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D E C I S I O N
of 27 October 1999

Case Number: T 0655/96 - 3.2.2

Application Number: 85306588.6

Publication Number: 0176305

IPC: A61F 13/15

Language of the proceedings: EN

Title of invention:

Disposable waste-containment garment

Patentee:

The Procter & Gamble Company

Opponent:

Paul Hartmann Aktiengesellschaft
Mölnlycke AB

Headword:

-

Relevant legal provisions:

EPC Art. 100(b)

Keyword:

"Sufficiency of the disclosure (yes)"

Decisions cited:

T 0219/85, T 0171/84

Catchword:

-



Case Number: T 0655/96 - 3.2.2

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 27 October 1999

Appellant: Mölnlycke AB
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 24 May 1996
maintaining European patent No. 0 176 305 in
amended form.

Composition of the Board:

Chairman: W. D. Weiß
Members: D. Valle
R. T. Menapace
M. G. Noël
J. C. M. De Preter

Summary of Facts and Submissions

- I. The appellant (opponent III) lodged an appeal, received on 12 July 1996, against the decision of the Opposition Division of 24 May 1996 to maintain the patent No. 0 176 305 in amended form and paid the appeal fee on the same day. The statement setting out the grounds of appeal was received on 23 September 1996.
- II. The Opposition division held that the patent disclosed the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 100(b) EPC) and that the cited prior art did not prejudice the novelty and the inventive step of the subject-matter of the patent as amended (Article 100(a) EPC).

With its grounds of appeal, the appellant only maintained its objection of insufficient disclosure (Article 100(b) EPC) challenging the finding of the Opposition Division, that suitable techniques for carrying out the invention were generally known to a person skilled in the art, e.g. from the documents

(D2) DE-A-1 560 871

(D3) DE-C-2 835 822

(D4) US-A-3 111 948

(D6) US-A-4 147 580 (cited in the patent application, page 2, line 8).

III. Oral proceedings were held on 27 October 1999 at which only the appellant and the respondent (proprietor) were represented. At the end of the oral proceedings the requests of the parties were as follows:

The appellant (opponent III) requested that the decision under appeal be set aside and the patent be revoked.

The respondent (patentee) requested that the appeal be dismissed and that the patent be maintained in the form approved by the opposition division (main request), or be maintained in the form of, in sequence, the auxiliary requests set out in its letter of 18 January 1996.

IV. Claim 1 according to the main request reads as follows:

"A disposable waste-containment garment comprising a liquid impermeable backsheet (27), a liquid permeable lamina (21, 22) and an absorbent core (23) disposed between the backsheet (27) and lamina (21, 22), said absorbent core comprising a mass of fibers substantially devoid of interfiber bonds, characterized in that the liquid permeable lamina is selected from a) a topsheet (21) and b) a wet strength tissue (22) overlain, on the face thereof remote from the backsheet, by a topsheet (21), and in that core slumping and core roping is reduced by adhesive that extends over the adjoining faces of the absorbent core (23) and the lamina (21, 22) so as to secure them in face to face relationship, the adhesive being in the form of an open pattern (49) that is a reticulated network of filaments."

V. The **appellant** argued essentially as follows.

The patent did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 100(b) EPC).

- The patent in suit was silent about how to make reticulated networks of filaments. The patent specification never differentiated between filaments and globules, or glue beads, see description, column 5, from line 24. Throughout the application there was no word to teach what had to be done to deposit the glue in form of filaments instead of globules.

The submission of 7 January 1994, page 2, by the patentee that the skilled person "must be presumed" or "would know" how to perform the invention or that "the skilled person ... would have no difficulty whatsoever ...in selecting the application conditions ..." (last paragraph under the heading "insufficiency" in the above cited submission) had to be regarded as a vague statement, which could not make up for a lack of a positive disclosure. Also the decision of the Board of Appeal T 219/85 stated that vague statements, such as: "in such a manner that" or: "under the condition that" did not enable on their own a skilled person to establish the conditions required to achieve the desired result.

- The reference to other patent specifications was not sufficient alone to take them as common

general knowledge. Contrary to the statement made in the decision under appeal (page 5, first paragraph), other patent specifications - including those considered as closest prior art (such as document (D6) cited in the description of the patent in suit) - could not normally compensate for insufficiency of the disclosure and did not become part of the common general knowledge. See decision of the Board of Appeal, T 171/84.

