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D E C I S I O N
of 14 January 2004

Case Number: T 0883/01 - 3.2.6

Application Number: 95918878.0

Publication Number: 0757550

IPC: A61F 13/56

Language of the proceedings: EN

Title of invention:

Closure system for disposable pull-on pants having a stretchable waistband

Patentee:

THE PROCTER & GAMBLE COMPANY

Opponent:

Kimberly-Clark Worldwide, Inc.

Headword:

-

Relevant legal provisions:

EPC Art. 56, 123

EPC R. 88

Keyword:

"Main request - inventive step (no)"

"Auxiliary request - amendments (allowable)"

"Auxiliary request - inventive step (yes)"

Decisions cited:

-

Catchword:

-



Case Number: T 0883/01 - 3.2.6

D E C I S I O N
of the Technical Board of Appeal 3.2.6
of 14 January 2004

Appellant: KIMBERLY-CLARK WORLDWIDE, INC.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 22 May 2001
rejecting the opposition filed against European
patent No. 0757550 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: P. Alting van Geusau
Members: H. Meinders
M.-B. Tardo-Dino

Summary of Facts and Submissions

I. The appeals are from the decision of the Opposition Division of 22 May 2001 rejecting on the one hand the opponent's opposition and on the other hand the patentee's request for correction of the patent, thus maintaining European Patent 0 757 550 as granted according to the auxiliary request of the patentee.

In its decision the Opposition Division considered that the request for correction of claim 1 as granted resulted in an extension of protection (Article 123(3) EPC). It considered that the subject-matter of claim 1 as granted fulfilled the requirements of Article 123(2) EPC as well as those of novelty and inventive step (Articles 54 and 56 EPC). In particular the prior art disclosed in the following documents has been taken into account:

D2: US-A-5 246 433

D3: US-A-5 304 162

D4: GB-A-2 244 422

D5: EP-A-0 206 208.

II. Against this decision the patentee filed an appeal on 20 July 2001, paying the appeal fee on that same date.

The appellant-patentee filed its statement of grounds of appeal on 26 September 2001.

The opponent filed an appeal against this decision on 1 August 2001, paying the appeal fee on that same date.

The appellant-opponent filed its statement of grounds of appeal on 1 October 2001.

III. Oral proceedings were held on 14 January 2004.

The appellant-patentee requested setting aside of the decision under appeal and maintenance of the patent on the basis of its main request (claims 1 to 9) presented during the oral proceedings or according to its auxiliary request, the latter with the following documents:

Claims 1 to 8 and

Description, pages 2 to 6, both filed during the oral proceedings of 14 January 2004,

Figures 1 to 9 as granted.

The appellant-opponent requested dismissal of the appeal of the appellant-patentee, as well as setting aside the decision under appeal and revocation of the patent.

IV. The wording of independent claim 1 according to the appellant-patentee's **main request** is as follows:

"A pull-up absorbent disposable pant (20) comprising:

a chassis (14) including a liquid impervious outer layer (48) having an inner surface (46);

said chassis (14) comprising a front panel (56), a back panel (58), each disposed at opposite ends of said chassis (14), and a crotch panel (57) intermediate said front and back panels (56, 58), and side panel flaps (30) extending laterally from said front and back panels (56, 58);

an absorbent core (24) disposed proximate said inner surface (46);

said side panel flaps (30) each having lateral edges and said front and back panels (56, 58) and said side panel flaps (30) having end edges (18);

said side panel flaps (30) extending from said front panel (56) and said back panel (58) joined together forming side panels (31);

elastic panels (90) associated with said side panels (31) providing elasticity to said side panels (31);
elastic members (76) associated with said front panel (56) and said back panel (58) and disposed proximate to said end edges (18) forming an elastic waistband (34);
fasteners (16) engageable and attachable to effectively reduce said waistband (34) size of said pant (20);

said absorbent disposable pant characterised by

said lateral edges of said side panel flaps (30) being of similar length, said side panel flaps (30) extending from said front panel (56) and said back panel (58) being joined together (10) along the entire length of said lateral edges of said side panel flaps (30),

fasteners (16) each comprising an elongated layer disposed on and attached to at least one of said front and back panels (56, 58) and extendible to the other of said back and front panels (56, 58) across said side panels (31), said fasteners (16) preferably being disposed proximate to one of said end edges (18) of said chassis (14)".

