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**D E C I S I O N**  
**of 8 July 2005**

**Case Number:** T 0972/02 - 3.2.6

**Application Number:** 94105999.0

**Publication Number:** 0623331

**IPC:** A61F 13/15

**Language of the proceedings:** EN

**Title of invention:**  
Shorts type disposable diaper

**Patentee:**  
KAO CORPORATION

**Opponent:**  
-

**Headword:**  
Disposable Diaper/KAO

**Relevant legal provisions:**  
EPC Art. 54(2), 106(3), 111(1)  
EPC R. 60(2)

**Keyword:**  
"Prior use proved (no), standard of proof, continuation of  
opposition proceedings (no)"

**Decisions cited:**  
T 0482/89, T 0082/92, T 0472/92, T 0097/94, T 0848/94

**Catchword:**  
-



Case Number: T 0972/02 - 3.2.6

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.6  
of 8 July 2005

**Appellant:** KAO CORPORATION  
(Proprietor of the patent) 1-14-10, Nihonbashikayaba-cho  
Chuo-ku  
Tokyo (JP)

**Representative:** Grünecker, Kinkeldey,  
Stockmair & Schwanhäusser  
Anwaltssozietät  
Maximilianstrasse 58  
D-80538 München (DE)

**Decisions under appeal:** Decisions of the Opposition Division of the  
European Patent Office posted on 11 November  
2001 (interlocutory decision) and on 3 July  
2002 revoking European patent No. 0623331  
pursuant to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** P. Alting van Geusau  
**Members:** R. T. Menapace  
G. L. De Crignis

## Summary of Facts and Submissions

I. After the sole opponent had withdrawn the opposition against European patent No. 0 623 331, the Opposition Division continued the proceedings in accordance with Rule 60(2) EPC and gave two decisions in writing.

II. The first decision ("interlocutory decision") posted on 11 November 2001 was an interlocutory one in the sense that it did not terminate the proceedings (Article 106(3) EPC) and no separate appeal was allowed against it.

In this decision the three prior uses ("A", "B" and "C") alleged by the sole Opponent were ascertained as fact. On the basis of extensive written evidence produced in support (*inter alia* drawings, test reports, correspondence, affidavits) the Opposition Division was "satisfied" that they "have been proved (using the balance of probabilities as a standard of proof, i.e. what was more likely than not to have happened."

Furthermore it was decided that the subject-matter of claim 1 as granted was new in the meaning of Article 54 EPC (having regard to said prior uses and the state of the art represented by documents D1 - D7 which had also been cited by the opponent), but that selecting the thickness of the absorber in the claimed range in the training pants known from prior use A was obvious for the person skilled in the art.

III. By the second decision ("final decision"), which was posted on 3 July 2002, the patent was revoked for lack of inventive step over prior use A.

- IV. Notice of appeal was lodged by the proprietor (Appellant) on 11 September 2002 together with payment of the appeal fee. The statements of grounds of appeal were filed on 8 November 2002.
- V. Already in the notice of appeal the Appellant requested to set aside the decision dated 3 July 2002 and to maintain the patent as granted.
- VI. In support of his requests the Appellant argued in essence as follows:

The revocation of the patent could not be based on the alleged prior use A without having verified the circumstances under which it took place. In particular, public availability of its subject could not be derived simply from the statements in two affidavits that the training-pants at issue were sent to/received by the Opponent "without any confidentiality agreement (non-disclosure agreement)" or, respectively, without any obligation to secrecy having been imposed ("ohne jegliche Auflage zur Geheimhaltung"). Without further clarifications it remained open whether these statements related only to a written or orally stipulated agreement of confidence, or whether they excluded also an (intended) co-operation of the two firms involved and, hence, an implied obligation to secrecy. The existence of such circumstances in the present case was suggested e.g. by the fact that it was very unusual for a manufacturer to forward diapers which were not yet on the market (as the ones in question), if it was not certain that the other firm would not disclose the diaper to other competitors.

