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D E C I S I O N
of 24 January 2003

Case Number: T 0639/00 - 3.2.6

Application Number: 94905410.0

Publication Number: 0675704

IPC: A61F 13/15

Language of the proceedings: EN

Title of invention:
Absorbent article having optional side flaps

Patentee:
THE PROCTER & GAMBLE COMPANY

Opponent:
SCA Mölnlycke AB

Headword:
-

Relevant legal provisions:
EPC Art. 87, 123(2), 54(3), R. 68(2)

Keyword:
"Priority - validity (yes)"
"Amendments"
"Novelty"
"Reimbursement of appeal fee (no)"
Decisions cited:
G 0002/98, T 0740/93

Catchword:
-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0639/00 - 3.2.6

D E C I S I O N
of the Technical Board of Appeal 3.2.6
of 24 January 2003

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Decision under appeal: **Interlocutory decision of the Opposition Division of the European Patent Office posted 15 May 2000 concerning maintenance of European patent No. 0 675 704 in amended form.**

Composition of the Board:

Chairman: P. Alting van Geusau
Members: G. Pricolo
M. B. Tardo-Dino

Summary of Facts and Submissions

I. The appeal is from the interlocutory decision of the Opposition Division posted on 15 May 2000 concerning the maintenance in amended form of European patent No. 0 675 704, granted in respect of European patent application No. 94 905 410.0.

In the decision under appeal the Opposition Division considered that the grounds for opposition under Article 100(a) did not prejudice maintenance of the patent in the form according to the first auxiliary request filed with letter dated 14 December 1999.

II. The appellant (opponent) lodged an appeal against this decision, received at the EPO on 26 June 2000, and simultaneously paid the appeal fee. The statement setting out the grounds of appeal was received at the EPO on 6 September 2000. The appellant requested refund of the appeal fee because of a substantial procedural violation allegedly committed by the Opposition Division.

III. The following documents which featured in the opposition procedure were considered as relevant in the appeal proceedings:

D1: WO-A-93/01785;

D2: EP-A-607 090.

IV. In an annex to the summons for oral proceedings pursuant to Article 11(2) Rules of Procedure of the Boards of Appeal the Board expressed its preliminary opinion that it appeared that amended claim 1 did not

contravene Article 123(2) EPC and that the decision under appeal was not affected by a substantial procedural violation. Moreover, the Board stated that it appeared that if D1 did not disclose the same subject-matter as claim 1 of the patent in suit then not only novelty over D1 was given, but also, having regard to the criteria set out in decision G 2/98, the priority of the patent in suit was validly claimed, so that D2 did not form part of the state of the art.

V. With letter dated 26 September 2002, the appellant withdrew the request for oral proceedings "in view of the likely consequences that decision G 2/98 may have on certain aspects of the appeal".

The appellant maintained the requests that the decision under appeal be set aside and the patent be revoked, and that the appeal fee be reimbursed due to the fact that a substantial procedural violation had occurred.

VI. The respondent (patentee) requested that the appeal be rejected and the patent be maintained in the form maintained by the Opposition Division. With letter dated 17 December 2002, the respondent expressed the opinion that the decision could be taken in written proceedings without the need for oral proceedings to be held.

VII. Following their latest requests, the parties were informed by the Board, with telefax sent on 24 January 2003, that oral proceedings were cancelled.

VIII. Independent claims 1 and 8 read as follows:

"1. An absorbent article (20) releasably held in a

folded configuration having an adhesive side (90) and a non-adhesive side (91), said absorbent article (20) comprising a main body portion (22) comprising an absorbent assembly (46), a body-facing side, a garment side, and a periphery comprising longitudinal edges and transverse edges, and a pair of flaps (24), each of said flaps (24) being joined along a juncture (30) to said main body portion (22), and each flap (24) comprising a proximal edge adjacent the juncture (30), a distal edge (34) disposed away from the juncture (30), a body-facing side (24"), and a garment side (24'), said absorbent article (20) characterized in that:

each flap (24) is folded to be over the garment side of said main body portion (22) to form a first flap portion (84) and each flap (24) being folded again to form a second flap portion (85) having a body-facing side (85") and a garment side (85'), said garment side (85') of said second flap portion (85) facing away from said garment side of said main body portion (22) such that, in the absorbent article´s folded configuration, said garment side of said main body portion (22) and said garment side (85') of each said second flap portion (85) all face opposite said body-facing side of said main body portion (22), and a flap securement member (56) joined to said garment side (85') of said second flap portion (85) of each said flap (24) whereby at least a portion of said flap securement member (56) on said second flap portion (85) overlays said main body portion (22) such that each said flap securement member (56) forms at least a portion of said adhesive side (90) of the absorbent article (20), said absorbent article (20) additionally comprising at least one pad securement member (54) joined to the garment side of said main body portion (22)".

