the interlocutory decision of the Opposition Division dated 10 April 1995 to maintain the patent in an amended form. The fee for appeal was paid on the same day. The statement setting out the grounds of appeal was received on 21 August 1995.

II. Opposition was filed against the patent as a whole and based on Article 100(a) EPC (lack of novelty). This objection was based on document

D1: EP-B-0 183 668, and

for the designated Contracting States AT, BE, CH, DE, FR, GB, IT, LI, LU, NL and SE on the state of the art according to Article 54 (3), (4) EPC represented by document

D2: WO-A-88 04546.

III. During oral proceedings which took place before the Opposition Division a single amended version of the patent including an amended Claim 1 was submitted for all the Designated Contracting States. Claim 1 in this version reads as follows:

"1. A sanitary napkin comprising:

(a) an absorbent element (6; 106) having longitudinally extending sides (25; 125), transverse ends, a body-facing side covered by a fluid pervious member (130), and an undergarment facing side covered by a fluid impervious backing layer (140), and

(b) elastic means (30; 35; 105; 110) disposed in tension transversely across said absorbent element (6; 106) of said napkin (100; 200) at two opposing points (25; 125) on said longitudinally extending sides of said absorbent element (6; 106), and flaps (10; 119) extending laterally from each longitudinally extending sides (25; 125) of said absorbent element (6; 106), characterised in that said elastic means are additionally disposed within at least one of said flaps for configuring to fold over a side of a crotch portion of an undergarment."

IV. The Opposition Division, in the decision under appeal, found that this amended version met the requirements of Article 123(2) and (3) EPC, was clear in the meaning of Article 84 EPC and its subject-matter was novel in the meaning of Article 54(2) EPC and involved an inventive step in the meaning of Article 56 EPC having regard to document D1. It found, however, that its subject-matter was not novel within the meaning of Article 54(3)(4) EPC with respect to all the Designated Contracting States except Spain having regard to document D2.

V. On 7 July 1998, the appellant filed new claims 1 and 2 according to a main request and to an auxiliary request, respectively. The claims according to the main request, beside a minor modification of the form, are identical in substance to those on which the decision under appeal is based. Claim 1 according to the auxiliary request differs from that of the main request in that the term "the lateral extension of said flap being larger in a central portion thereof than at their edges" is added to feature (c) at its end and in that the words "characterised in that" are replaced by "wherein".

VI. The appellant requested that the decision under appeal be set aside and the patent be maintained, for Spain, as maintained by the Opposition Division in the decision under appeal, for the other designated states AT, BE, CH, DE, FR, GB, IT, LI, NL and SE, in accordance with the main request or - alternatively - in accordance with the auxiliary request, both submitted on 7 July 1998.

The respondent requested that the appeal be dismissed.

VII. The appellant argues as follows:

Concerning the main request, the addition of "flaps" in the main claim does not change the meaning of the claim, but it makes it only more clear. Regarding the novelty issue, document (D2) has the purpose to reduce leakage, see page 1, line 15, meanwhile the purpose of the invention is to attain an easy placement and removal of the napkin. Furthermore the napkin according to document (2) is designed to fold around the waist region of the panty, whereas the invention aims to achieve a folding in the crotch region. Finally the function of the elastic members is to give the absorbent body a tendency to curve inwards, whereas the invention does not know this function of the elastic elements.

According to the decision of the board of Appeal in T 161/82, if a feature disclosed in a prior document accidentally falls within the wording of a claim to be examined for novelty without there being a common technical feature problem, a particular careful comparison has to be made between what can fairly be considered to fall within the wording of the claim and what is effectively shown in said document.

Regarding the auxiliary submission, Article 123 EPC is fulfilled because the additional feature is disclosed in the drawings and it delimits the scope of the protection. The amendment contained in the auxiliary request is also supported by the statement in the description that the flaps fold over a side of a crotch portion of the undergarment (column 3, lines 19 and 20).

Flaps which extend from the rear or front edge like in document (D2) cannot be folded around the crotch portion.