But even assuming a public prior use of the diapers "A" as alleged, the subject of claim 1 of the opposed patent was based on an inventive step.

## **Reasons for the Decision**

1. The appeal is admissible. As it is clear from the procedural context and provided for in Article 106(3) EPC, also the interlocutory decision dated 11 November was appealed against together with the final decision dated 3 July 2002.
  
2. *Prior art*
  - 2.1 The finding in the decisions under appeal that the subject-matter claimed lacks inventive step was based exclusively on prior use A (interlocutory decision, Point 12 of the Reasons; decision II, second chapter of the Reasons), namely the sending of a sample of training pants of Pope & Talbot Inc. ("P&T") together with related documentation to the former Opponent in December 1992, which was considered to represent the closest prior art.
  
  - 2.2 That critical prior use was established as a fact by the Opposition Division on the basis of written evidence including three affidavits, whose authors had been offered but have not been heard as witnesses. The Opposition Division was "satisfied" that the prior use in question (as well as prior use "B" and prior use "C" which were, however, not taken into account further) had been proven on the balance of probabilities, i.e.

that it "was more likely than not to have happened" (interlocutory decision, Point 8 of the Reasons, also indicating explicitly this standard of proof as the one applied).

2.3 However, the Board holds in line with the relevant case law (decisions T 782/92, T 97/94, T 848/94 and, in particular T 472/92 published in OJ 1998, 161) that the standard of proof in respect of a public prior use which has been alleged by an opponent, is a higher one than the one applied by the Opposition Division, namely that the prior use has to be proved beyond any reasonable doubt. As it was put in the decision last cited, in cases where practically all the evidence in support of the alleged prior use lies within the power and knowledge of the opponent, the opponent has to prove his case up to the hilt. The Board concurs also for more fundamental reasons. It would be incompatible with legal certainty, which is in the interest of all the parties and the public alike, and the inventor's right to a patent, to base a decision, whether a patent granted to him is maintained or not, on mere likelihood or probability.

2.4 The wrong standard of proof having been applied in establishing facts on which the decision under appeal relied, a fresh and complete evaluation of the relevant evidence has to be made. The principle of unfettered consideration of evidence applies, i.e. the body required to take the decision (here the Board under Article 111(1) EPC) decides on the basis of the whole of the evidence and in the light of its conviction arrived at freely without reference to any legislative

provisions (see e.g. T 482/89, OJ EPO 1992,646) whether an alleged fact has occurred or not.

2.5 A prior use (e.g. delivery of samples of a potentially novelty destroying product accompanied by related documents, as alleged in the present case), in order to constitute state of the art under Article 54(2) EPC, must have been public. This precondition is not fulfilled, if there was, in respect of the subject-matter concerned, an express or tacit agreement on secrecy (which has not been broken). This means, in view of what has been set out above, that it is decisive, whether the presence of circumstances leading to an implied obligation to secrecy (here of the opponent as the addressee of the disclosure in question) is to be excluded on the face of all the evidence available, or whether doubts remain in this respect.

2.6 When looking at the transaction in question from this angle it becomes apparent already from the quantity of the goods received by the Opponent and the fact that they were delivered free of charge that the transaction was not a regular and thus unrestricted sale of a commercial product to the Opponent or made in preparation of a future wholesaler-retailer relationship between the two companies involved. Rather, as the accompanying documents (construction drawings, bill of raw materials) and the laboratory analysis performed by Mrs Raffin of the Opponent (see her affidavit and her report dated 21.12.92) suggest, the samples were put at the Opponent's disposal in the framework of the decision-making on his future manufacturing and marketing activities.

