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D E C I S I O N
of 2 July 2004

Case Number: T 1036/01 - 3.2.6

Application Number: 95109130.5

Publication Number: 0687453

IPC: A61F 13/15

Language of the proceedings: EN

Title of invention:

Absorbent article having a body accomodating absorbent core

Patentee:

KIMBERLY-CLARK WORLDWIDE, INC.

Opponent:

SCA Hygiene Products AB

Headword:

-

Relevant legal provisions:

EPC Art. 54(1), 56, 83, 84, 123(2),(3)

Keyword:

"Admissibility of amendments - yes; (reformatio in peius - no)"

"Sufficiency of disclosure - yes"

"Clarity of claim 1 - yes"

"Novelty and inventive step - yes"

Decisions cited:

G 0001/99

Catchword:

-



Case Number: T 1036/01 - 3.2.6

D E C I S I O N
of the Technical Board of Appeal 3.2.6
of 2 July 2004

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

Representative: Hammond, Andrew David
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Respondent: KIMBERLY-CLARK WORLDWIDE, INC.
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Representative: Davies, Christopher Robert
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
24 July 2001 concerning maintenance of European
patent No. 0687453 in amended form.

Composition of the Board:

Chairman: P. Alting van Geusau
Members: G. C. Kadner
J. H. Van Moer

Summary of Facts and Submissions

- I. The mention of the grant of European patent No. 687 453 in respect of European patent application No. 95 109 130.5 filed on 13 June 1995 and claiming a US-priority from 13 June 1994 was published on 7 April 1999.
- II. Notice of opposition was filed on 4 January 2000 by the Appellant (Opponent), based on the grounds of Article 100 (a) EPC
- III. By decision announced during oral proceedings on 3 July 2001 and posted on 24 July 2001 the Opposition Division maintained the patent in amended form with the following claim 1:

"A sanitary napkin comprising a liquid-permeable cover (12), a liquid impermeable baffle (14), and wherein an absorbent core (18) is positioned between said cover and said baffle, the core having a body-facing surface and a predetermined length and thickness, and comprising a central, longitudinal flexure axis (24) which is aligned along the longitudinal center line Y-Y of the core thereby dividing said absorbent core (18, 118) into first and second symmetrical members (26, 28) wherein each of said members has an outer boundary (32), said first member (26) having a second flexure axis, and said second member (28) having a third flexure axis, the core preferentially bending along each of said flexure axes so that the core can acquire a "W"-shape when subjected to lateral compression, characterised in that the central longitudinal flexure axis extends over the entire length of the absorbent

core and is defined either by a region of less dense absorbent, or by a slit or channel extending from the body-facing surface through 40 to 95 percent of the core."

The Opposition Division was of the opinion that the amended claims did not give rise to objections under Article 123(2), (3) and Article 84 EPC. The subject-matter of claim 1 met the requirements of Article 54(1) and 56 EPC, and therefore the patent could be maintained as amended on the basis of this claim together with dependent claims 2 to 12.

- IV. On 19 September 2001 notice of appeal was lodged against the decision together with payment of the appeal fee. The statement of grounds of appeal was filed on 29 November 2001.

The Appellant pursued its request for revocation of the patent because of an alleged inadmissible extension of the subject-matter of claim 1 and for lack of inventive step. The appellant further requested reimbursement of the appeal fee since it had not sufficiently been given the possibility to comment on the amended description of the patent in suit during the oral proceedings.

- V. In a communication dated 16 February 2004 the Board informed the parties that discussion would be necessary as to whether the application as originally filed contained adequate support for the subject-matter of the amended claim 1. In case present claim 1 would be found formally acceptable, novelty and inventive step would have to be discussed during oral proceedings.

As regards the request for reimbursement of the appeal fee the Board expressed the opinion that the Opposition Division committed a procedural violation by not giving the appellant sufficient opportunity to comment on the amendments made to the description. However, the further requirement of Rule 67 EPC to allow reimbursement should also be considered.

