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**D E C I S I O N**  
of 20 October 2005

**Case Number:** T 0993/01 - 3.3.02

**Application Number:** 95943693.2

**Publication Number:** 0808157

**IPC:** A61K 9/70

**Language of the proceedings:** EN

**Title of invention:**  
Medicated tissue paper product

**Patentee:**  
The Procter & Gamble Company

**Opponent:**  
Kimberly-Clark Worldwide, Inc.  
SCA Hygiene Products GmbH

**Headword:**  
Medicated tissue/PROCTER & GAMBLE

**Relevant legal provisions:**  
EPC Art. 123(2)

**Keyword:**  
"Amendments - added subject-matter (yes) "

**Decisions cited:**  
-

**Catchword:**  
-



Case Number: T 0993/01 - 3.3.02

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.02  
of 20 October 2005

**Appellant:** THE PROCTER & GAMBLE COMPANY  
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**Respondents:** Kimberly-Clark Worldwide, Inc.  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 6 July 2001  
revoking European patent No. 0808157 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** U. Oswald  
**Members:** H. Kellner  
J. P. Seitz

## Summary of Facts and Submissions

- I. European patent No. 0 808 157 based on application No. 95 943 693.2 was granted with 8 claims.

Claim 1 as granted read as follows:

"A medicated tissue (10) for applying medication to a user, comprising :

a substrate (12) comprising two or more tissue paper plies (16, 18), said substrate having two exposed surfaces (20, 21); and

a semisolid therapeutic substance transferrably carried on at least one exposed surface (20, 21) of said substrate (12), such that, in use, said therapeutic substance (14) is transferable from said substrate (12) to said user,

characterised in that said therapeutic substance (14) comprises a lotion (34) and a medicinal component (36), said medicinal component (36) is dispersed substantially throughout said lotion (34), said lotion (34) having both solid and liquid components, the solid components being miscible with and entrapping the liquid components on the surface of the plies so that the therapeutic substance (14) does not fully impregnate or saturate first ply (16) or second ply (18)."

- II. Opposition was filed against the granted patent under Article 100(a) EPC for lack of novelty and inventive step and under Article 100(b) EPC for insufficiency of disclosure.

The following document was cited inter alia during the proceedings before the opposition division and the board of appeal:

(1) US 4 481 243

III. By its decision pronounced on 10 May 2001 and posted on 6 July 2001, the opposition division revoked the patent under Article 102(1) EPC because neither the set of claims of the main request nor the set of claims of the first, second and third auxiliary requests filed in writing and during the oral proceedings met the requirements of the EPC.

The subject-matter of the main request was not new with respect to document (1), disclosing all the characteristics of the patentee's claimed medicated tissue.

With respect to the set of claims of the first auxiliary request the opposition division noted that it contained features that did not fulfil the requirements of Article 123(2) EPC.

The subject-matter of the second and third auxiliary request was regarded to be not inventive over the teaching of document (1).

IV. The appellant (patentee) lodged an appeal against said decision and requested that the patent be maintained as granted or alternatively on the basis of one of three auxiliary requests.

V. On 20 October 2005, oral proceedings took place before the board.

During these oral proceedings the appellant introduced three sets of claims as main request and first and second auxiliary requests together with pages 2 and 4 of amended description.

The subject-matter of the first claim of the main request substantially includes the subject-matter of claims 1, 3 and 5 as granted, with the proviso that with respect to claims 3 and 5 "comprises" is replaced by "consists of". Its wording is as follows:

"A medicated tissue (10) for applying medication to a user, comprising :

a substrate (12) comprising two or more tissue paper plies (16, 18), said substrate having two exposed surfaces (20, 21); and

a semisolid therapeutic substance transferably carried on at least one exposed surface (20, 21) of said substrate (12), such that, in use, said therapeutic substance (14) is transferable from said substrate (12) to said user,

characterised in that said therapeutic substance (14) comprises a lotion (34) and a medicinal component (36), said medicinal component (36) being dispersed substantially throughout said lotion (34), said lotion (34) having both solid and liquid components, the solid components being miscible with and entrapping the liquid components on the surface of the plies so that the therapeutic substance (14) does not fully impregnate or saturate first ply (16) or second ply (18),

and wherein said medicinal component consists of material selected from viricides, analgesics and a medicinal scent, said medicinal scent selected from natural menthol, synthetic menthol and camphor."