- In any case, the cited prior art documents did not disclose methods to make reticulated networks of filaments:

(a) Document (D6) disclosed only globules and not, like the patent in suit, reticulated networks of filaments. That the disclosure of document (D6) was useless in assessing the feasibility of the invention was also acknowledged in the decision under appeal (point 4.3, first and last paragraph) in the following terms: "the adhesive being in the form of an open pattern that is a reticulated network of filaments, cannot be derived from ... D6" and "the skilled person could not start with the knowledge of D6 and end up with the subject-matter of the patent in suit".

(b) Documents D2 and D3 disclosed printing techniques, see decision under appeal, page 5 first paragraph. In particular document D2 disclosed a cylinder with deep

grooves ("tiefgeätzter Muster", column 5, lines 2, 3) which deposited glue on the surface of the garment. The pattern obtained was clearly different from the filaments of the invention, which were - in comparison - very tiny. Furthermore the material used in a garment according to document D2 had low viscosity (column 5, line 22) which meant low adhesive capacity, not suitable for filaments.

(c) Document D4 employed a spraying technique (see decision under appeal, page 5) to deposit glue material in crossing lines (column 3, line 29).

- According to the case law of the Boards of Appeal the same level of skill had to be applied when, for the same invention, the two questions of sufficient disclosure and inventive step had to be considered. Moreover, the skilled person in the art should be able to reproduce the invention without any additional inventive activity. The decision under appeal, however, stated that the invention was feasible on the basis of document D6 and at the same time that it was inventive having regard to the same document. These were two contradictory statements.

- During the opposition proceedings on 2 September 1994 the opponent and present appellant filed a declaration by Urban Widlund together with microphotographies taken from products which had been made with the machine disclosed in document

D6 (see column 2, from line 37: hot-melt adhesive to be wiped from the slot extrusion orifice of a glue nozzle). The attached photos clearly showed that the result was the coating of the underlying fibers and not a reticulated network of filaments. This was confirmed also by the appealed decision, see page 6, second and third paragraph. The decision under appeal, page 7, recognized further that the patent in suit required the presence of filaments of adhesive standing alone. As it was proved by the above declaration, the outcome by using the technique disclosed by document D6 was not a reticulated network of adhesive filaments. That meant that the skilled man in the art with the knowledge of the techniques of document D6 was not in the position to carry out the invention without an undue burden, as required by the case law of the Boards of Appeal.

VI. The **respondent** submitted the following arguments:

The patent specification disclosed the preferred type of adhesive (column 5, lines 25 to 40) and the quantity to be used to produce the filaments (claims 4 and 5). On the basis of the general knowledge, documented by document D6, and of the above cited data, the person skilled in the art was capable of modifying the process of document D6 in order to produce filaments instead of globules as required by the claimed invention. The main claim in suit was a product claim. The fact that the process to obtain the product was part of the common general knowledge, as acknowledged in the background part of the closest prior art document D6, did not imply that the product itself was obvious. According to

the jurisprudence of the Boards of Appeal, in assessing feasibility the whole content of the patent specification must be taken into account. The microphotographies presented by the appellant referred to a garment made with a method which differed in several aspects from the examples disclosed in the description of the patent in suit and therefore they could not be considered as such as representative of the method described in the examples of the invention. Consequently, they could not be used for demonstrating whether or not the modes described in the description were sufficiently clear and complete for it to be carried out by a person skilled in the art. Article 100(b) EPC is in fact not only directed to the claims but also to the whole description. In order to prove the insufficiency of the disclosure it was necessary to follow all the conditions laid down in the description regarding the best mode of carrying out the invention. The burden of proof laid on the party who was challenging the patent.

The micrographs submitted by the appellant in annex to the declaration of Mr Widlund referred to a product for which it was not specified that the adhesive used was of the type disclosed in column 5 of the patent specification nor that the quantity of adhesive used corresponded to that disclosed in the patent specification. The appellant stated that a machine such as described in document D6 had been used, however document D6 was silent about the features of the machine used. The choice of a suitable adhesive was on the other hand very important in order to produce filaments.

Finally, Mr Widlund's tests were not carried out with the intention to produce a reticulated network as claimed by the patent in suit; his declaration only states that the garments submitted had been made using the method of document D6. In this connection it had to be considered that this declaration was based on tests which were carried out before the priority date of the patent in suit. Under these conditions the benefit of the doubt was on the side of the respondent (see T 219/83).

