

**Internal distribution code:**

- (A)  Publication in OJ  
(B)  To Chairmen and Members  
(C)  To Chairmen  
(D)  No distribution

**DECISION**  
**of 21 October 2004**

**Case Number:** T 0425/02 - 3.2.6

**Application Number:** 95916091.2

**Publication Number:** 0755238

**IPC:** A61F 13/56

**Language of the proceedings:** EN

**Title of invention:**

A method for manufacturing a pants-type diaper or sanitary panty, and such an article

**Patentee:**

SCA Hygiene Products AB

**Opponents:**

The Procter & Gamble Company  
Kimberly-Clark Worldwide, Inc.

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 123(2), 123(3), 84, 111(1)  
EPC R. 71a

**Keyword:**

"Admissibility of amendments in appeal proceedings - late  
filed request (no)"

"Change of claim category from product to method of  
manufacturing the product - allowable"

"Remittal (yes)"

**Decisions cited:**

G 0007/93, G 0004/93, T 0755/96, T 0005/90

**Catchword:**

-



Case Number: T 0425/02 - 3.2.6

**D E C I S I O N**  
**of the Technical Board of Appeal 3.2.6**  
**of 21 October 2004**

**Appellant:** SCA Hygiene Products AB  
(Proprietor of the patent) S-405 03 Göteborg (SE)

**Representative:** Hyltner, Jan-Olof  
Albihns Stockholm AB  
P.O. Box 5581  
S-114 85 Stockholm (SE)

**Respondent I:** The Procter & Gamble Company  
(Opponent I) One Procter & Gamble Plaza  
Cincinnati, Ohio 45202 (US)

**Representative:** Lawrence, Peter Robin Broughton  
GILL JENNINGS & EVERY  
Broadgate House  
7 Eldon Street  
London EC2M 7LH (GB)

**Respondent II:** Kimberly-Clark Worldwide, Inc.  
(Opponent II) 401 North Lake Street  
Neenah  
WI 54956 (US)

**Representative:** Dixon, Philip Matthew  
Frank B. Dehn & Co  
Holzstrasse 26  
D-80469 München (DE)

**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
1 March 2002 concerning maintenance of European  
patent No. 0755238 in amended form.

**Composition of the Board:**

**Chairman:** P. Alting van Geusau  
**Members:** G. Pricolo  
J. H. Van Moer

## Summary of Facts and Submissions

I. The appeal is from the interlocutory decision of the Opposition Division posted on 1 March 2002 concerning the maintenance in amended form of European patent No. 0 755 238, granted in respect of European patent application No. 95916091.2.

In the decision under appeal the Opposition Division considered that claim 1 as amended in accordance with the main request filed during the oral proceedings met the requirements of Article 123(2) and (3) EPC and that its subject-matter was novel and also involved an inventive step over the available prior art. However, the request contained further independent method claims 6 to 8 which contravened Article 123(3) EPC. These claims were based on product claim 6 as granted and the change of category from product to method resulted in an extension of the protection conferred. Consequently the main request was to be rejected. The first auxiliary request was considered to be allowable since it comprised only claim 1 of the main request.

II. The appellant (patentee) lodged an appeal, received at the EPO on 29 April 2002, against this decision and simultaneously paid the appeal fee. With the statement setting out the grounds of appeal, received at the EPO on 19 June 2002, the appellant filed a set of claims comprising independent claims 1 to 4 corresponding, respectively, to claims 1 and 6 to 8 of the main request filed during the oral proceedings held before the Opposition Division.

III. 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 claims 2 to 4 were directed to three independent alternatives which were not considered during examination or opposition proceedings and that it had to be discussed whether under these circumstances the filing of these independent claims was equitable. Although it would appear that the change of category, from the product of granted claim 6 to the method of manufacturing the product of claims 2 to 4 did not extend the protection conferred, claim 3 extended the protection conferred because claim 6 of the patent as granted was restricted to both the elements being fastened to either the inner casing sheet or the outer casing sheet whilst claim 3 included the possibility that the fastener elements were fastened to the inner casing sheet and to the outer casing sheet. Furthermore the Board stated that it would appear that claims 3 and 4 were not clear in view of a contradiction between the preamble and the characterizing portion thereof.

