BESCHWERDEKAMMERN DES EUROPÄISCHEN PATENTAMTS

BOARDS OF APPEAL OF THE EUROPEAN PATENT OFFICE

CHAMBRES DE RECOURS DE L'OFFICE EUROPEEN DES BREVETS

Internal distribution code:
(A) [ ] Publication in OJ
(B) [ ] To Chairmen and Members
(C) [X] To Chairmen

D E C I S I O N
of 16 October 2000

Case Number: T 0101/97 - 3.2.6

Application Number: 90118497.8

Publication Number: 0412579

IPC: A61F 13/15

Language of the proceedings: EN

Title of invention:
Form-fitting self-adjusting disposable garment

Patentee:
KIMBERLY-CLARK WORLDWIDE, INC.

Opponents:
Mölnlycke AB
The Procter & Gamble Company

Headword:
-

Relevant legal provisions:
EPC Art. 100(c), 123(2)

Keyword:
"Feature disclosed in the application as originally filed - no"

Decisions cited:
G 0001/93, T 0384/91

Catchword:
-

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0101/97 - 3.2.6

D E C I S I O N
of the Technical Board of Appeal 3.2.6
of 16 October 2000

Appellant: (Proprietor of the patent)
KIMBERLY-CLARK WORLDWIDE, INC.
401 North Lake Street
Neenah
Wisconsin 54956 (US)

Representative:
Diehl, Hermann, Dr. Dipl.-Phys.
DIEHL, GLÄSER, HILTL & PARTNER
Patentanwälte
Postfach 34 01 15
D-80098 München (DE)

Respondents: (Opponent 01)
Mölnlycke AB
405 03 Göteborg (SE)

Representative:
Hammond, Andrew
Albihn West AB
Box 142
SE-401 22 Göteborg (SE)

(Opponent 02)
The Procter & Gamble Company
One Procter & Gamble Plaza
Cincinnati
Ohio 45202 (US)

Representative:
Canonici J. J.
Procter & Gamble GmbH
Patent Department
Sulzbacher Strasse 40-50
D-65824 Schwalbach am Taunus (DE)

Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 28 November 1996 revoking European patent No. 0 412 579 pursuant to Article 102(1) EPC.**

Composition of the Board:

Chairman: P. Alting van Geusau
Members: G. C. Kadner
J. C. M. De Preter

Summary of Facts and Submissions

I. The mention of the grant of European patent No. 0 412 579 in respect of European patent application No. 90 118 497.8 filed on 6 September 1986 which was part of the earlier application with publication number 0 214 636, was published on 8 June 1994.

II. Notice of opposition was filed on 8 March 1995 by Respondent I (Opponent I), on the grounds of Articles 100(a), (b) and (c) EPC and by Respondent II (Opponent II), on the grounds of Articles 100(a) and (c) EPC. In respect of the objection based on Article 100(c) EPC Respondent I essentially relied upon:

E1: EP-A-0 214 636

III. By a decision posted on 28 November 1996 the Opposition Division revoked the European patent 0 412 579.

The Opposition Division was of the opinion that the subject-matter of the granted patent extended beyond the disclosure of the earlier application as filed because two features could not be derived directly and unambiguously from the parent application EP-A-0 214 636. Since these features were included in each of the claims 1 of the main request and the auxiliary requests 1 to 5, the subject-matter of these claims did not meet the requirements of Article 123[2] EPC.

IV. On 27 January 1997 a notice of appeal was lodged against the decision together with payment of the appeal fee.

With the statement of grounds of appeal filed on 8 April 1997, the Appellant filed an affidavit by Mr Thomas H. Roessler and a sample diaper.

V. In a communication dated 13 June 2000 the Board expressed the preliminary opinion that it was doubtful whether the features in question could be derived from the originally filed documents, and that the affidavit and the sample diaper submitted by the Appellant, did not appear to be suitable evidence to repair deficiencies in the original disclosure.

VI. Oral proceedings were held on 16 October 2000 in the absence of Opponent 02, who, although duly summoned, did not appear (Rule 71[2] EPC).

The Appellant (Patentee) requested that

the decision under appeal be set aside and that the patent be upheld with replacement claim 1 according to the fourth auxiliary request filed with letter of 2 October 1996 (main request);

auxiliary with replacement claim 1 according to the fifth auxiliary request filed with letter of 2 October 1996 (first auxiliary request);

auxiliary with replacement claim 1 filed during the oral proceedings on 16 October 2000 (second auxiliary request).