- V. Claim 1 according to the **auxiliary request** of the appellant-patentee reads as follows (in bold the differences in respect of the main request):

"A pull-up absorbent disposable pant (20) comprising:

a chassis (14) including a liquid impervious outer layer (48) having an inner surface (46);

said chassis (14) comprising a front panel (56), a back panel (58), each disposed at opposite ends of said chassis (14), and a crotch panel (57) intermediate said front and back panels (56, 58), and side panel flaps (30) extending laterally from said front and back panels (56, 58);

an absorbent core (24) disposed proximate said inner surface (46);

said side panel flaps (30) each having lateral edges and said front and back panels (56, 58) and said side panel flaps (30) having end edges (18);

said side panel flaps (30) extending from said front panel (56) and said back panel (58) joined together forming side panels (31);

elastic panels (90) associated with said side panels (31) providing elasticity to said side panels (31);
elastic members (76) associated with said front panel (56) and said back panel (58) and disposed proximate to said end edges (18) forming an elastic waistband (34);
fasteners (16) engageable and attachable to effectively reduce said waistband (34) size of said pant (20);

said lateral edges of said side panel flaps (30) being of similar length, said side panel flaps (30) extending from said front panel (56) and said back panel (58) being joined together (10) along the entire length of said lateral edges of said side panel flaps (30),

characterised by

fasteners (16) each comprising an elongated layer disposed on and **each anchored** to one of said front and back panels (56, 58) **by means of high-strength adhesive, thermal bonding or ultrasonic bonding and overlying the elastic member (76) associated with said front or back panel (56, 58) such that pulling on the fastener (16) extends the elastic member (76)** and extendible to the other of said back and front panels (56, 58) across said side panels (31), said fasteners (16) being disposed proximate to one of said end edges (18) of said chassis (14)".

VI. The arguments of the appellant-patentee can be summarised as follows:

Main and auxiliary request - amendments:

The deletion of "said" in relation to the second mention of the elastic members (76) in the preamble of claim 1 was an allowable correction as it was clear from the application as filed as well as the patent as granted that two different elastic parts were envisaged in the disposable pant: elastic panels (90) associated with the side panels (31) and elastic members (76) associated with the front and the back panel (56, 58). Thus it was clear that an error had occurred, what the error was and what the correction should be. Extension of protection thus could neither ensue (Article 123(3) EPC).

Main request:

D2 should be considered as closest prior art instead of D3, as it clearly concerned a training pant. D3 related to a diaper and mentioned the application of its teaching to training pants only in passing, amongst a large number of other possible products. If the latter were taken as closest prior art, inventive step had to be acknowledged over it as the features which distinguished the subject-matter of claim 1 over the product discussed therein were not rendered obvious by the other available prior art. In any case, if the teaching of D3 were applied to a training pant, it was not evident that the latter would have elasticated side panels as well as the fasteners attached to the front

and back panel, they could just as easily be fixed to the side panels, as in D4.

Auxiliary request - inventive step:

In claim 1 of this request it was now further specified how the fasteners were permanently fixed ("anchored") to the front and back panel (so as to distinguish from the releasable fasteners as disclosed in D3), as well as the relationship between the fasteners and the elastic member in the waistband of the training pant. None of the available prior art provided an indication to that solution.

VII. The appellant-opponent considered the correction requested by the appellant-patentee not allowable, as the word "said" could not be deleted without infringing Article 123(3) EPC. It could not remain either, as it amounted to added-subject-matter pursuant to Article 123(2) EPC.