Flaps projecting laterally from the center are acknowledged by document (D2) as representing the prior art. Document (D2) aims to overcome their drawbacks (bad accessibility). See page 1, lines 8 to 14.

The additional feature is also clear and has the technical effect of facilitating the removal of the napkin after use, see column 2, lines 23 to 30. The auxiliary submission is new having regard to the disclosure of document (D2) and distinguishes therefrom by the added feature. Document (D2) requires namely that the side flaps are made tapering from the upper end, see page 2, lines 25 to 27.

VIII. The respondent argues as follows:

Claims 1 according to both requests are unclear, since the patent does not disclose how the elastic means are to be affixed to the absorbent element. Moreover, the claims are rendered unclear with respect to the functional feature "for configuring to fold over a side of a crotch portion of an undergarment". The additional feature in Claim 1 according to the auxiliary request increases the lack of clarity even further.

Even if it were assumed that the additional feature in the auxiliary request renders the subject-matter of Claim 1 novel, this feature does not make any technical contribution to the problem to be solved when starting from the state of the art represented either by document (D1) or (D2).

Reasons for the Decision

1. The appeal is admissible.
2. *Extent of the power of the Board to decide upon the grounds of appeal*

Claims 1 and 2 according to the main request correspond to those which have been the basis for the decision under appeal.

The decision under appeal, in point 2 and 3 of the grounds, states that these claims meet the requirements of Articles 123(2) and (3) as well as of Article 84 EPC. Moreover in point 5 of the reasons, the decision under appeal states that these claims meet the requirements of novelty and inventive step within the meaning of Articles 52(1), 54(1)(2) and 56 EPC having regard to document (D1) (i.e. for Spain as designated State). According to point 4 of the grounds, however, the subject-matter of Claim 1 according to the present main request is not novel, on the ground of Article 54(3)(4) EPC with respect to document (D2), i.e. for the remaining designated state.

The respondent (opponent) has not appealed against these findings.

According to the decision of the Enlarged Board of Appeal G 9/92, headnote, point 1, if the patent proprietor is the sole appellant against an interlocutory decision maintaining a patent in amended form, neither the Board of Appeal nor the non-appealing opponent as a party to the proceedings may challenge the maintenance of the patent as amended in accordance to the interlocutory decision.

Consequently, the Board's power is limited to examining whether the Opposition Division was right in concluding that the subject-matter of Claim 1 according to the main request is novel having regard to document D2. With respect to Claim 1 according to the auxiliary request the Board may only examine whether the feature by which the auxiliary request is distinguished from the main request meets the formal requirements of Articles 123 and 84 EPC and whether this feature makes the claim novel over the state of the art as represented by document D2.

Any power exerted beyond this extent would mean to challenge the validity of the patent for Spain which is not allowed according to the cited decision of the Enlarged Board of Appeal.

3. *Amendments*

The feature: "(for configuring) the flaps" is disclosed in column 3, line 19 of the patent specification.

The feature: "the lateral extension of said flaps being larger in a central portion thereof that at their edges" is disclosed in the Figures 1 and 2.

Article 123(3) EPC is also met because the scope of the protection is narrowed.

Consequently, claims 1 of both submissions meet the requirements of Article 123 EPC.

4. *Article 84 EPC*

The addition of "flaps" in the main submission is made in order to increase clarity of the claim and it does not affect the meaning of the claim. Therefore claim 1 of the main submission is clear.

The feature in the auxiliary submission that the extension of the flaps is larger in the central portion is clear. This feature does not make the claim not concise because said feature - contrary to the argument of the respondent - has a technical effect. It can in fact contribute to an easier removal of the napkin after use, according to the purpose of the invention stated at column 2, lines 28 to 30. The technical meaning of this feature is also recognised by document (D2) by stressing the different effects of flaps projecting from the center of the absorbent body and of those located at the front edge, see page 1, lines 8 to 26.

Accordingly claim 1 of the auxiliary submission is clear.

