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D E C I S I O N
of 9 November 2004

Case Number: T 0611/02 - 3.2.6

Application Number: 95118292.2

Publication Number: 0750062

IPC: D04H 1/40

Language of the proceedings: EN

Title of invention:
Disposable skin cleansing articles

Patentee:
GEORGIA-PACIFIC S.A.R.L.

Opponents:
SCA Hygiene Products AB
Unilever PLC
Kimberly-Clark Worldwide, Inc.
Paul Hartmann AG

Headword:
-

Relevant legal provisions:
EPC Art. 83

Keyword:
"Sufficiency of disclosure - no"

Decisions cited:
T 0256/87, T 0387/01, T 0153/85

Catchword:
-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0611/02 - 3.2.6

D E C I S I O N
of the Technical Board of Appeal 3.2.6
of 9 November 2004

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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 28 March 2002 revoking European patent No. 0750062 pursuant to Article 102(1) EPC.**

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 decision of the Opposition Division posted on 28 March 2002 to revoke European patent No. 0 750 062, granted in respect of European patent application No. 95118292.2.

II. In the decision under appeal the Opposition Division considered that the patent in suit did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. The Opposition Division based its decision inter alia on the fact that the patent in suit failed to disclose a test method for measuring the tensile strength of the substrate of the claimed absorbent article, which, in accordance with the wording of claim 1 as amended during the opposition proceedings, should be no more than 45 N in any direction.

III. The appellant (patentee) lodged an appeal, received at the EPO on 24 May 2002, against this decision and simultaneously paid the appeal fee. The statement setting out the grounds of appeal was received at the EPO on 26 July 2002. It was accompanied by a copy of document:

D1: "edana recommended test method: nonwovens tensile strength, 20.2-89", February 99.

IV. In a communication accompanying the summons for oral proceedings pursuant to Article 11(1) Rules of Procedure of the boards of appeal the Board expressed the preliminary opinion that it was not clear whether the expressions "**tensile** strength" and "**textile**

strength" used in the patent in suit referred to the same parameter, that claim 1 did not include any reference to a specific test method, and that in respect of sufficiency of disclosure it was in particular necessary to discuss the question of how to determine said tensile or textile strength.

V. In response to the communication of the Board, the appellant filed with letter dated 9 October 2004 amended documents forming the basis for a new main request and three auxiliary requests for maintenance of the patent in amended form.

VI. Oral proceedings, at the end of which the decision of the Board was announced, took place on 9 November 2004.

The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the claims of the main or first to third auxiliary request as filed with letter dated 9 October 2004.

The respondents (opponents I to IV) requested that the appeal be dismissed. In support of its submissions, respondent III filed document

D2: "3300 Series Table Models", Instron, 2003.

VII. Claim 1 of the main request reads as follows:

"1. A dry, disposable skin cleansing article comprising a substrate having a major surface for rubbing on the skin, characterized in that said substrate is a non woven substrate hydroentangled throughout its whole

thickness, having a basis weight of from 20 to 150 g/m^2, wherein the tensile strength of said substrate is of no more than 45 N in any direction, as measured according to the method described herein, comprising at least 60% of fibres that have a length of at least 2 cm, preferably 3 to 5 cm, and that extend from the surface plane of the substrate as a result of said rubbing whilst remaining attached to the substrate."

The respective independent claims 1 in accordance with the first and second auxiliary requests are both directed to a dry, disposable skin cleansing article, and claim 1 of the third auxiliary request is directed to the use, in a dry, disposable skin cleansing article, of a nonwoven substrate. All these claims include the requirement of claim 1 of the main request according to which:

"the tensile strength of said substrate is of no more than 45 N in any direction, as measured according to the method described herein."

VIII. Insofar as they are relevant to the present decision the submissions of the appellant in support of its requests can be summarized as follows:

In the context of the patent in suit the expressions "tensile strength" and "textile strength" had the same meaning. In fact they were used indifferently throughout the whole specification for referring to the same measurable property of the substrate.