Main request:

D3 was closest prior art, relating explicitly to training pants as well as disclosing fasteners extending from the back to the front panel. The skilled person, on reading the disclosure of D3, would - when applying the teaching of D3 to the training pant mentioned therein - choose the best training pant available at that time, which comprised elasticated side panel flaps joined along the entire length of their lateral edge to form elasticated side panels, and elastic members associated with the front and the back panel in the waistband region, as was evidenced for

instance by D2. In doing this, he would inevitably arrive at the training part of claim 1.

Auxiliary request:

In respect of claim 1 according to the auxiliary request, no further arguments were submitted.

Reasons for the Decision

1. The appeals are admissible.

The appeal of the patentee is admissible as it was adversely affected by the decision under appeal, which rejected its request for correction of claim 1 as granted.

2. *Main request - amendments (Article 123 EPC)*

As the main request is to be refused for the reasons set out below, the amendments carried out in claim 1 according to this request need not be discussed here. In any case they form part of the amendments discussed in connection with the auxiliary request.

3. *Main request - novelty (Article 54 EPC)*

Novelty of claim 1 as amended was not any longer contested by the appellant-opponent. The Board ascertained whether any one of the available prior art documents disclosed all features of claim 1 and found that this was not the case.

4. *Main request - inventive step (Article 56 EPC)*

4.1 The Board considers D3 to disclose the closest prior art for the discussion of inventive step of the subject-matter of claim 1. Not only does D3 disclose a diaper with elongated fasteners associated with its front and back panel, it also declares that the proposed solution for a diaper is intended for use with a wide variety of garments, including "briefs, training pants, or the like" (column 1, lines 11 to 19).

Further, it is also more closely related than D2 - which was argued by the appellant-patentee to be the closest prior art - to the objective of the disposable pant as claimed. It concerns namely the adaptability, by the user, of the size of a disposable absorbent article as opposed to the "manufacturer adaptability" of this size by providing a number of different sizes (see D3, column 1, lines 41 to 49 and 61 to column 2, line 4 in comparison with column 1, lines 27 to 49 of the patent in suit).

D2, on the other hand, is concerned with a one-size-fits-all training pant, thus one without either "manufacturer-size-adaptability" or "user-size-adaptability" (see column 1, lines 31 to 43).

4.2 D3 discusses in detail the solution to this problem for diapers, but declares the solution also applicable to briefs and training pants, as discussed above. D3 is silent on the technical features of such a training pant.

In conclusion, the subject-matter of claim 1 of the main request only distinguishes itself from the disclosure of D3 by the features which are specific for such a training pant:

side panel flaps extending laterally from the front and back panel joined together along the entire length of their lateral edges to form side panels,

elastic panels associated with the side panels providing elasticity thereto,

elastic members associated with the front and the back panels, disposed proximate to the end edges forming an elastic waistband.

- 4.3 A skilled person having knowledge of D3 will, when following up the suggestion of applying the teaching, discussed therein for a diaper, to a training pant, have to decide on which type of training pant he will choose.

D3 is a patent granted in April 1994. The Board considers that at that time the "state of the art" training pant, i.e. the best training pant available on the market, comprised not only side panel flaps joined along the entire length of their lateral edges to form side panels, the side panels being provided with elastic panels, but also elastic members associated with the front and the back panel in the waistband region. Such a training pant is for instance disclosed in D2, a patent granted in September 1993.

A skilled person, when having to choose a training pant to which it should apply the teachings of D3 as suggested, will choose the commonly available training pant, such as the one disclosed in D2. In applying the teachings of D3 to it, he will arrive at the subject-matter claimed in claim 1 according to the main request.

In fact, also the patent in suit, in its discussion of the background art useful for understanding the invention according to Rule 27(1)(b) EPC, considers D2 to be disclosing a training pant which is in need of improvement.

