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D E C I S I O N
of 30 May 2006

Case Number: T 0156/04 - 3.2.06

Application Number: 96939481.6

Publication Number: 0861343

IPC: D04H 13/00

Language of the proceedings: EN

Title of invention:
Controlled hysteresis nonwoven laminates

Patentee:
KIMBERLY-CLARK WORLDWIDE, INC.

Opponent:
SCA Hygiene Products AB

Headword:

-

Relevant legal provisions:
EPC Art. 114(1), 54(2), 111(1)

Keyword:
"Late-filed document - admitted"
"Novelty"
"Remittal (yes)"

Decisions cited:
T 0611/90, T 0258/84

Catchword:

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Case Number: T 0156/04 - 3.2.06

D E C I S I O N
of the Technical Board of Appeal 3.2.06
of 30 May 2006

Appellant: SCA Hygiene Products AB
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Appellant: KIMBERLY-CLARK WORLDWIDE, INC.
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
18 November 2003 concerning maintenance of
European patent No. 0861343 in amended form.

Composition of the Board:

Chairman: G. Kadner
Members: G. Pricolo
R. Menapace

Summary of Facts and Submissions

I. The appeals stem from the interlocutory decision of the Opposition Division posted on 18 November 2003 maintaining European patent No. 0 861 343 in amended form in accordance with the patent proprietor's auxiliary request filed during the oral proceedings held on 17 October 2003.

Claim 1 according to the patent proprietor's main request (rejection of the opposition) not allowed by the Opposition Division was claim 1 as granted, which reads as follows:

"A controlled hysteresis composite elastic material comprising a first layer which is an elastomeric metallocene polyolefin layer and which is joined to at least one second layer comprised of an elastomeric polymer selected from the group consisting of polyurethanes, copolyether esters, polyamide polyether block copolymers, ethylene vinyl acetates (EVA), and block copolymers having the general formula A-B-A', A-B-A-B or A-B, and which is also joined to a third layer which is a gatherable web".

II. In the decision under appeal the Opposition Division considered that the subject-matter of claim 1 as granted was distinguished from the disclosure of document

D1: WO-A-95/05418;

only by the presence of a further polymer in the second layer. However, the wording "comprised of" in claim 1

implied that the further polymer could be present in an amount which was only marginally above the threshold of detection. Such a minimum amount of additional polymer could not give rise to any technically meaningful effect. Accordingly, the distinction over D1, being of mere formal nature, could not serve to establish novelty.

III. The patent proprietor and the opponent each lodged an appeal against the decision of the Opposition Division. The notices of appeal were received at the EPO on 28 January 2004 and the appeal fees were paid on the same day. The statements setting out the grounds of appeal were received at the EPO on 25 and 26 March 2004, respectively.

IV. In the communication dated 26 January 2006 accompanying the summons to oral proceedings pursuant to Article 11(1) of the Rules of Procedure of the Boards of Appeal, the Board expressed a preliminary opinion according to which the wording of claim 1 implied that the second layer had a composition different from that of the first layer due to the presence of the elastomeric polymer selected from the group referred to in claim 1 and that the presence of this elastomeric polymer could not be regarded as implying only a mere formal distinction over D1 as argued by the Opposition Division. Since there was no disclosure in D1 of a first layer consisting of an elastomeric metallocene polyolefin layer in combination with a second layer having a different composition, it appeared that the subject-matter of claim 1 as granted was novel over D1.

V. With letter dated 26 April 2006 the appellant (opponent), in response to the above-mentioned preliminary opinion of the Board, filed a new document

D11: WO-A-95/03443;

and submitted that this document should be admitted into the proceedings, even if filed late, because it was prima facie relevant to novelty and inventive step of the claims of the opposed patent.

VI. With telefax of 2 May 2006 the appellant (patent proprietor) filed a set of claims according to auxiliary requests A to E as announced in the grounds of appeal.

