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D E C I S I O N
of 25 January 2006

Case Number: W 0008/05 - 3.2.06

Application Number: PCT/EP03/03384

Publication Number: WO 2003/082167

IPC: A61F 13/15

Language of the proceedings: EN

Title of invention:

Prefastened absorbent product with elastic reclosable sides
and method for producing same

Applicant:

SCA Hygiene Products AB

Opponent:

-

Headword:

-

Relevant legal provisions:

PCT R. 13.1, 13.2, 68.2, 68.3(c)

Keyword:

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Decisions cited:

G 0001/89, W 0004/94

Catchword:

-



Case Number: W 0008/05 - 3.2.06

International Application No. PCT/EP 03/03384

D E C I S I O N
of the Technical Board of Appeal 3.2.06
of 25 January 2006

Applicant: SCA Hygiene Products AB
S-405 03 Göteborg (SE)

Representative: Albihns GmbH
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D-80335 München (DE)

Decision under appeal: Protest according to Rule 68.3(c) of the Patent Cooperation Treaty made by the applicants against the invitation of the European Patent Office (International Preliminary Examining Authority) to restrict the claims or pay additional fees dated 17 December 2003.

Composition of the Board:

Chairman: P. Alting van Geusau
Members: G. Pricolo
S. Hoffmann

Summary of Facts and Submissions

I. The applicant filed International patent application PCT/EP03/03384 on 1 April 2003. The application contained 19 claims of which the independent claims 1 and 15 are as follows:

"1. Prefastened absorbent product, said absorbent product comprising a rear portion (1), a front portion (2) and a crotch portion (3) therebetween, a longitudinal axis (Y-Y) passing generally through the middle of the front and rear portions (1,2) and a lateral axis (X-X) perpendicular to the longitudinal axis (Y-Y), said rear portion including at least two rear side flaps (8, 12, 9, 13) attached therein, each presenting an inner surface (19, 19') and an outer surface (20, 20'), said front portion (2) including at least two front side flaps (6, 7) attached therein, each presenting an inner surface (17, 17') and an outer surface (18, 18'), wherein one member of a releasable fastening means (10, 11; 15, 16, 46) is present on each of said rear side flaps (8, 12, 9, 13) and each of said front side flaps (6, 7) respectively, the members of said releasable fastening means on said front and said rear side flaps (6, 7; 8, 12, 9, 13) respectively being in contact to thereby form a reclosable connection therebetween, and further wherein each one of said front side flaps (6, 7) is fixedly attached by means of a weld (21, 22) to a respective one of said rear side flaps (8, 12, 9, 13) in an overlapping relationship such that the outer surface (18, 18') of each one of said front side flaps (6, 7) lies against the inner surface (19, 19') of each respective rear side flap (8, 12, 9, 13), and wherein the weld (21, 22) in each of

said rear side flaps (8, 12, 9, 13) lies laterally inwardly with respect to the releasable fastening means (10, 11) positioned on said respective rear side flap, and wherein each of said front and rear side flaps (6, 7; 8, 12, 9, 13) includes an elastic portion, and wherein said weld (21, 22) is positioned proximate the laterally outer edge (47, 48) of the elastic portion of at least one of said front and said rear side flaps (6, 7; 8, 12, 9, 13)."

"15. Method of producing a prefastened, reclosable absorbent product, wherein a first side flap member (9a, 13a) is fixedly attached at a first attachment location (23a) to an outer surface (4a) of a first end portion (1a) of an absorbent product chassis member, so as to extend laterally outwardly from a side edge (40a) of said chassis member, said first side flap member (9a, 13a) being provided with one part (11a) of a releasable fastening means (11a, 15a), and wherein a second side flap member (7a) is attached by welding at an area of attachment (21a) to said first side flap member (9a, 13a) such that an inner surface (19a) of said first side flap member (9a, 13a) is attached to an unfolded overlapping relationship to an outer surface of said second side flap member (7a), and wherein said second side flap member (7a) is folded over said first side flap member (9a, 13a) such that an inner surface of the second side flap member (7a) faces said inner surface (19a) of said first side flap member (9a, 13a), and wherein said second side flap member (7a) is then fixedly attached to said second end portion (2a) of said chassis member."