"8. A method for making an absorbent article (20) releasably held in a folded configuration, said absorbent article (20) comprising an adhesive side (90), a non-adhesive side (91) and flaps (24) with flap adhesives (56) which form at least a portion of the adhesive side (90) of said absorbent article (20), the method characterized in that it comprises the steps of:
(a) providing an absorbent article (20) comprising a garment side, a body-facing side, a main body portion (22), and a pair of flaps (24) joined to said main body portion (22) along a juncture (30), said main body portion (22) comprising an absorbent assembly (46), each of said flaps (24) comprising a proximal edge adjacent the juncture (30), a distal edge (34) disposed away from the juncture (30);
(b) folding each said flap (24) over said garment side of said absorbent article (20),
(c) folding each flap (24) a second time such that a portion of the garment side (24') of each of said flaps (24) overlays and faces away from the garment side of said main body portion (22) to form an adhesive receiving portion (56') on each of said flaps (24), and
(d) applying an adhesive to at least said adhesive receiving portions (56') of each of said flaps (24) to form flap securement members (56),
wherein the step (d) of applying said adhesive to at least said adhesive receiving portion (56') of each of said flaps (24), comprises either:
(1) applying adhesive to a portion of the garment side of the main body portion (22) to form a pad securement member (54), or (2) printing said adhesive onto said adhesive receiving portion (56') of each of said flaps (24) and onto said garment side of said main body portion (22)".

IX. The arguments of the appellant can be summarized as follows:

Claim 1 of the patent in suit included the features of original claims 1 and 3. However, the application as filed disclosed the features of claim 3 only in combination with the features of claim 2. Therefore, the subject-matter of claim 1 of the patent in suit which did not include the features of claim 2 could not be derived directly and unambiguously from the application as filed. As a consequence, the subject-matter of claim 1 extended beyond the content of the application as filed, contrary to Article 123(2) EPC.

Having regard to Figure 36 of D1, which was a simplified schematic perspective view of the sanitary napkin described in D1, and to the passages in D1 describing that the central portion of the stretchable attachment device might be omitted, that the stretchable attachment elements might be integral with the backsheet, that a suitable backsheet was an adhesive sheet, and that the garment facing side thereof could be used as a panty fastening adhesive, it was clear for the skilled person, when following the teaching of D1 in terms of a sanitary napkin having stretchable attachment elements integral with the backsheet, that the backsheet could be used as a panty fastening adhesive, ie as a pad securement member. Hence, the subject-matter of claim 1 was known from D1.

D1 was in the same name as the patent in suit and was filed before the claimed priority date thereof. Since D1 disclosed the subject-matter of claim 1 of the patent in suit, the earlier application from which the patent in suit claimed priority could not be deemed to

be the first application in the sense of Article 87(1) EPC. Accordingly, claim 1 did not enjoy the right to priority. Even if some differences were to be deemed to exist between D1 and the subject-matter of claim 1 of the patent in suit, the claim was still not entitled to priority because the features added to claim 1 in respect of granted claim 1 which was found to lack novelty over D1 by the Opposition Division, did not change the nature of the invention.

In view of the fact that the subject-matter of claim 1 was not entitled to priority, D2 was prior art under Article 54(3) EPC. Since D2 disclosed an absorbent article having all the features of claim 1, the subject-matter of claim 1 was not novel also in respect of D2.

In its decision, the Opposition Division simply asserted that the subject-matter of claim 1 was novel with respect of D1 without providing any reasoning. Despite the opponent's detailed oral presentation on this point, the Opposition Division summarized his arguments as being non-convincing. The fact that arguments may have been deemed to be non-convincing did not detract from the fact that the opposition Division was obliged under Rule 68(2) EPC to provide reasons as to why the Opponent’s arguments were deemed to be insufficient. That the Opposition Division identified a feature which, in its view, was not present in D1 was the reason why the Division came to the conclusion that claim 1 was novel. However, the mere identification of a distinguishing feature did not constitute motivation as to why the Division was of the opinion that feature was not present in D1, ie it did not constitute reasoning. In this respect, the clear meaning of

Rule 68(2) EPC was that decisions were to be motivated.

X. In support of its request the respondent relied essentially on the following submissions:

Having regard to the whole disclosure of the application as filed, the amendments made did not introduce subject-matter extending beyond the content of the application as filed.