VII. Oral proceedings, at the end of which the decision of the Board was announced, took place on 30 May 2006.

The appellant (patent proprietor) requested that the decision under appeal be set aside and that the case be remitted to the department of first instance (main request) or that the patent be maintained as granted or on the basis of one of the auxiliary requests filed on 2 May 2006 in the order A-E.

The appellant (opponent) requested that the decision under appeal be set aside and that the European patent No. 0 861 343 be revoked.

VIII. The arguments of the appellant (patent proprietor) in support of its requests can be summarized as follows:

The wording of claim 1 according to which the second layer was "comprised of" an elastomeric polymer implied that the second layer was predominantly made of the elastomeric polymer and that it was the latter that dictated the elastic properties thereof. Accordingly, not only was the subject-matter of claim 1 as granted distinguished from the composite elastic material of D1 by the second layer having a composition different from that of the first layer, as pointed out by the Board in the communication accompanying the summons to oral proceedings, but also by the specific composition of the second layer. D11 was not relevant to the novelty of the claimed subject-matter because it lacked a clear disclosure of a gatherable web being joined to the first and second elastic layers. Anyway, the introduction of D11 into the proceedings would change the centre of gravity of the case presented on appeal compared with that of the one decided by the first instance, since the discussion would then be focussed on the differences in the structure of the composite materials rather than on the differences in the composition of the layers. In line with current case law (e.g. decisions T 258/84 and T 611/90), remittal to the first instance was therefore justified.

IX. The appellant (opponent) essentially argued as follows:

The wording "comprised of" in claim 1 implied that the second layer could comprise only a small amount of the elastomeric polymer selected from the group referred to in claim 1. D1 disclosed a composite elastic material comprising at least one elastomeric metallocene polyolefin layer and at least one less-elastic layer, i.e. a gatherable web. It further disclosed that the

composite could comprise multiple elastic layers. The metallocene elastic polymer needed only to constitute a minimum of 10 weight percent of any such composite, implying that further elastic layers could be made of other elastic polymers, in particular those recited in claim 1 of the contested patent. Accordingly, the subject-matter of claim 1 as granted was not novel over the D1.

D11 was prima facie relevant to the patent in suit. This document disclosed a composite material comprising a first layer in the form of an elastomeric nonwoven material made from elastomeric metallocene polyolefins and a second layer in the form of a net made of conventional elastomers such as polyurethanes, EVA, block copolymers, etc. This elastomeric composite could be joined to other layers such as fabrics and materials for the formation of disposable undergarments and the like. Hence the composite could be joined to a gatherable, i.e. non-elastic, web. Therefore, the subject-matter of claim 1 as granted was not novel over D11. Furthermore, D11 was directed to the same problem as that underlying the opposed patent, namely to allow for greater control of the properties of materials produced from elastomeric polymers.

Reasons for the Decision

1. The appeals are admissible.

2. *Introduction of D11*

2.1 The appellant's (patent proprietor's) main request to remit the case to the department of first instance is a procedural request which in the present circumstances would only be justified if document D11, filed by the appellant (opponent) about 1 month before the date of oral proceedings, were admitted into the proceedings.

2.2 In accordance with the established case law of the Boards of Appeal, an essential criterion for deciding on the admissibility of a late-filed document is its relevance, i.e. its evidential weight in relation to other documents already in the proceedings (see Case Law of the Boards of Appeal of the European Patent Office, 4th edition 2001, VI.F.2). However, the relevance of D11 can only be assessed having regard to the subject-matter claimed by a substantive request of the patent proprietor.

2.3 Considering the appellant's (patent proprietor's) main substantive request, which is the maintenance of the patent as granted, and having regard to the passages of D11 referred to by the appellant (opponent) (in particular: claim 1, page 15, lines 30-34; page 17, lines 17-28; page 10, line 24- page 11, line 34, page 24, lines 6-12 and page 5, lines 5 to 12), the Board takes the view that document D11 is highly relevant to the claimed subject-matter.

