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**Datasheet for the decision
of 9 November 2006**

Case Number: T 0279/04 - 3.2.06

Application Number: 89302553.6

Publication Number: 0336578

IPC: A61F 13/15

Language of the proceedings: EN

Title of invention:

Thin, flexible sanitary napkin

Patentee:

THE PROCTER & GAMBLE COMPANY

Opponents:

SCA Hygiene Products AB
McNeil-PPC, Inc.
Kimberly-Clark Worldwide, Inc.

Headword:

-

Relevant legal provisions:

EPC Art. 123(2), 84

Keyword:

"Added subject-matter (yes) - main request and auxiliary request 1b"
"Disclaimer intended to avoid the conflicting requirements of Article 123(2) and 123(3) - auxiliary request 1a"
"Clarity (no) - auxiliary request 1a"

Decisions cited:

G 0001/03

Catchword:

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Case Number: T 0279/04 - 3.2.06

D E C I S I O N
of the Technical Board of Appeal 3.2.06
of 9 November 2006

Appellant: THE PROCTER & GAMBLE COMPANY
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 22 December 2003
revoking European patent No. 0336578 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: P. Alting van Geusau
Members: G. Pricolo
W. Sekretaruk

Summary of Facts and Submissions

- I. The appeal is from the decision of the Opposition Division posted on 22 December 2003 revoking European patent No. 0 336 578, granted in respect of European patent application No. 89 302 553.6.
- II. In the decision under appeal the Opposition Division held that claim 1 as amended according to the proprietor's main request did not contain subject-matter extending beyond the content of the application as filed, that the claimed invention was disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art and that it was novel over the available prior art. However, the main request was not allowable because the subject-matter of claim 1 did not involve an inventive step having regard to the prior art disclosed by document D1: EP-A-122 042.

The auxiliary request filed by the proprietor during oral proceedings was not admitted pursuant to Rule 71(a) EPC.

- III. The appellant (patent proprietor) lodged an appeal, received at the EPO on 20 February 2004, against this decision and paid the appeal fee on the same day. With the statement setting out the grounds of appeal, received at the EPO on 29 April 2004, the appellant filed a main request together with auxiliary requests for maintenance of the patent in amended form.

Claim 1 of the main request, which corresponds in substance to claim 1 of the main request on which the decision under appeal is based, reads as follows:

"1. A thin sanitary napkin (10), said napkin being of generally elongate form and having opposed body and garment surfaces (26,17) defining the plan area of the napkin, said sanitary napkin comprising a liquid impermeable barrier means (16) forming said garment surface (17), and an absorbent means (13) having a first major surface (19) and a second major surface (22), said second major surface (22) being disposed adjacent said liquid impermeable barrier means (16), said absorbent means (13) including a liquid permeable topsheet (25) overlying the first major surface (19) and forming the body surface (26) of the sanitary napkin (10), and said absorbent means (13) comprises an absorbent core (34) containing from 5.0% to 85.0% by weight of hydrogel-forming polymeric material, and said sanitary napkin (10) being characterized by:
having a flexure resistance of less than 400 g as measured by a modified form of ASTM-D-4032-82; a test absorbent capacity of at least 8.0 g sterile saline solution, measured on a sample of the napkin having a plan area of 66.5cm², said sample being centred on the intersection of the longitudinally and laterally extending centre lines (58,61) of the napkin; a total absorbent capacity of at least 14.0 g sterile saline solution, as measured in the entire napkin; and said sanitary napkin having a caliper of less than 3.0 mm as measured under a load of 17.44 g/cm²."

IV. In a communication accompanying the summons to oral proceedings pursuant to Article 11(1) of the Rules of Procedure of the Boards of Appeal, the Board stated that it had to be discussed whether the feature of claim 1 according to which the sample is "*centred on the intersection of the longitudinally and laterally extending centre lines of the napkin*" could be derived from the passage of the description that "*[a sample] of the sanitary napkin is cut from the portion of the sanitary napkin which would be centred under the vaginal orifice when the sanitary napkin is worn*". The Board expressed the preliminary opinion that it would appear that there was no disclosure in the application as filed that the intended position of the vaginal orifice with respect to the napkin must correspond to the intersection of the longitudinally and laterally extending centre lines of the napkin.

V. In response to the preliminary opinion of the Board, the appellant filed with letter dated 9 October 2006 new auxiliary requests of maintenance of the patent in amended form.

VI. Oral proceedings took place on 9 November 2006, at the end of which the decision of the Board was announced.

The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request, filed with the grounds of appeal on 29 April 2004, or on the basis of auxiliary request 1a, filed with the letter dated 9 October 2006, with description column 16 filed during the oral proceedings on 9 November 2006 as auxiliary request 1a'

or on the basis of auxiliary request 1b filed with letter dated 9 October 2006.

It further requested correction of the description under Rule 88 EPC in accordance with the request filed with letter dated 9 October 2006.

The respondents (opponents I, II and III) requested that the appeal be dismissed.