VI. Oral proceedings were held on 2 July 2004. The following documents considered at first instance proceedings were discussed again:

D3: EP-A-0 136 524

D5: US-A-4 029 101

D6: US-A-3 343 543

The Appellant requested that the decision under appeal be set aside and that the European patent No. 687 453 be revoked. The request for reimbursement of the appeal fee was withdrawn.

The Respondent (Patentee) requested that the appeal be dismissed and that the patent be maintained on the basis of the documents filed during the oral proceedings together with the figures as granted.

Claim 1 of this request reads as follows:

"A sanitary napkin comprising a liquid-permeable cover (12), a liquid impermeable baffle (14), and wherein an absorbent core (18) is positioned between said cover and said baffle, the core having a body-facing surface

and a predetermined length and thickness, and comprising a central, longitudinal flexure axis (24) which is aligned along the longitudinal center line Y-Y of the core thereby dividing said absorbent core (18, 118) into first and second symmetrical members (26, 28) wherein each of said members has an outer boundary (32), said first member (26) having a second flexure axis, and said second member (28) having a third flexure axis, characterised in that the central, longitudinal flexure axis (24) in combination with the second and third flexure axes allow the core to preferentially bend upward along the central longitudinal axis and toward the cover in a convex configuration when the sanitary napkin is subjected to lateral compressive forces, the second and third flexure axes allowing the core to bend along these axes to acquire a "W"-shape if the absorbent core is sufficiently compressed, and that the central longitudinal flexure axis extends over the entire length of the absorbent core and is defined either by a region of less dense absorbent, or by a slit or channel extending from the body-facing surface through 40 to 95 percent of the core."

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

Claim 1 as maintained by the Opposition Division violated Article 123(2) EPC because the feature relating to the core preferentially bending along each of said flexure axes, which now also included a core with a preferential bending along both the second and third flexure axes, was not disclosed in the application as originally filed. In current claim 1

this feature of claim 1 upheld by the Opposition Division was no longer present which led to a "*reformatio in peius*" situation.

Furthermore, the patent in suit did not disclose the claimed invention in a manner sufficiently clear to enable a skilled person to carry it out. In particular the patent did not contain any disclosure, neither in the general description nor in the examples, of how the absorbent core, starting from an inverted "V"-shape could acquire a "W"-shape when subjected to further compressive force.

Claim 1 was not supported by the description resulting in a violation of Article 84 EPC. The embodiments of Figures 2 to 10 did not fall within the scope of claim 1 and should be deleted.

The subject-matter of claim 1 was not novel with respect to the sanitary napkin disclosed in D6. Figure 3 of that document already showed the "W"-shape of the absorbent core. At least the claimed solution was not inventive when taking due account of the prior art documents. D3 disclosed the deformation of the absorbent core into a "W"-shape along three flexure axes, and when trying to achieve better fluid distribution, the skilled person would pick up the teachings of D6 or D5 by extending the grooves for distribution of the fluid over the entire length of the absorbent core, thus arriving at the sanitary napkin according to claim 1 in an obvious manner.

VIII. The submissions of the Respondent can be summarised as follows:

There was no question of "*reformatio in peius*" because claim 1 was amended in accordance with the requirements set out in decision G 1/99. By the introduction of the new features the subject-matter of claim 1 was limited to an absorbent core which in a first step preferentially bent upward along the first flexure axis and upon further compression was allowed to acquire a "W"-shape by bending along the second and third flexure axis which was in fact a possibility already included in the claim as maintained by the Opposition Division.

The insufficiency objection was without foundation. The skilled person was given a number of possibilities as to how the core material should be configured so as to obtain flexure axes and also the figures showed how such different possibilities would bend to a "W"-shape during use.

The subject-matter of the amended claim 1 was novel and inventive when compared with the teachings of the cited prior art documents. D6 neither disclosed a "W"-shape of the absorbent core nor a flexure axis extending over the entire length of the core having a depth of 40 to 95% of the core.