The patent in suit included information sufficient for a skilled person to determine the tensile strength in the manner intended by the patent in suit. The essential information concerning the size of the samples was given in the description. As regards those parameters for carrying out the test that were not specified, such as e.g. the rate of extension, the skilled person would refer to the "edana" recommended test method for measuring the textile strength, as shown by document D1, because in the technical field under consideration this was the most used test method. Other methods for measuring the tensile strength were not standardized but only devised for private use. Therefore, the skilled person was not confronted with any ambiguities in carrying out the measurement of the tensile strength of a given substrate.

Moreover, the patent in suit referred to the co-pending European patent application 95304447.6 which disclosed further details of the test for measuring the tensile strength. Since the reference to the co-pending application was specifically related to the strength of the substrate, the skilled person would look for and find in the co-pending application those details of the test that were not specified in the patent in suit. Furthermore, since these details were identical to those of the "edana" test method in accordance with D1, there could be no doubt for the skilled person that the "edana" method was effectively the one intended for use by the patent in suit.

IX. In respect of the specific feature of claim 1 that the tensile strength of the substrate is of no more than 45 N in any direction the respondents submitted in

particular that its inclusion in claim 1 contravened Article 123(2) EPC because the limit of 45 N was only disclosed in the application as filed in combination with the "textile" strength, not the "tensile" strength.

In any case, the patent in suit failed to disclose how to carry out the procedure for measuring the tensile strength and therefore the requirements of Article 83 were not met. In fact, the description of the patent in suit merely specified the size of the samples to be used, the measuring instrument used, an Instron tester, and the distance to be set between the jaws of the instrument. No indication was given about other essential parameters which affected the result of the measurement, such as the rate of extension which in an Instron tester could be set within a very large range as shown by D2. Furthermore, there was no clear and unambiguous basis in the patent in suit to conclude that it was intended to perform an "edana" test. Firstly, there existed other standardized procedures for measuring the tensile strength of nonwovens, such as the ASTM method referred to in D1. Secondly, the size of the samples as disclosed in the patent in suit did not correspond to the size specified in the "edana" specification according to D1, and therefore the skilled person would come to the conclusion that the "edana" measurement test was not the one intended by the patent in suit.

The reference to the co-pending European application 95304447.6, which reference was not so specific to consider the test procedure described therein to be incorporated in the disclosure of the patent in suit, did not change this situation because also there the

size of the samples was different from that specified in the "edana" specification in accordance with D1, and moreover information essential for reliably reproducing the test, such as the manner in which the strip of material was secured in the Instron machine, was missing.

Reasons for the Decision

1. The appeal is admissible.

2. During the oral proceedings the respondents have raised various objections based on Articles 123(2), 84 and 83 EPC in respect of the claimed subject-matter.

Since, for the reasons given below, the presence in claim 1 of the feature according to which "the tensile strength of said substrate is of no more than 45 N in any direction, as measured according to the method described herein" *per se* already justifies the conclusion of lack of sufficient disclosure (Article 83 EPC) in respect of all the appellant's requests, it is not necessary for the purposes of the present decision to deal with all the objections raised by the respondents.

Considering first the requirements of Article 123(2) EPC it is to be noted that this feature, taken in isolation from the other features defined in the independent claim 1 of the requests under consideration, is based on the disclosure of application as filed, in particular on claim 12 thereof. Although this claim refers to the "textile strength" and claim 1 under

consideration to the "tensile strength", it is clear for the skilled person that in the context of the patent in suit the terms "textile" and "tensile" have the same meaning when they refer to the strength. In fact, the references on page 7 of the application as filed to the "textile strength" being the force measured with an Instron machine and to the "tensile strength number" being the peak force from this force over elongation curve, make clear that "textile strength" and "tensile strength" have identical meaning.

3. In order to carry out the invention, the skilled person must be in a position to establish whether a product falls within the area covered by the claim and to reliably prepare the claimed product (see e.g. T 256/87, point 10 of the reasons). In the present case, this means that the skilled person must be in a position to establish whether the textile strength which is measured for a given substrate can be effectively correlated to the limit of 45 N referred to in claim 1. This presupposes that the skilled person utilizes a method for determining the textile strength which is either the same or one that gives essentially the same results as the method which has been used as a basis for arriving at establishing a limit of 45 N in the patent in suit (see also T 387/01, point 2.2.1). This is clearly reflected by the wording of claim 1 according to which the textile strength is "as measured according to the method described herein".