- 4.4 The argument of the appellant-patentee, that the skilled person would not necessarily maintain the fasteners attached to the front or the back panels, but could attach the fasteners to the elasticated side panels of a training pant, such as in D4, cannot hold.

The general teaching of D3 is to have elongated fasteners of sufficient length to allow not only for modest adjustments, but also for a more important adjustment of the waist circumference. This is achieved by a sufficient length of the fastener of D3, provided with two Z-folds. This effect can only be achieved with a fastener of sufficient length, i.e. one extending from the back panel to the front panel or vice-versa and not with one fixed to the side panels of the training pant.

- 4.5 For the above reasons the subject-matter of claim 1 according to the main request does not involve inventive step. This request is therefore to be refused.

5. *Auxiliary request - Amendments (Article 123(2) and (3) EPC)*

5.1 Claim 1 has been amended in respect of the version as granted by replacing (changes are in bold type):

"elastic members (76) associated with said side panels (31) providing elasticity to said side panels (31); said elastic members (76) associated with said front panel (56) and said back panel (58) and disposed proximate to said end edges (127) forming an elastic waistband (34)"

by:

"elastic **panels (90)** associated with said side panels (31) providing elasticity to said side panels (31); [...] elastic members (76) associated with said front panel (56) and said back panel (58) and disposed proximate to said end edges (18) forming an elastic waistband (34)".

5.2 The appellant-opponent argued that this amendment did not comply with Article 123(3) EPC, as the claim as granted required the elastic members associated with the side panels to be one and the same as the elastic members associated with the front and back panel forming an elastic waistband. After the amendment there were now two different elastic means, leading to an extension of the scope of the claim.

Further, given the fact that the wording of claim 1 as granted did not comply with Article 123(2) EPC, as the application as filed consistently presented the elastic means 76 and 90 as two different elastic means, the new

claim fell in the "inescapable trap" of Article 123(2) and (3) EPC, because remedying the Article 123(2) EPC deficiency would lead to a claim not fulfilling Article 123(3) EPC.

- 5.3 The Board considers that from the description as originally filed it is directly and unambiguously derivable that the invention only concerns an arrangement with separate elastic means associated with the side panels on the one hand and with the front/back panels on the other. These were elastic **panels** (90) and elastic **members** (76) respectively (see pages 6 and 7 of the application as originally filed). This is also stated by the appellant-opponent in its letter of 1 October 2001, page 1 last paragraph.

Thus the subject-matter of claim 1 as granted is not in conformity with the requirements of Article 123(2) EPC, as it creates the impression that the elastic means in the front panel, in the back panel and in the side panels are one and the same.

- 5.4 The question to be answered is whether the wording as now amended infringes the requirements of Article 123(3) EPC.

The Board considers that the wording of the relevant passage of claim 1 as granted: "... elastic members (76) associated with said side panels (31) providing elasticity to said side panels (31); said elastic members (76) associated with said front panel (56) and said back panel (58) and disposed proximate to said end edges (127) forming an elastic waistband (34); ..." does not **exclusively** mean that the elastic means

associated with the side panels are the same as the ones associated with the front/back panels, as argued by the appellant-opponent. It is, however, an embodiment **possibly** covered by this wording and thus included in the protection conferred by the patent in suit.

- 5.5 However, this passage of claim 1 as granted is of such awkward wording that it could mean something else as well. In such a situation the skilled reader, who wishes to establish what is the extent of protection conferred by this claim and thus is interested in technical reality, will revert to the description to find out what actually could have been meant.

Article 69 EPC and its Protocol on interpretation in fact state that for determining the extent of protection as defined by the claims one should have recourse to the description and drawings, if any. The skilled person would, in fact, already have been prompted to do so as preceding the passage referred to above reference signs (112, 114, 116, 118, 120, 122, 127) are used which are not present in the drawings (nor in the description, for that matter).