2.7 Normally, companies which are active in the same field and thus (potential) competitors do not assist each other in that way outside an established or at least intended co-operation between them in the field of research and development or marketing or both. The existence of such a closer relationship, i.e. circumstances leading to a mutual obligation to secrecy even in the absence of an explicit undertaking (implied confidentiality, tacit agreement on secrecy) in the present case is not refuted by the relevant evidence available. The only specific evidence as regards confidentiality is the statement of Mr Urban from P&T that he sent the sample and the corresponding documentation to the Opponent "without any confidentiality agreement (non-disclosure agreement)" and Mr Malowaniec's declaration that he received it without any obligation to secrecy having been imposed. In the given context this wording proves at best that in respect of the delivery in question confidentiality was not expressly stipulated (between Mr Urban and his counterpart from the Opponent). However, this fact in no way excludes an obligation to secrecy resulting from the overall circumstances - or even from an express confidentiality agreement otherwise concluded between P&T and the opponent, in which case it would be all the more plausible that, it being redundant, no agreement on secrecy was concluded in respect of the delivery at issue. Equally inconclusive is the lack of any statement on confidentiality in Mrs Raffin's affidavit.

2.8 There exists also an inconsistency in respect of what was exactly the object of the alleged prior use: According to all three affidavits (Urban, Malowaniec, Raffin) just one sample was sent to/received by the



opponent. In contrast, the laboratory report on the "Training-Pants von P&T" (page 6 of enclosure 1.5) drawn up by the same Mrs Raffin refers to (a plurality of) samples available ("... es sich bei den zur Verfügung stehenden Mustern ... um Handmuster handelte."). Furthermore, it is stated therein that the data provided by P&T gave only the total amount of adhesive per pant, whereas the bill of raw material for the P&T pants (Enclosure 1.3, referred to in the affidavits of Urban an Malowanic) specifies merely the type of the adhesives used (Findley H2123-1, H2239-01), not their amount.

2.9 Taking the submissions, facts and available means of evidence in their entirety and in context, the Board concludes that they are - contrary to the finding of the Opposition Division arrived at "on the balance of probabilities" (Point 2.2, above) - not at all sufficient to establish with the necessary reliability that the transaction in question (sending of a sample of training pants of P&T together with related documentation to Opponent in December 1992) was "simply a sale", as found in the impugned interlocutory decision (Point 7, second paragraph, last sentence of the Reasons). Hence, that alleged prior use does not qualify as a public prior use within the meaning of Article 54(2) EPC.

2.10 It is true that the contrary cannot be excluded either, but that cannot be established either under the applicable standard of proof in the absence of more detailed submissions and the production of evidence in particular as to the intentions underlying the delivery in question, its purpose and the relationship between

the two companies and/or the persons acting on their behalf. However, in the present case the (sole) opponent, on whom rests the burden of proof in respect of any prior use alleged by him, withdrew the opposition (Point II, above). So, he cannot be expected to produce further evidence, neither is this a matter for the Board of Appeal or the Opposition Division and, even less, for the proprietor (appellant).

2.11 In that situation the alleged prior use is not to be examined further and, for the purposes of the decision on the present appeal, has not to be considered.

2.12 The same applies *mutatis mutandis* to the two other alleged prior uses B and C, which were found proven equally "on the balance of probabilities" which is the wrong standard of proof (Points 2.2, 2.3, above). Moreover, the Opposition Division held them less relevant than prior use A (closest state of the art - interlocutory decision, Point 12 of the Reasons) and, implicitly even less relevant than the state of art represented by documents D1 - D7 which it found not to prejudice the maintenance of the patent as granted (interlocutory decision, Point 14 of the Reasons). In the Board's judgment it is then neither necessary nor appropriate to examine these two allegations of prior use further.

3. *Continuation of the opposition proceedings (Rule 60 EPC)*

As none of the alleged prior uses was proved and the Board sees no reason to question the above cited (and uncontested) finding of the Opposition Division as regards documents D1 to D7, there is no longer any

reason to continue the opposition proceedings by the European Patent Office on its own motion (Rule 60(2) EPC), be it by the Board itself or by the Opposition Division upon remittal to the department of the first instance.

## **Order**

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

1. The decisions under appeal are set aside.
2. The patent is maintained unamended.

The Registrar:

The Chairman:

M. Patin

P. Alting van Geusau