5. *Novelty*

5.1 *Main request*

Document (D2), which is relevant on the basis of Article 54 (3) EPC for the contracting states AT, BE, CH, DE, FR, GB, IT, LI, LU, NL and SE, discloses a

sanitary napkin comprising an absorbent element (1) having longitudinally extending sides, transverse ends, a body-facing side covered by a fluid pervious member (3), and an undergarment facing side covered by fluid impervious backing layer (2), and elastic means (10) disposed in tension transversely across said absorbent element (1) and affixed to said absorbent element (1) of said napkin at two opposing points on said longitudinally extending sides of said absorbent element, and flaps (4, 5) extending laterally from each of said longitudinally extending sides of said absorbent element, whereby said elastic means are additionally disposed within at least one of said flaps for configuring the flap to fold over a side of a crotch portion of an undergarment (page 3, lines 2 and 3, Figures 1 and 2).

Accordingly the subject-matter of claim 1 according to the main request is not new as far as the contracting states AT, BE, CH, DE, FR, GB, IT, LI, LU, NL and SE are concerned.

The appellant argues that the purpose of the invention is different from that of the prior art. The declared purpose of the invention is however not necessarily relevant in assessing novelty as far as the device of the prior art is apt to perform the function of the invention and the structural features of the invention can be read in the device of the prior art.

The decision T 161/82 cited by the appellant in order to stress the relevance of the problem of the invention in assessing novelty states in point 5 of the Grounds that the mentioned comparison leads to focusing to a distinguishing structural feature (strict parallelism) which practically excludes the possibility of regarding the prior art as novelty destroying. This is not the case here. In fact the flaps of the prior art document

perform the function of the invention of protecting the crotch portion together with the main function of easily adjusting the napkin in its proper position. In this context reference is made to page 1, lines 8 to 17 of document (2) where the purpose of protecting the crotch portion is acknowledged. The flaps of the napkin according to document (D2) are furthermore folded around the crotch region, like the invention, and not over the waist band of the panty, see paragraph bridging the pages 2 and 3 and the first paragraph of page 3 of document (2). Regarding the function of the elastic members, reference is made to page 4, first paragraph and to Figure 4. The cited passage states that the transverse elastic members have the effect of curving the absorbent element inwards (that is towards the body of the wearer). That means that the flaps are simultaneously made to curve outwards, see Figure 4. This facilitates the folding of the flaps over the side of the crotch section of the garment.

5.2 Auxiliary request

The flaps of the sanitary napkin disclosed in document (D2) extend from one end of the napkin to the other end thereof and are made tapering from the end which is to be forwardly placed within a panty. The latter end is referred to as the front end of the napkin (see page 2, lines 23 to 29, and Figure 1).

In contrast thereto, claim 1 according to the auxiliary request contains the essential feature: "the lateral extensions of said flaps being larger in a central portion thereof than at their edges". Therefore, the subject-matter of claim 1 is novel with respect to the content of document (D2).

Document (D2) belongs to the state of the art only within the meaning of Article 54(3)(4) EPC and therefore it may not be taken as a basis to assess inventive step within the meaning of Article 56 EPC.

6. Having regard to the considerations under point 2 above, Claim 1 according to the auxiliary request meets the requirement of the EPC for the Designated Contracting States AT, BE, CH, DE, FR, GB, IT, LI, LU, and SE.

Order

For these reasons it is decided that:

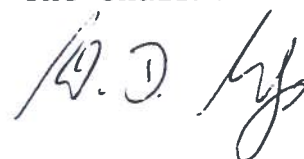
1. The decision under appeal is set aside.
2. The case is remitted to the first instance with the order to maintain the patent as follows:
 - (a) Claims for Spain, as maintained by the opposition division in the decision under appeal, and
 - (b) Claims for the designated states AT, BE, CH, DE, FR, GB, IT, LI, LU, NL and SE, in accordance with the auxiliary request submitted on 7 July 1997;
 - (c) both (a) and (b) with the description and drawings as specified in the decision under appeal.

The Registrar:



N. Maslin

The Chairman:



W. D. Weiß