Reasons for the Decision

1. The appeal is admissible.
2. The only issue to be decided is whether the patent discloses the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

The patent in suit contains detailed instructions about the type of adhesive to be preferably used (column 5, lines 25 to 27, lines 33 to 36; corresponding to page 7, second paragraph of the original disclosure). There it is said that a preferred pressure sensitive hot melt adhesive for constituting adhesive networks 49 and 52 is identified by Adhesive Specification No 990-374 of Findley Adhesives Inc.). The patent in suit also specifies the quantities of adhesive to be used, see claim 5 as granted which corresponds to the original claim 6. Furthermore, the person skilled in the field of hygienic articles has necessarily a general knowledge of the neighbouring techniques for producing

synthetic fibers, which are also generally made of hot-melt material. Finally, the skilled person is well aware of the method described in document D6, cited in the original disclosure of the patent in suit, page 2, second paragraph. Although this document is concerned in particular with the delivery to a substrate of hot-melt adhesive in the form of globules, through a nozzle, it also mentions a deposition in the form of stripes (column 7, last paragraph: "The process of the present invention may be used to apply an overall coating on the porous, fibrous web or a pattern coating ... Various adhesive coating patterns are possible including stripes running in the machine direction, wide bands, or interrupted or intermittent patterns").

It is therefore evident that a practitioner, facing the task of reproducing the invention as described in the patent in suit, will be able using his normal skill, on the basis of the information given in document D6, to form a pattern of reticulated network of filaments. He will in particular choose an adequate adhesive and suitably modify the method of Figure 2 of document D6 to form filaments, that is thin stripes, (instead of globules), in the machine direction - as suggested in column 7, line 66 -, then do the same in the perpendicular direction and finally press or melt the two rows of filaments - as suggested by the patent in suit, column 5, lines 25 to 27.

The Board agrees with the appellant that normally another patent specification cannot contribute to the sufficiency of disclosure nor is it per se part of the common general knowledge. However, the same decision of

the Board of Appeal cited by the appellant to support his argument (T 171/84) states in point 5 of the reasons that: "unless being available to the skilled reader of the patent..., other specifications cannot ... contribute to the sufficiency of disclosure". This exception to the general rule applies here because document D6, which is the specification of a US patent issued in 1979, is cited in the description of the patent application as filed and therefore its teaching was available to the person skilled in the art, trying to reproduce the invention, without any undue burden.

The Board does not see any contradiction in the decision under appeal between the two statements, the first under the heading Article 100(b) EPC: "D6 ... indicates how to manufacture such a product", and the second under the heading Inventive Step: "The adhesive being in the form of a reticulated network of filaments, cannot be derived from ... D6". As stated above, document D6, even if it does not directly show how to make a reticulated network of filaments, provides, in combination with the instructions of the description of the patent in suit and the common general knowledge, sufficient instructions to enable a person skilled in the art to carry out the invention. On the other hand the opposition division found that the same document did not contain any incentive which could lead the person skilled in the art to modify the patterns of the glue disclosed therein to form the reticulated network of filaments of the invention. The two statements are not contradictory. Only once a reticulated network of filaments has been disclosed does the method of producing it become evident in the

light of the disclosure of document D6. But document D6 never suggests to do it. In other words, the fact that the method of producing reticulated networks of filaments is available without undue burden on the basis of the teaching of the patent in suit and of a document in the prior art, does not necessarily imply that the claimed product is obvious on the basis of the same document of the prior art.

The microphotographs attached to the declaration of Mr Widlund do not contradict the above conclusions. These pictures have been submitted with the intention to prove that a reticulated network of filaments cannot be obtained with a machine disclosed in document D6. These pictures, however, were taken at the occasion of a consumer test in June 1983 and 1984, that is before the priority date of the patent in suit (17 September 1984). That means that the product cannot have been made with the intention of reproducing a reticulated network of filaments according to the patent in suit. It has been consistent case law of the Boards of Appeal that sufficiency of disclosure within the meaning of Article 83 EPC must be assessed on the basis of the application as a whole - including the description and claims - and not of the claims alone, see case law of the Boards of Appeal, 1998 page 147. The above cited declaration does not specify whether the type of adhesive and the quantity used were the same as suggested by the patent in suit and therefore it does not fulfill the condition set out by the case law cited above.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

S. Fabiani

W. D. Weiß