The only difference in corresponding claim 1 of the first auxiliary request with respect to claim 1 of the main request is the inclusion of the following wording between "second ply (18)," and "and wherein said medicinal component ...". The included wording relates to claim 2 as granted; it reads:

"wherein said therapeutic substance comprises from 0.25% to 50% of said medicinal component and from 50% to 99.75% of said lotion"

The additional inclusion to arrive at the wording of claim 1 of the second auxiliary request relates to claim 4 as granted; it is positioned at the end of the inclusion set out above and it reads:

", wherein said lotion comprises by weight from 40% to 60% mineral oil, from 6% to 14% paraffin wax, from 15% to 25% cetearyl alcohol, from 1% to 5% aloe extract, and from 5% to 14% steareth-2,"

Additionally, the appellant submitted amended pages 2 and 4 of the description of the granted patent, where the sentences defining "medicated" and "medicine" and "An exemplary mentholated medicinal scent" (see column 2, line 37 to line 42 and column 6, line 9 to 11) were deleted.

VI. The appellant mainly argued that all claims on file had been reworded in order to overcome the objections raised with regard to original disclosure, novelty and inventive step.

With respect to the ranges given for the concentrations of components in the therapeutical substance, it emphasised that it was clear to the skilled person that "% of medicinal component" in any case meant the amount of the pure therapeutically active compound and not any composition containing it.

VII. The respondents' arguments may be summarised as follows:

In their view, inserting the term "consists of" with regard to the "medicinal component" in all requests, meant that any concentrations mentioned in the sets of claims had to refer to the pure therapeutically active compound. In the claims and in the description of the granted patent, however, with respect to the medicinal component to be included, the concentrations referred to an ointment or a medicine.

Therefore, definitions of concentrations with reference to pure therapeutically active compounds were not disclosed in the application as filed.

VIII. The appellant (patentee) requested that the decision under appeal be set aside and that the patent be maintained on the basis of either one of his three requests all filed during the oral proceedings.

The respondents (opponents) requested that the appeal be dismissed.

## Reasons for the Decision

1. The appeal is admissible.
2. The sets of claims of the three requests represent a response to the arguments set out during the proceedings. They have to be regarded as an attempt to overcome the problems discussed by narrowing the scope of the subject-matter of the patent in suit and they were therefore admitted into the proceedings.
3. As regards the subject-matter of the patent in suit as now claimed in amended form, the medicinal component being present in the therapeutic substance has to

"consist of material selected from viricides, analgesics and a medicinal scent, said medicinal scent selected from natural menthol, synthetic menthol and camphor".

Consequently, the definitions of ranges of the concentrations of the medicinal component contained in the therapeutic substance, as set out in claim 2 of the main request and in claim 1 of the first and the second auxiliary request have to refer to the pure therapeutically active compounds like an active viricidal compound as a viricide or like menthol as a medicinal scent.

However, in the application as filed the medicinal component is defined as "medicines like viricides ..." and "mentholated medicinal scent is an ointment which



is sold under the trademark "VICKS VAPORUB"<sup>®</sup>" (see page 7, second paragraph).

In this context, which is essential for understanding the reference for %-concentration ranges given for the "medicinal component" as originally disclosed, the whole formulation including additional substances and one or more therapeutically active compounds is the basis and not the pure therapeutically active compound.

Therefore, the amendment replacing "comprises" by "consists of" does not fulfil the requirements of Article 123(2) EPC.

4. In these circumstances, the arguments of the appellant cannot succeed:

The appellant submitted that it was clear from the claims that "% of medicinal component" in any case referred to the amount of the pure therapeutically active compound and not any composition containing it.

Therefore, an amendment in claims 1 of all the requests, concerning substitution of the term "comprises" by the term "consists of" did not change the teaching of the patent in suit with reference to the concentration of the medicinal component in the therapeutical substance.

However, even if it was really true in any circumstances that "% of medicinal component" could mean nothing else than a reference to the relative amount of a defined, therapeutically active compound, the wording of claim 1 of the patent in suit exhibiting terms like "therapeutical substance" in context with a

"lotion" and a "medicinal component" being part of it, cannot be understood without any help from the description. Without the definitions in the description, the person skilled in the art, for instance from his own common general knowledge, would not understand any difference between "therapeutical substance" and "medicinal component".

Thus, understanding the meaning of claim 1 on the basis of the definitions in the description, the skilled person has to observe all the definitions given for the "medicinal component" and must come to the conclusion that the term comprises medicines or ointments. Such medicines or ointments contain not only the pure therapeutically active compound but also different kinds of additional substances like solvents or carriers.

5. Accordingly, the set of claims of the main request as well as the set of claims of the first and the second auxiliary request contravene Article 123(2) EPC.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:

A. Townend

U. Oswald