None of the prior art documents contained an indication towards the controlled deformation of the core as defined in claim 1; in a first step being bent upward to an inverted "V"-shape and then upon sufficient compression acquiring a "W"-shape. Even when starting from D3 as closest prior art, since the core according to D6 was not able to acquire a "W"-shape, a combination of its teachings with those of D3 was

merely based on hindsight and in any case did not lead to the combination of claimed features.

Reasons for the Decision

1. The appeal is admissible.

2. *Amendments*

Besides other amendments claim 1 as maintained by the Opposition Division had been amended with respect to claim 1 as granted by introduction of the feature "... the core preferentially bending along each of said flexure axes so that the core can acquire a "W"-shape when subjected to lateral compression...". However, in connection with the term "preferentially" the application as originally filed provides only support for the core to preferentially bend upward along the flexure axis 24 in a convex configuration, when starting lateral compression, thereby initially forming an inverted "V"-shape in the central region of the core (see A-document column 1, lines 48 to 53; column 2, lines 19 to 25; column 7, line 50 to column 8, line 3; column 15, claim 3). Therefore the claim upheld by the Opposition Division violated Article 123(2) EPC.

In current claim 1 the feature in question was replaced by those of the first part of the characterising portion according to which a two-stage bending of the core takes place along the flexure axes during lateral compression of the core. A basis for this amendment is found in the original application document (page 3, 2nd paragraph; page 8, last sentence). The appellant

considered that this amendment, although perhaps disclosed in the application as filed, should nevertheless be refused because it gave rise to a "*reformatio in peius*" situation.

However, considering the conclusions drawn in the decision G 1/99 ("*reformatio in peius*", OJ 2001, 381) a "*reformatio in peius*" situation can be avoided by an amendment introducing one or more originally disclosed limiting features which would not put the opponent/appellant in a worse situation than it was in before it appealed (G 1/99, point 15, first alternative).

The newly introduced features limit the scope of the claim maintained by the Opposition Division in a manner disclosed in the application as filed to a "Two stage" bending in which firstly the absorbent core preferentially bends along the flexure axis in the middle and, when compressing further, also along the second and third flexure axes. This limitation is considered to fall within the formulation of the claim upheld by the Opposition Division because the core at the second and third flexure axes has properties (cuts or places) to flexure more easily than at other parts of it and as such can be considered to "preferentially" bend at these axes under continued lateral compression.

Therefore the Board concludes that the amendments made to claim 1 are allowable under Article 123(2) and (3) EPC and do not give rise to "*reformatio in peius*".

3. *Article 83 EPC*

The appellant objected that the skilled person would not be provided with sufficient detail of how the absorbent core would acquire the "W"-shape.

However, considering the functioning described in the patent in suit, it is clear that after initial bending of the core at the flexure axis 24, resistance to further bending increases to a point where bending along the second and third axes becomes easier. How to achieve such two-stage bending does not give rise to any undue burden to the skilled person because sufficient detail is disclosed in the application as filed to the possibilities to influence the bending properties of the core.

For these reasons the Board comes to the conclusion that the subject-matter claimed does not give rise to objections under Article 83 EPC.

4. *Novelty*

Lack of novelty of the subject-matter of claim 1 was argued in respect of the napkin disclosed in D6. The appellant submitted that the embodiment of Figure 3 had a "W"-shape, its longitudinal troughs 17 extended over the entire length of the absorbent core and obviously had a depth of 40 percent of the core.

However, what in figure 3 can be identified as a "W"-shape is not the shape of the core but only the shape of part of its envelope, the core having the shape of an inverted "U", which "U"-shape is indeed subject of

the invention disclosed in D6 (see claim 1). Moreover, the troughs do not extend over the entire length of the core but they terminate short of the ends thereof (column 2, lines 71 to 72). With regard to Figure 2 the troughs have a distinct depth, however neither an explicit nor implicit disclosure is present in that document so that they would extend from the body-facing side through 40 percent or even through the range of 40 to 95 percent of the core. Regarding Figure 3, there is no basis for the opinion that the vertical extension is more than 40 percent of the core.