As regards the determination of the textile strength of a given material, the description of the patent in suit (see paragraph [0029]) discloses that the "textile strength in both the MD and CD directions is determined

from 1" wide strips cut to 15 cm in length and fixed without slack but without tension on an Instron tester within jaws set at 10 cm distance. The energy input from the Instron machine to the sample is then plotted over time with the y axis indicating the force applied to the sample in Newtons and the x axis indicating the % elongation of the sample at the indicated elongation rate." The patent in suit does not include any further specifications in respect of this test procedure. In particular, there is no disclosure of the rate of extension to be applied during the test. It is undisputed that this parameter has an influence on the measured force, as indeed confirmed by D1 which indicates that the "edana" tensile strength test must be carried out at a specified constant rate of extension (see page 1, 2nd paragraph; page 3, point 6.4). Thus the skilled person trying to put into practice the teaching of the patent in suit is left in a position in which he must choose a suitable value of the rate of extension from those possible with an Instron machine. It is undisputed, and clearly shown by D2 (see the table on the second page), that such machines allow for a wide range of extension rates. Since the measurement of the tensile strength depends on the rate of extension, different results will be obtained depending on the choice made by the skilled person. Therefore, the skilled person is not in a position to know whether the results of measurements made once a rate of extension is arbitrarily selected can be correlated to the limit of 45 N stated in claim 1 of the patent in suit. Hence he is not in a position to know whether he is working within the area covered by claim 1.

4. The appellant submitted that the skilled person would refer to the "edana" recommended test method for measuring the textile strength as shown in document D1 for finding those parameters that were not specified in the patent in suit such as e.g. the rate of extension.

This argument cannot be followed because the "edana" test is not the only available standardized test for measuring the tensile strength. In fact, D1 itself (page 2) refers to an ASTM test, which in order for it to be equivalent to the "edana" test, has to be amended in the manner specified in D1. Furthermore, even if the skilled person would consider that the "edana" test might be the one intended by the patent in suit, the fact that D1 specifies the use of samples of dimensions (50 mm wide and more than 200 mm long, see page 3) different from those specified in the patent in suit (1" = 25,4 mm wide and 100 mm long, see paragraph [0029]) would indicate that this is not the case and that in fact another test, possibly a test devised by the patentee for private purposes, is intended.

5. The appellant further referred to the co-pending European patent application 95304447.6 cited in paragraph [0034] of the description of the patent in suit. In this paragraph it is stated that "in one embodiment of the present invention, the substrate is a relatively low strength one, as described in *copertime* [emphasis added by the Board] European Patent Application No. 95304447.6."

In accordance with established case law of the boards of appeal where there is a specific reference in one prior document (the "primary document") to a second

prior document, when construing the primary document (i.e. determining its meaning to the skilled man) the presence of such specific reference may necessitate that part or all of the disclosure of the second document be considered as part of the disclosure of the primary document (see e.g. T 153/85, OJ 1988, 001). In the present case there is no specific reference in the patent in suit to that part of the European co-pending application dealing with the test procedure for determining the tensile strength and therefore the details of the test procedure disclosed therein cannot be regarded as incorporated in the patent in suit. In fact, the disclosure of the patent in suit is such that the skilled person would only turn to said co-pending application in order to find suitable "relatively low strength" substrates for use in accordance with the invention. Anyway, even if the skilled person would turn to the co-pending application for obtaining information about the test procedure, he would still not obtain all the necessary information for unambiguously and reliably reproducing the test, since in this co-pending application there is no indication of the further factor that affects the measurement results which is the manner in which the samples are secured to the jaws, and he would not relate the test procedure to the "edana" test because also there samples with different dimensions than those specified in D1 are used.

6. Since the above-mentioned feature concerning the limit of 45 N for the textile strength of the substrate is present in claim 1 of all requests, the above-mentioned finding that the skilled person is not in a position to know whether he is working within the area covered by

claim 1 applies to all requests under consideration. Accordingly, none of the requests is allowable because the claimed invention is not disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 83 EPC).

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

M. Patin P. Alting van Geusau