Claim 1 of the main request reads as follows:

"An absorbent garment article, comprising:

an outer cover (20);

a pair of longitudinally opposed end portions;

a crotch portion situated between the end portions, said crotch portion including opposed marginal sides which define a pair of leg openings;

a first elastic member (62) connected to each of said marginal sides to elasticize said leg openings to aid in conforming said garment to a wearer at said leg openings;

a pair of longitudinally extending, second elastic members (56) with each of said second elastic members spaced inwardly from each respective one of first elastic members;

an absorbent structure (22) bonded to said outer cover (20) in a crotch section of said article,

characterized by said absorbent structure (22) including a liquid-permeable bodyside liner (42), an absorbent core (38) disposed adjacent said liner (42);

a liquid-impermeable barrier (44), said absorbent core (38) being located between said barrier (44) and said liner (42) and

said second elastic members (56) being connected to said liner (42) along at least a crotch portion of said absorbent structure (22) sidewards of the core (38) between said liner (42) and said barrier (44) and said elastic members (56) being applied to said liner (42) in a tensioned condition when the absorbent structure (22) is constrained to lie flat,

said second elastic members (56) gathering and forming margins on said liner (42) to provide elasticized margins which extend spaced from said outer cover (20), said second elastic members holding said elasticized margins against the skin of the wearer to provide barriers to reduce the sideways flow of urine and faeces and restrict leakage at the leg openings when the garment is securely worn."

The last paragraph of each of claims 1 of the first and second auxiliary request is identical to the last paragraph of claim 1 of the main request.

VII. In support of its requests the Appellant essentially relied upon the following submissions:

The feature that the second elastic members 56 were connected to the liner 42 was fully derivable from Figures 10 to 12 and the description thereof in the parent application document. Since the second elastic members 56 according to Figure 10 might alternatively be bonded to either the bodyside liner 42 or to the barrier 44 (column 9, lines 43 to 44 of E1) this alternative disposition of the second elastic member 56 in the embodiment of Figure 12 lay also within the

scope of the invention. In regard of this cross-section of a diaper it was clear that the disclosure of Figure 12 was not restricted on the bonding to the barrier 44 as shown but also included the bonding to liner 42.

Even if the term "margin" was not disclosed expressis verbis, a skilled person clearly recognized in connection with the drawings that this expression addressed the longitudinal side of a structure.

Furthermore, the function of the diaper being "trim, does not gap at the legs or waist and is highly resistant to leakage" (column 4, lines 6 to 11 of E1) would be an equivalent to the property of a barrier function providing a tight seal for the wearer to reduce the sideways flow of urine and faeces.

Having regard to claim 1 of the auxiliary requests by characterising the subject-matter in more detailed "structural" features the "functional" features of the last paragraph of claim 1 would appear self-evident to a skilled person so that original disclosure of these functional features was established by their implicit presence in the originally filed application documents.

VIII. The Respondents requested dismissal of the appeal. The submissions raised against the second auxiliary request by Opponent 01 are summarised as follows:

This request should not be admitted because it was late filed. Additional features from the description which were not easily to be understood, had been incorporated into the amended claim 1. This request came as a

surprise, and consequently no sufficient time and opportunity for proper consideration of the new amendments was available.

Anyway, the subject-matter of claim 1 of the main request and of the auxiliary requests extended beyond the content of the earlier application as filed because neither the bonding of the second elastic member 56 to the liner 42 to provide elasticized margins nor said second elastic members holding said elasticized margins against the skin of the wearer to provide barriers were clearly and unambiguously derivable from the disclosure of the originally filed document E1.

Reasons for the Decision

1. The appeal is admissible.

2. *Admissibility of the second auxiliary request*

2.1 According to the case law of the Boards of Appeal, the filing of new claims during the oral proceedings can be refused for reasons of fairness. An Opponent should not be surprised at a late state of the procedure with unexpected amendments and be put in a situation in which insufficient time and opportunity was allowed to deal with the new amendments, so as to be able to file observations or present comments.

2.2 However, the Board is of the opinion that in the present case this request does not give rise to such a situation. The request was submitted at the beginning of the oral proceedings. The amendments concerned features which were easily understandable in

themselves, and the Appellant explained in detail where the new features were disclosed in the parent application in the claimed relations. In particular the disclosure of the amendments was supported by those parts of the description which had already been cited during the dispute in relation with the ground of opposition according to Article 100(c) EPC. In addition, the Respondents had been given sufficient opportunity to evaluate the amendments during the adjournment of the oral proceedings.

2.3 For these reasons filing of the second auxiliary request was admitted.

3. *Article 100(c) EPC*

3.1 According to Article 100(c) EPC the subject-matter of the European patent granted on a divisional application may not extend beyond the content of the earlier application as filed. This means that the subject-matter of the present patent should not extend beyond that disclosed in the parent application 86112378.4 with publication number 0 214 636 (E1).

In accordance with the case law of the Boards of Appeal the addition of an undisclosed feature is prohibited if it makes a technical contribution to the subject-matter of the claimed invention (see e.g. G 1/93, OJ 1994, 541 and T 384/91, OJ 1995, 745) even if the scope of protection is limited by this addition.

Main request

3.2 The Appellant pointed out that the contested claim 1 was amended only in such a way that no technical effect was caused. The "structural" features included in claim 1 up to the last paragraph were sufficient for a skilled person to recognize that the "functional" features indicated in the last paragraph of claim 1 would be self-evident.