From the detailed description of the invention starting at column 4, line 58 of the patent as granted, relating to the envisaged embodiments of the invention, and from the drawings he will derive directly and unambiguously that the elastic members 76 associated with the front- and back panel and the elastic panels 90 associated with the side panels are in fact two separate items and that the claim should in fact be read as requested by the appellant-patentee (however with the use of "panel"

instead of "member" for the elastic means associated with the side panels).

Thus the protection conferred by the claim as granted covers, apart from the possibility that the elastic means on all panels are one and the same, **also** the embodiment where they are separate.

5.6 In such a situation the Board cannot see how a limitation to one of these two embodiments, which is furthermore originally disclosed in the application documents as originally filed (see point 5.2 above), would infringe the requirements of Article 123(3) EPC. The above mentioned amendment is therefore in conformity with the requirements of Article 123(2) and (3) EPC.

5.7 In view of the above the discussion on whether the wording of claim 1 as granted is based on an error, whether the error is obvious and its correction is derivable from the application as filed and whether such a correction pursuant to Rule 88 EPC is of a strictly declaratory nature and thus not infringing Article 123(3) EPC as submitted by the appellant-patentee, is redundant.

5.8 Claim 1 has further been limited by the addition of the following features (in brackets the disclosure in the original application documents):

the fasteners (16) are anchored to one of the front or back panels by means of high-strength adhesive, thermal bonding or ultrasonic bonding (page 7, fourth paragraph),

the fasteners overlies the elastic member (76) associated with said front or back panel, such that pulling on the fastener extends the elastic member (page 6, last paragraph, page 7, second paragraph and page 8, first full paragraph) and are extendible to the other of said front and back panels across said side panels (page 3, second full paragraph).

5.9 Finally, claim 1 has been amended such that reference signs of embodiments which no longer form part of the patent as granted have been deleted and incorrect ones have been corrected. The amendments to the dependent claims concern corrections of reference signs which are no longer applicable and of typographical errors. The amendments to the description are necessary for bringing it into line with the amended claims (Article 84 EPC).

5.10 These amendments do not give rise to objections under Articles 84 and 123 EPC.

6. *Auxiliary request - Inventive step (Article 56 EPC)*

6.1 The subject-matter of claim 1 as amended according to the auxiliary request distinguishes itself from that of claim 1 according to the main request by the following additional features:

the fasteners are each anchored by means of high-strength adhesive, thermal bonding or ultrasonic bonding to one of said front and back panels,

the fasteners overlie the elastic member associated with said front or back panel such that pulling on the fastener extends the elastic member.

With these features it is guaranteed that the fasteners are firmly attached to the pull-up pant, thus are more durable, and that the waistband of the pant is effectively reduced, also since the side panels are gathered or folded under the fasteners extending across them (see patent in suit, column 6, lines 14 to 16 and 35 to 41).

- 6.2 The Board establishes that none of the prior art documents available in the file gives an indication to modify the teaching of D3, even if applied to a training pant, in the above manner. Anchoring the fasteners in the manner as claimed departs wholly from the teaching of D3 relating to releasable fasteners. Having the fasteners overlie the elastic members in the front and back panel is not evident from D2.

Also the appellant-opponent did not furnish any further arguments regarding lack of inventive step against present claim 1.

- 6.3 Thus the Board concludes that the subject-matter of claim 1 according to the auxiliary request is not obvious within the meaning of Article 56 EPC and therefore involves inventive step (Article 56 EPC).

The subject-matter of dependent claims 2 to 8 concerning preferred embodiments of the pull-up disposable pant as claimed in claim 1 (Rule 29(3) EPC), thus also fulfils the requirements as to novelty and inventive step.

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 on the basis of the following documents:
 - claims 1 to 8 of the auxiliary request, filed during the oral proceedings,
 - pages 2 to 6 of the description, filed during the oral proceedings,
 - figures 1 to 9 as granted.

The Registrar:

The Chairman:

M. Patin

P. Alting van Geusau