When considering novelty of the claimed subject-matter over D1, the appellant tried to combine features belonging to different embodiments, rather than considering separately each entity described in the prior art document. The fact that in some embodiments the backsheet could be provided by an adhesive film layer did not teach the skilled person to do the same in the embodiment of Figure 36, for instance. Furthermore, the provision of stretchable attachment elements made integral with a backsheet consisting of an elastic adhesive film would result in the stretchable attachment elements becoming permanently attached to themselves when folded, owing to the adhesiveness of the film constituting them. Thus, the subject-matter of claim 1 was novel over D1. Moreover, since the invention claimed in the patent in suit was different from that of D1, the priority of the patent in suit was validly claimed.

Reasons for the Decision

1. The appeal is admissible.

2. *Amendments*

2.1 Claim 1 includes all the features of claims 1 and 3 of the application as filed.

Although original claim 3 was dependent on original claim 2, in the Board's view the application as filed is not restricted to the provision of a pad securement member joined to the garment side of the main body portion, in accordance with the definition of original claim 3, only in the presence of a pressure sensitive adhesive or a mechanical fastening material in the flap securement member, in accordance with the definition of original claim 2, for the following reasons.

The application as filed (see page 17, last paragraph, to page 18, line 3) discloses that any type of fasteners or combination of fasteners used in the art can be used for the pad and flap. This constitutes a direct and unambiguous disclosure that the pad securement member can be used with any known flap securement member, thus also with flap securement members that do not comprise the pressure sensitive adhesive or mechanical fastening material referred to in original claim 2. It follows that there is support in the application as filed for an absorbent article which comprises the combination of features of claims 1 and 3 only.

Moreover, original claim 10, which is dependent on original independent claim 9, defines the corresponding feature of claim 3 that a pad securement member is formed, but does not require the corresponding feature of claim 2 that the flap securement member comprises a pressure sensitive adhesive or a mechanical fastening material.

Claim 1 defines the additional feature that the article is "releasably held" in a folded configuration, which feature is supported by the disclosure of the application as filed, see eg page 22, last paragraph.

2.2 Independent claim 8 is based on original claims 9 and 10, and additionally defines the above-mentioned feature that the article is "releasably held" in a folded configuration.

2.3 The subject-matter of the dependent claims is directly and unambiguously derivable from the application as filed, and the description of the patent in suit is adapted to be consistent with the claims as amended.

2.4 Hence, the amendments do not introduce subject-matter which extends beyond the content of the application as filed (Article 123(2) EPC).

2.5 Since the independent claims 1 and 8 have been restricted, with respect to granted claims 1 and 9, by the addition of the features of granted dependent claims 3 and 10, the amendments do not result in an extension of the protection conferred (Article 123(3) EPC).

2.6 It follows that none of the amendments gives rise to objections under Article 123(2) and (3) EPC.

3. *The state of the art according to document D1*

3.1 D1, filed on 23 July 1992, was published on 4 February 1993, after the priority date (22 December 1992) of the patent in suit, but before the filing date (16 December 1993) thereof. Following Article 158(1) and (2), it

forms part of the state of the art under Article 54(3) EPC, unless the priority claim of the patent in suit is invalid, D1 being then prior art under Article 54(2) EPC.

3.2 Document D1 discloses several embodiments of absorbent articles, in particular sanitary napkins. The embodiment of Figures 36 to 38 referred to by the appellant (see also pages 85 to 91), consists of an absorbent article comprising a main body portion (20) and a pair of flaps (stretchable attachment elements 108) having flap securement members (adhesive patches 120). The flaps are folded (see page 87, 3rd paragraph) essentially as claimed in claim 1 of the patent in suit.

In the Board’s judgment, in agreement with the Opposition Division´s view and contrary to the view of the appellant, there is no direct and unambiguous disclosure in D1 to provide, in the above-mentioned embodiment, an additional pad securement member joined to the garment side of the main body portion, for the following reasons.

D1 discloses, in connection with the above-mentioned embodiment, that the flaps can be integral with the backsheet (see page 86, third paragraph). This is, however, only one of the several possible constructions of the flaps disclosed by D1, because the flaps may be attached to the sanitary napkin, or may be unitary with a stretchable attachment device 100 which is itself joined to the napkin, or unitary with the topsheet, etc.(see page 85, penultimate paragraph, to page 86 third paragraph).