- II. The European Patent Office (EPO), acting in its capacity as an International Searching Authority (ISA) issued a search report dated 7 October 2003 in which it informed the applicant that the international application did not comply with the requirement of unity of invention (Rule 13.1 PCT) and that, since all the claims could be searched without effort justifying an additional fee, the applicant was not invited to pay any additional search fee. The ISA indicated that claims 1 to 14 related to a first invention, namely a prefastened absorbent article having a pair of rear side flaps and a pair of front side flaps attached to each other by a weld, and claims 15 to 19 to a second invention, namely a method for producing a prefastened absorbent article having a pair of rear side flaps and a pair of front side flaps attached to each other by a weld.
- III. On 17 December 2003 the EPO, acting in its capacity as International Preliminary Examining Authority (IPEA), issued an invitation (on Form PCT/IPEA/405) to restrict or to pay additional fees (Rule 66 PCT) in which it indicated that it agreed with the objection put forward by the ISA as to lack of unity.
- IV. With letter dated 12 January 2004 the applicant paid under protest the additional fee for preliminary examination of claims 15 to 19 and submitted arguments as to why the inventions were unitary.
- V. With a communication dated 27 February 2004 on Form PCT/IPEA/437, a review board within the meaning of Rule 105(3) EPC confirmed the IPEA's opinion regarding lack of unity and invited the applicant to pay a

protest fee for further examination of the protest. The review board came to this finding on the basis of the fact that the subject-matter of claim 1 was not novel over the disclosure of document

D1: US-A-5 370 634 (incorrectly designated as US-A-537 064);

cited in the international search report.

According to the opinion of the review board:

- the special technical feature (within the meaning of Rule 13.2 PCT) left in the group of claims 1 to 14 over D1 was that each front side flap comprised a line of weakening (claim 13), which solved the problem of how to remove the product from the wearer, and
- the special technical feature left in the group of claims 15 to 19 over D1 was a method for producing a prefastened absorbent product having a pair of rear side flaps and a pair of front side flaps attached to each other by a weld, which solved the problem of how to assemble the product.

Accordingly, there was no "same or corresponding special technical feature" among the groups of claims 1 to 14 and 15 to 19 and therefore the application did not comply with the requirement of unity of invention.

VI. With letter dated 24 March 2004, the applicant filed a response to the review panel's reasoning together with

a debit order for the payment of the protest fee, which was registered at the EPO on 25 March 2004.

The applicant essentially submitted that whilst the review panel stated that Figs. 4 and 5 of D1 were the basis for the non-unity objection, this was not clear from the invitation to pay additional fees or restrict (PCT/IPEA/405). Consequently, there were no specific comments made to Figs. 4 and 5 in the previous protest submissions. Anyway, nothing in D1, including Figures 4 and 5, indicated that the areas of joining or welding, labelled as 5D, were formed with the overlapping arrangement as in claims 1 and 15 of the application. Accordingly, the subject-matter of claims 1 and 15 was novel over D1 and therefore the protest was justified.

Reasons for the Decision

1. The protest is admissible.
2. The applicant submitted that it was not clear from the invitation to pay additional fees or restrict (PCT/IPEA/405) that Figs. 4 and 5 of D1 were the basis for the non-unity objection. This submission implicitly gives rise to the question of whether the invitation was sufficiently reasoned within the meaning of Rule 68.2 PCT.

In the invitation, the IPEA refers to D1 as the closest prior art (see page 1, first line) and to the special technical features "left" over the closest prior art (see point 3). For the first invention, reference is made to only one such special technical feature, namely

the feature concerning the line of weakening defined in claim 13. In point 4 of the invitation it is stated that *"no same or corresponding special technical feature can be found (Rule 13.1 PCT) among the groups of claims (1-14) and (15-19), apart from the features known from the prior art. The special technical features of the groups of claims (1-14) and (15-19) solve different and distinct problems which can be approached independently from each other."* It is therefore clear that the objection is of lack of unity *a posteriori* (see G 1/89): due to the lack of novelty of (at least) claim 1, the only special technical feature, i.e. the feature distinguishing the invention of claims 1 to 14 from the product of D1 is the feature of claim 13 (since according to Rule 13.2 PCT the expression "special technical features" means those technical feature that define a contribution which the claimed invention, considered as a whole, makes over the prior art). The same, or a corresponding (being related to the same or analogous technical problem) feature is not present in the method claims 15-19, and therefore there is no technical relationship among the inventions involving one or more of the same or corresponding special technical features (Rule 13.2 PCT). Accordingly, there is lack of unity in the sense of Rule 13.1 PCT between the two groups of claims 1-14 and 15-19. It is therefore possible to objectively understand the reasons for the objection of lack of unity in the invitation to pay additional fees or restrict (see also W 4/94, point 4.1). This finding is corroborated by the fact that the applicant itself was able to submit reasoned arguments in response to the invitation (see letter dated 12 January 2004).