IV. Oral proceedings took place on 21 October 2004.

The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the claims 1 to 7 filed during the oral proceedings.

The respondents I and II (opponents I and II) requested that the appeal be dismissed. Respondent I subsidiarily requested that the case be remitted to the first instance for further prosecution.

V. Independent claims 1 and 2 of the appellant's only request read as follows:

"1. A method of manufacturing an absorbent article in the form of a pants-type diaper or a sanitary panty from a continuously running web of mutually joined flat blanks, each blank includes an elongated absorbent body (5) enclosed between two casing sheets (2,9), which at mutually opposing front and rear end parts of the absorbent body have side parts that extend laterally beyond said body on both sides thereof, said method comprising the steps of folding the blank about a transverse axis so that the end edges of said side parts will lie edge-to-edge, joining together the side edges of the front and rear side parts which oppose one another in the folded state of the blank with the aid of a releasable and refastenable fastener means (20;33), mounting one of two elements (18,19;34,35) which include mutually complementary members of the releasable and refastenable fastener means (20;33;37,38) on one of the front and rear side parts of the blank which face one another in the folded state of said blank, and mounting the other element on the other of said side parts in such a way that both of the elements (18,19;34,35) are mounted on the inside of the side parts, and thereafter separating individual pants-type diapers from the web, wherein the two elements (18,19;34,35) are mounted on one of the front and rear side parts of the blank that oppose one another in the folded state of the blank with said two elements mutually joined together prior to folding the blank, and mounted on the other side part of said blank in conjunction with folding the blank."

"2. A method of manufacturing an absorbent article in the form of a pants-type diaper or a sanitary panty from a individually advanced blanks, each blank includes an elongated absorbent body (5) enclosed between an inner liquid permeable casing sheet (9) and an outer liquid-impermeable casing sheet (2), which casing sheets at opposing front and rear end parts of the absorbent body extend with side parts laterally beyond said body on both sides thereof, the side edges of opposing front and rear side parts are joined together with the aid of a releasable and refastenable fastener means, the releasable and refastenable fastener means are comprised of mutually complementary members of two elements of which one is fastened to the front side part and the other is fastened to the rear side part, both of the elements are fastened to the outside of the side parts, characterised in that the fastener element having closed fastener means are applied to the outer casing sheet (2) by first fastening a free end of the fastener elements to one of the front or rear side parts of the blank and thereafter folding the blank about a transverse axis so that the end edges of said side parts will lie edge-to-edge, whereafter the fastener elements are folded in over the other of the front and rear side parts and fastened thereto."

VI. In support of its requests the appellant relied essentially on the following submissions:

Since the method of independent claim 2 resulted in an article having all the technical features of the article according to claim 6 as granted, the protection

conferred by claim 2 was not extended when compared to that conferred by the granted patent. Claim 2 was therefore allowable under Article 123(3) EPC.

Remittal of the case to the first instance was not necessary because claim 2 was directed to the same subject-matter as claim 4 of the application as filed which was already searched in the proceedings leading to the grant of a patent. The respondents could not be surprised by the filing of the independent claim 2 because granted claim 3 was clearly related to the passage of the description of the patent in suit specifically disclosing the method steps of claim 2.

VII. Respondent I objected that the new method claim 2 should not be admitted on the basis of the fact that new method claims were filed for the first time during the oral proceedings before the Opposition Division, after the final date for making written submissions set with the summons in accordance with Rule 71a EPC.

The respondents I and II did not raise objections under Article 123(2), (3) and 84 EPC and considered the claims allowable in this respect.

Respondent I requested the case to be remitted to the first instance for having an opportunity of carrying out an additional search in respect of the subject-matter of claim 2, which was not specifically claimed in the patent as granted, before a decision in respect of novelty and inventive step was taken.