D1 also generally discloses, but not specifically with the above-mentioned embodiment of Figures 36 to 38, that a suitable backsheet of the absorbent article of D1 can be an adhesive sheet (page 49, 3rd paragraph) and that the garment facing side of this sheet can be used as a panty fastening adhesive (page 49, fourth paragraph), hence as a pad securement member. The use of an adhesive sheet as backsheet is one possible selection from the several backsheet materials disclosed by D1 (see page 48, last paragraph ff.).

There is no direct and unambiguous teaching in D1 to specifically select flaps which are integral with the backsheet from the various constructions of the flaps disclosed by D1, in combination with the specific selection, from the several backsheet materials disclosed by D1, of an adhesive sheet as suitable backsheet material.

Furthermore, the provision of flaps integral with an adhesive backsheet material used "as is" (see page 49, 4th paragraph) would not be a possibility that a skilled person would seriously contemplate for the above-mentioned embodiment shown in Figures 36 to 38 of D1, as it would result in the folded parts becoming attached to each other.

Therefore, the subject-matter of claim 1 is distinguished over the disclosure of D1.

3.3 The appellant has not submitted any arguments in respect of independent claim 8. The method of claim 8 results directly and necessarily either in an absorbent article having all the features of claim 1, or in such an article wherein the "pad securement member" is

replaced by "an adhesive printed onto the garment side of the main body portion". Since this printed adhesive is essentially equivalent to a pad securement member, the subject-matter of claim 8 is distinguished over D1 for the same reasons given for claim 1.

4. *Priority*

4.1 The appellant submitted that the priority of the patent in suit is invalid because D1 discloses the same invention of the patent in suit, or an invention of the same nature, and because it has been filed by the same applicant of D1 and is not, therefore, the first application in the sense of Article 87(1) EPC.

In accordance with the criteria set out in the decision G 2/98 (see point 9 of the reasons) of the Enlarged Board of the Appeal, the concept of the "same invention" referred to in Article 87(1) is equivalent to the concept of "the same subject-matter" and implies that the subject-matter of the claim should be directly and unambiguously derived from the previous application.

As stated above (see point 3.2), the subject-matter of independent claims 1 and 8 cannot be directly and unambiguously derived from D1. Therefore, since D1 does not disclose the same invention of the patent in suit, it does not represent the first application in the sense of Article 87(1) EPC.

It follows that it can only be concluded that the first application in the sense of Article 87(1) EPC is the earlier patent application US 07/995462 from which the patent in suit claims priority.

4.2 Furthermore, the Board is satisfied that the subject-matter of the claims of the patent in suit is directly and unambiguously derivable from the earlier patent application US 07/995462 from which the patent in suit claims priority. Therefore, the requirements for claiming priority set out in Article 88(3) EPC are met.

4.3 Hence, the priority of the patent in suit is validly claimed.

4.4 As a consequence, it must be concluded that: document D1 forms part of the state of the art under Article 54(3) EPC, and document D2, which was published on 20 July 1993, after the valid priority date of the patent in suit, does not form part of the prior art under Article 54(2) or (3) EPC.

5. *Novelty*

As stated above (see point 3), the claimed subject-matter is distinguished from the disclosure of document D1. The Board, noting that the appellant has not referred to other documents during the appeal proceedings, is satisfied that the subject-matter of independent claims 1 and 8, and of dependent claims 2 to 7, is distinguished from the remaining available prior art and therefore concludes that it meets the requirement of novelty.

6. *Inventive step*

Since document D1 forms part of the state of the art under Article 54(3) EPC, pursuant to Article 56 EPC it cannot be taken into consideration in assessing inventive step. Furthermore, the appellant has not

filed any submissions in respect of inventive step which means that no counterarguments are available to put the conclusion of the Opposition Division in doubt. Since the Board does not see a reason to deviate from the conclusion arrived at by the Opposition Division in this respect, it also finds that claim 1 meets the requirement of Article 56 EPC.

7. *The alleged substantial procedural violation*

7.1 Pursuant to Rule 67 EPC, allowability of the appeal constitutes a prerequisite for reimbursement of the appeal fee. Since the appeal cannot be allowed, the appellant’s request for reimbursement of the appeal fee cannot be granted.

7.2 For the sake of completeness, the Board observes that the significance of the alleged failure in the reasoning under paragraph 4.2 of the decision under appeal does not amount to a substantial procedural violation or a fundamental deficiency which would have implied the need for an immediate remittal to the first instance without examining the merit of the appeal.

Order

For these reasons it is decided that:

1. The appeal is dismissed.

2. The request for reimbursement of the appeal fee is rejected.

The Registrar: The Chairman:

M. Patin P. Alting van Geusau