Therefore, the invitation is sufficiently reasoned within the meaning of Rule 68.2 PCT.

3. Since the *a posteriori* objection of lack of unity is based on the lack of novelty of the subject-matter of claim 1 over D1, it has first to be examined whether this is in fact the case.

Using the wording of claim 1, D1 discloses (see Figs. 4, 5 referred to by the review panel in the communication dated 27 February 2004 on Form PCT/IPEA/437) a prefastened absorbent product, said absorbent product comprising a rear portion, a front portion and a crotch portion therebetween, a longitudinal axis passing generally through the middle of the front and rear portions and a lateral axis perpendicular to the longitudinal axis, said rear portion including at least two rear side flaps (each consisting of portions 14 and 5E; see column 4, lines 16, 17 and 60; column 5, lines 10 to 15; column 6, lines 47, 48) attached therein (note that D1 does not disclose any join between the elastic portion 14 of the rear side flap and the rear portion of the absorbent body; it is however clear that the elastic members - see column 5, lines 10 to 15 - are somehow attached as they are made of a different material than the rest of the absorbent product,) each presenting an inner surface and an outer surface, said front portion including at least two front side flaps (side portions of front waist portion 5C), each presenting an inner surface and an outer surface, wherein one member of a releasable fastening means (6,8) is present on each of said rear side flaps and each of said front side flaps respectively, the members of said releasable fastening

means on said front and said rear side flaps respectively being in contact to thereby form a reclosable connection therebetween, and further wherein each one of said front side flaps is fixedly attached by means of a weld (5D) to a respective one of said rear side flaps in an overlapping relationship such that the outer surface of each one of said front side flaps (5C) lies against the inner surface (of portion 5E) of each respective rear side flap (5E, 14), and wherein the weld (5D) in each of said rear side flaps lies laterally inwardly with respect to the releasable fastening means (6) positioned on said respective rear side flap, and wherein each of said rear side flaps includes an elastic portion (14), and wherein said weld (5D) is positioned proximate (namely in correspondence with) the laterally outer edge of the elastic portion of at least one of said front and said rear side flaps (14, 5E).

The applicant argued that in D1 the areas of joining or welding 5D were not formed with the overlapping arrangement as in claim 1 of the application. However, the requirement of claim 1 concerning the attachment of the front side flaps by means of a weld to the rear side flaps in an overlapping relationship "*such that the outer surface of each one of the front side flaps lies against the inner surface of each respective rear side flap*" is fulfilled by the absorbent product shown in Figs. 4 and 5 of D1, because portion 5E of each rear side flap (14, 5E) undoubtedly overlaps the outer surface of corresponding front side flap 5C.

However, contrary to the finding of the review panel, D1 does not disclose, in the embodiment of Figs. 4 and

- 5, the features of claim 1 of the application according to which the front side flaps are attached to the front portion of the absorbent product and each of said front side flaps includes an elastic portion. In fact, in this embodiment the front side flaps 5C constitute direct extensions of the absorbent product's front portion (see column 4, lines 22 to 26), for which no elastic properties are derivable from the disclosure of D1.
4. The above-mentioned distinguishing feature (special technical feature in the sense of Rule 13.2 PCT), that the front side flaps are attached to the front portion of the absorbent product, finds its corresponding feature in method claim 15. Indeed, according to claim 15, all the flap members are "fixedly attached" to the first and second end portion, respectively, of the chassis member. This means that in the product which is obtained as a result of the method of claim 15, the front side flaps are attached to the front portion thereof.
5. Moreover, also the embodiments of an absorbent article according to D1 other than those shown in Figs. 4 and 5 are not provided with the combination of features of claim 1. In fact, D1 neither discloses a product having the features of claim 1 nor a method having the features of claim 15. Accordingly, the subject-matter of the independent claims 1 and 15 of the application is novel over D1.

Since the subject-matter claimed in the international application is novel over D1, the Board finds that the IPEA's *a posteriori* objection of lack of unity, based

on the lack of novelty over D1, is not justified. Considering that the Board should only examine under Rule 68.3(c) PCT whether the reasons for which the international application was not considered as complying with the requirement of unity of invention by the IPEA were justified, and not investigate whether a finding of lack of unity might be justified on other grounds (see W 4/94, point 5.5), the Board comes to the conclusion that the protest is justified.

Order

For these reasons it is decided that:

1. Refund of the additional examination fee paid by the applicant is ordered.
2. The protest fee shall be refunded.

The Registrar:

The Chairman:

C. Eickhoff

P. Alting van Geusau