## Reasons for the Decision

1. The appeal is admissible.
  
2. *Admissibility of the appellant's request*

With the statement of grounds of appeal the appellant filed a set of claims corresponding to the claims of the main request filed during the oral proceedings held before the Opposition Division, which main request was admitted into the proceedings but not allowed because claims 6 to 8 were held to infringe Article 123(3) EPC. The decision to admit amended claims after the final date for making written submissions in accordance with Rule 71a EPC is a discretionary decision of the Opposition Division (see T 755/96, OJ 2000, 174). A Board of Appeal should normally only overrule the way in which a first instance department has exercised its discretion if it comes to the conclusion either that the first instance department in its decision has not exercised its discretion in accordance with the right principles or that it has exercised its discretion in an unreasonable way (see G 7/93, OJ 1994, 775). In the present case the Board cannot find reasons, nor has any been submitted by respondent I, which would justify such conclusion, and therefore it takes the view that the Opposition Division correctly exercised its discretion. Accordingly, the claims of the main request filed during the oral proceedings held before the Opposition Division fall within the framework of the opposition proceedings.

The request under consideration differs from this previous main request in that independent claims 3 and



4 have been deleted in response to the objections raised by the Board in the communication annexed to the summons to oral proceedings and in that claim 2 has been modified in response to clarity objections raised during the oral proceedings. Thus, the amendments leading to the request now under consideration were made in reaction to findings made in the course of the appeal proceedings and for this reason also the actual request cannot be regarded as late filed.

3. *Allowability of amendments*

3.1 Claim 1

Claim 1 corresponds to claim 1 of the first auxiliary request allowed by the Opposition Division. It differs therefrom by the presence of the reference numerals 37 and 38 between parentheses. Since according to Rule 29(7) EPC the reference signs shall not be construed as limiting the claim, these claims are identical in substance and consequently the findings of the Opposition Division in respect of claim 1 of the first auxiliary request also apply to claim 1 of the request under consideration.

In accordance with G 4/93, if the patent proprietor is the sole appellant against an interlocutory decision maintaining a patent in amended form, neither the Board of Appeal nor the non-appealing opponent as a party to the proceedings as of right under Article 107, second sentence, EPC, may challenge the maintenance of the patent as amended in accordance with the interlocutory decision. From this it follows that in the present case, in which the patent proprietor is the sole appellant,

neither the Board of Appeal nor the respondents may challenge the maintenance of the patent as amended, i.e. the allowability of the first auxiliary request comprising the single claim 1. In the Board's view, this implies that the allowability of claim 1 of the request under consideration which is identical to the claim allowed by the Opposition Division is *res judicata* and accordingly may no longer be challenged in proceedings before the European Patent Office.

In fact, this conclusion has not been disputed by the parties.

### 3.2 Claims 2 to 7

3.2.1 Basis for the method of claim 2 is found in claims 7 and 8 and in the description of the application as filed (page 13, lines 30 to 37 and page 14, lines 15 to 19).

Claims 3 to 7, dependent on claim 2, correspond to claims 9 to 13 of the application as filed.

Therefore, claims 2 to 7 do not give rise to objections under Article 123(2) EPC.

3.2.2 The method of independent claim 2 directly results in an article having all the features of claim 6 as granted. Claim 2 complies with the requirements of Article 123(3) EPC because it will only be infringed if the product obtained as a direct result of the method falls within the originally granted product claim 6 and in addition the particular form of manufacture defined in claim 2 is used. Therefore claim 2 restricts the

protection compared to the protection of the original claims, without in any way extending it (see e.g. T 5/90, not published).

- 3.2.3 In fact, it was not in dispute that the amended claims meet the requirements of Article 123(2), (3) and 84 EPC and also the Board sees no reason to raise objections on the basis of these requirements.

4. *Remittal to the first instance*

Having regard to the fact that the features defined in the characterizing portion of claim 2 were not present in the claims of the patent as granted but only in the description, and to the fact that the differences existing between the methods of claims 1 and 2 (claim 2 relates to a method in which the blanks are individually advanced whilst claim 1 to a method in which there is a continuously running web of mutually joined flat blanks) are of such nature that a substantially different reasoning is necessary when assessing novelty and inventive step of their subject-matter, the Board considers it appropriate to make use of its discretion under Article 111(1) EPC to remit the case to the first instance, in order to give the respondents (whose oppositions were primarily based upon the claims of the patent as granted) an opportunity of carrying out an additional search in respect of subject-matter not claimed in the patent as granted and in order not to deprive the parties of their right to a fair hearing before a first instance in relation to the questions of novelty and inventive step of claim 2.

**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 for further prosecution.

The Registrar:

The Chairman:

M. Patin

P. Alting van Geusau