Therefore, even though late-filed, document D11 is admitted into the proceedings pursuant to Article 114(1) EPC.

3. *Novelty*

3.1 The subject-matter of claim 1 as granted was found to lack novelty over D1 by the Opposition Division. If this finding were confirmed, then the main request would fall independently of any considerations relative to D11. Therefore, the Board considers it expedient to first assess novelty over the documents considered by the Opposition Division before deciding on the matter of possible remittal.

3.2 In the communication pursuant to Article 11(1) RPBA annexed to the summons to oral proceedings, the Board explained in detail why in its preliminary opinion the subject-matter of claim 1 as granted was novel over D1. During the oral proceedings the appellant (opponent) did not comment on this view and simply relied on its written submissions in the grounds of appeal. The Board therefore does not see any reason to deviate from its provisional opinion, which is given in further detail below.

3.3 The wording of claim 1 implies that the second layer has a composition different from that of the first layer due to the presence of the elastomeric polymer selected from the group referred to in claim 1. In this respect it is noted that the views of the Opposition Division in the decision under appeal (point 5), according to which the presence, in the second layer, of an elastomeric polymer selected from the group referred to in claim 1 implies *"nothing more than a minuscule distinction over the prior art, which distinction is (just) sufficient to provide literal (formal) novelty"*, and according to which *"it is not*

credible that such a minuscule amount of additional polymer would give rise to any technically meaningful effect" cannot be followed. Indeed, in the absence of any indication to the contrary in the patent in suit, the presence of the elastomeric polymer in the second layer can only be regarded as an essential technical feature within the meaning of Rule 29(1) and (3) EPC, which, as such, interacts with the other features of the claim to provide a technical effect. Therefore, the claim cannot be interpreted as implying that the elastomeric polymer might be present only in an amount lying marginally above the threshold of detection (point 4 of the decision under appeal), but rather as implying that the elastomeric polymer must at least be present in an amount sufficient to provide a detectable technical effect.

- 3.4 In D1 there is no clear and unambiguous disclosure of a layer consisting of an elastomeric metallocene polyolefin in combination with a second layer having a different composition. In fact, the passages relied upon by the appellant (opponent) on page 18, lines 4 to 8 of D1, according to which "*for the composite materials of the present invention, any layer (or portion) and any number of layers can comprise at least one substantially linear ethylene polymer*", i.e. said elastomeric metallocene polyolefin (see page 8, lines 2 to 29), and on page 17 second to fourth paragraph, according to which "*the substantially linear ethylene polymers disclosed herein can be admixed with other polymers*" (such as ethylene vinyl acetates), represent a general disclosure of a composite material having a plurality of layers with the metallocene polyolefin, not, however, a specific disclosure of a composite

material in which the first layer is an elastomeric metallocene polyolefin and the second layer has a different composition.

- 3.5 Novelty of the subject-matter claimed in the patent as granted over the other documents cited in the proceedings before the Opposition Division was not contested and can, in the Board's judgment, be acknowledged.

4. *Remittal to the department of first instance*

Having found that the subject-matter of claim 1 is novel over the prior art which was available to the Opposition Division, the next substantive issue to be addressed is whether the subject-matter of claim 1 is novel over document D11 which was only filed in the appeal proceedings.

The Board agrees with the appellant's (patent proprietor's) view that D11 might be such as to change the centre of gravity of the case presented on appeal compared with that of the one decided by the first instance (see e.g. T 611/90). Therefore, in order to give the parties the opportunity to prosecute their rights at two instances of jurisdiction, the Board considers that the questions of novelty over D11, and of inventive step over the now available prior art, should be dealt with by the department of first instance. The Board thus makes use of its power under Article 111(1) EPC to remit the case to the first instance for further prosecution. This also means that the appellant's (patent proprietor's) main (procedural) request is allowed.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:

M. Patin

G. Kadner