Since also none of the other documents disclose napkins with the entire combination of features of claim 1 the sanitary napkin according to claim 1 meets the requirement of novelty (Article 54(1) EPC).

5. *Inventive step*

5.1 The problem underlying the patent in suit starting from D3 is to provide a sanitary napkin that is inherently self-adjusting and form-fitting to the body and which permits compression of the pad without destroying the basic shape thereof (see paragraph [0004] of the patent description).

5.2 This technical problem is solved by the sanitary napkin with the features of claim 1, in particular that the central, longitudinal flexure axis in combination with the second and third flexure axes allow the core to preferentially bend upward along the central longitudinal axis and toward the cover in a convex configuration when the sanitary napkin is subjected to lateral compressive forces, the second and third

flexure axes allowing the core to bend along these axes to acquire a "W"-shape if the absorbent core is sufficiently compressed, and that the central longitudinal flexure axis extends over the entire length of the absorbent core and is defined either by a region of less dense absorbent, or by a slit or channel extending from the body-facing surface through 40 to 95 percent of the core.

5.3 According to D3 the grooves which can be identified as flexure axes extend only over an area of 30 to 40 percent of the entire surface of the napkin (page 8, lines 6 to 7). They are designed to allow deformation of the sanitary napkin and a good adaptation to the perineal area of the wearer. They can be produced e.g. using stamping dies whereby the absorbent material is compressed. Neither can a suggestion be derived from that document to provide a flexure axis over the entire length of the absorbent core nor to form it by a region of less dense absorbent, or by a slit or channel extending from the body-facing surface through 40 to 95 percent of the core. No suggestion of a "two-stage" bending as now defined in claim 1 is derivable from D3 either. Consequently the teachings of D3 cannot lead to the subject-matter of claim 1 in an obvious manner.

5.4 According to the opinion of the appellant D6 or D5, which showed grooves extending over the whole or nearly the whole length of the absorbent core, would lead the skilled person to apply this configuration to the absorbent article of D3. However, even when applying this teaching neither D5 nor D6 or any of other documents no longer relied upon by the appellant

disclose any indication towards the claimed two-stage bending of the absorbent.

- 5.5 Consequently the sanitary napkin according to claim 1 could not be arrived at without the involvement of an inventive step (Article 56 EPC). Therefore this claim as well as its dependent claims 2 to 13 relating to particular embodiments of the invention in accordance with Rule 29(3) EPC, can form the basis for maintenance of the patent (Article 52(1) EPC).

Thus taking into account the amendments made by the Appellant, the patent and the invention to which it relates meet the requirements of the EPC and the patent as amended is maintained in this form (Article 102(3) EPC).

6. *Procedural violation*

After the appellant expressed its satisfaction with the Board's opinion that the Opposition Division committed a procedural violation by not having given the appellant sufficient opportunity to comment on the amendments in the description of the patent in suit it subsequently withdrew its request for reimbursement of the appeal fee.

However, in accordance with the case law of the Boards of Appeal (see for example J 7/82, OJ 1982, 391), in certain cases a Board of Appeal will, even in the absence of a request to this effect, examine and decide whether reimbursement of the appeal fee is equitable by reason of a substantial procedural violation.

Considering the circumstances of the present appeal, the Board comes to the conclusion that reimbursement is not equitable because there is no causal link between the violation of the appellant's right to be heard and the appeal. In this respect it is to be noted that the main issue of the appeal concerned the subject-matter of claim 1, which of course has in turn repercussions on amendments of the description but only as a secondary issue.

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 with the following documents:
 - claims 1 to 13 and
 - description, column 1 to 13,
both filed at the oral proceedings;
 - figures 1 to 11 as granted.

The Registrar:

The Chairman:

C. Eickhoff

P. Alting van Geusau