The Board cannot agree with this opinion, because this paragraph does not only contain "functional" features directly following from the earlier mentioned structure but also new "structural" features. The feature according to which the second elastic members holding the elasticized margins against the skin of the wearer to provide barriers is a structural feature defining a seal function between the bodyside liner 42 and the skin of the wearer. In restricting leakage at the leg openings this sealing effect has a technical character. The Board considers that at least this feature is not clearly and unambiguously derivable from the originally disclosed invention.

3.3 The Appellant stressed that in the cited parts of the text of the parent application the barrier with a seal function was described as inherently included, but the Board cannot find evidence for this point of view. The board considers publication E1 to render the content of the original application correctly as there was not given any reason to doubt its accordance, and the Appellant, also being the applicant of the parent application, accepted this document to be basis of the discussion. In E1 (column 1, lines 21 to 30) the neat criteria of a diaper as such are described. However,

this text is silent about whether the prevention of leakage is caused by the barriers formed in connection with the second elastic members which are not mentioned there. The same reasons are valid for the parts of the description in column 3, line 55 to column 4, line 1, lines 5 to 11 and lines 25 to 39. The text of column 5, lines 32 to 45 relates to the effect of forming a cupped shape of the absorbent structure by applying an elastic member to the bodyside liner, however, any hint to achieve a barrier with a sealing property against the skin of the wearer for the second elastic members is missing.

3.4 In support of its argumentation the Appellant relied on several citations of parts of the description. The Board cannot find sufficient evidence in order to support the original disclosure in the text. The description of the embodiments of Figures 10 to 12 from column 9, line 39 to column 10, line 56, concerns the adhesively bonding of the elastic members 56 to the bodyside liner 42 causing the absorbent structure to converge and thus functioning as conforming means, or respectively, bonding them in a tensioned condition to the diaper in a flat condition thus forming a cupped shape of the absorbent structure. Any sealing function against the skin of the wearer cannot be derived therefrom because there is no mentioning between which parts a seal or barrier should be constructed.

3.5 Regarding Figure 17, a seal function to the skin of the wearer, as put forward by the Appellant, cannot be recognized. According to the description (column 12, lines 5 to 16) this drawing particularly relates to the

fasteners 70, 74, and no conclusion in a direction of the sealing function against the skin of the wearer is unambiguously derivable from this paragraph either.

3.6 Additionally, the Board considered Figure 19 together with column 13, lines 15 to 22 of E1. In this embodiment the second elastic members 56 are abandoned. However, the prevention of gapping thereby aiding in eliminating the leakage of urine and faeces is emphasized. It is clear that the prevention of leakage is similar to a sealing function, and this effect is achieved without the second elastic members. This fact contradicts the alleged disclosure of the special seal function of the second elastic members holding the elasticized margins against the skin of the wearer to provide barriers.

Auxiliary requests

3.7 The Appellant argued that by incorporating still more of the "structural" features which were originally disclosed according to E1 into the amended claims 1 of these requests the self-evidence of the "functional" features would increase, and a skilled person would clearly recognize them as already having been disclosed in the parent application.

3.8 Claim 1 according to the first auxiliary request contains in addition to that of the main request three additional words in the feature "said second elastic members (56) being connected to **the underside of** said liner (42). However, a relation to any seal function against the skin of the wearer cannot be recognized.

The last paragraph of claim 1 of this request is identically with that of claim 1 of the main request. As set out above this paragraph contains not only functional features but also the structural feature concerning the seal function provided by the elasticized margins against the skin of the wearer. At least this one feature included in this paragraph cannot be clearly and unambiguously be derived from the parent application, and therefore it was not originally disclosed.

3.9 The second and the third paragraph of the characterizing portion of claim 1 according to the second auxiliary request contain in addition to claim 1 of the first auxiliary request further features concerning the location of the bonding of the liquid-impermeable barrier (44) and the absorbent core (38) in relation to the bodyside liner (42), the outer cover (20), and the second elastic member (56), and of the connection of the second elastic members (56) to the liner (42) laterally spaced from the core (38). Evidently also these terms cannot support a sealing property to the leg of the wearer because any relation of the second elastic member with the skin of the wearer is lacking.

The last paragraph of claim 1 of the second auxiliary request being identical to that of claim 1 of the main request, once again at least this one feature concerning the sealing function to the skin of the wearer included in this paragraph was not originally disclosed.

4. Summarising, for the above reasons the Board arrived to the conclusion that at least the feature "**said second elastic members holding said elasticized margins against the skin of the wearer to provide barriers**" extends beyond the originally disclosed documents. Consequently each of the claims of the requests filed by the appellant does not meet the requirement of Article 123[2] EPC, and therefore revocation of the patent under Article 100(c) EPC is justified.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

M. Patin P. Alting van Geusau