VII. Claim 1 according to auxiliary request 1a differs from claim 1 according to the main request in that it refers to a liquid impermeable "sheet", rather than to a liquid impermeable "means", and in that the characterizing portion reads as follows:

"a flexure resistance of less than 400 g as measured by a modified form of ASTM-D-4032-82; said sanitary napkin having a test absorbent capacity of at least 8.0 g sterile saline solution, measured on a sample of the napkin having a plan area of 66.5cm², said sample being cut from the portion which would be centred under the vaginal orifice when the sanitary napkin is worn; a total absorbent capacity of at least 14.0 g sterile saline solution, as measured in the entire napkin; and said sanitary napkin having a caliper of less than 3.0 mm as measured under a load of 17.44 g/cm²; but not including a sanitary napkin whose test capacity is less than 8.0 g sterile saline solution, measured on a sample of the napkin having a plan area of 66.5cm², when said sample is centred on the intersection of the longitudinally and laterally extending centre lines (58,61) of the napkin."

Claim 1 according to auxiliary request 1b differs from claim 1 according to the main request in that it refers to a liquid impermeable "sheet", rather than to a liquid impermeable "means", and in that it additionally recites the following feature:

"said hydrogel-forming polymeric material being uniformly distributed throughout at least 100.0cm² of the napkin".

VIII. The arguments of the appellant in support of its requests, insofar as they are relevant to this decision, can be summarized as follows:

The reference in claim 1 to the intersection of the longitudinally and laterally extending centre lines of the napkin necessarily implied that the napkin was both laterally and longitudinally symmetrical, and that the claim did not cover napkins which were not. Although the intended position of the vaginal orifice with respect to the napkin did not necessarily correspond precisely to the intersection of the longitudinally and laterally extending centre lines of the napkin, these two positions were sufficiently close to one another that, for practical purposes, it made no difference which was taken when cutting a sample for the purpose of measuring the test absorbency capacity. This was confirmed by the test results of opponent II (D19 filed before the Opposition Division and D31 filed in appeal proceedings), in which the test method of the patent in suit was carried out using a sample centred on the intersection of the longitudinally and laterally extending centre lines. Accordingly, claim 1 of the

main request complied with the requirements of Article 123(2) EPC.

In auxiliary request 1a claim 1 was amended with a view to avoiding the objection under Article 123(2) EPC, raised by the respondents, by replacing the statement that the test absorbency capacity sample was centred on the intersection of the longitudinally and laterally extending centre lines of the napkin by a statement that the sample was cut from the portion which would be centred under the vaginal orifice when the sanitary napkin was worn. This feature was clear: there could be no doubt that it was the sample itself that should be centred under the vaginal orifice, the position of which could be easily determined. Furthermore, the amendment of claim 1 was accompanied by an amendment of the description to make it clear that the sample had well-defined shape and dimensions. To obviate any problem under Article 123(3) EPC, claim 1 was further amended by including a disclaimer to exclude from its scope any napkins which, although satisfying claim 1 as a result of the "vaginal orifice" amendment, would not have satisfied the claim as granted. This was a proper use of a disclaimer. Although the purpose of the disclaimer was none of those mentioned in decision G 1/03, this decision did not exclude the possibility of using a disclaimer as part of an amendment to avoid the so-called inescapable trap, which was the purpose for which the appellant was seeking to employ it here. Possibly, a question as to the allowability of a disclaimer for this purpose should be referred to the Enlarged Board of Appeal.

In auxiliary request 1b claim 1 was amended to avoid the objection under Article 123(2) EPC by stating that the hydrogel-forming polymeric material was distributed uniformly throughout at least 100.0cm² of the napkin. In a napkin with such a large area of uniform polymer distribution, it was out of question that there could be any difference between a test absorbency capacity measured on the basis of the position of the vaginal orifice and a test absorbent capacity measured on the basis of the intersection of the longitudinally and laterally extending centre lines of the napkin.

IX. The respondents essentially argued as follows:

The claim was not restricted to symmetrical napkins but encompassed any kind of napkins. Generally, also for napkins that were symmetrical in shape, the point of intersection of the laterally and longitudinally extending centre lines might be completely different from the intended position of the vaginal orifice. D19 and D31 showed the results of tests made on napkins of the kind disclosed by D1. These napkins were homogeneous and therefore it did not matter where the sample for measuring the test absorbency capacity was centred. However, this was not the case for all the napkins encompassed by claim 1, in particular for those napkins having zones with different absorbency, such as disclosed by document

D33: US-A-4 333 463.

Therefore, claim 1 of the main request introduced subject-matter extending beyond the content of the application as filed.

G 1/03 set out an exhaustive list of criteria for the allowability of a disclaimer. The disclaimer introduced in claim 1 according to the auxiliary request 1a did not fulfil any of these criteria, and therefore it was not allowable. It still included an undisclosed feature, yet dressed-up as a disclaimer. It was not clear what subject-matter was covered by the combination of the newly introduced feature and the disclaimer. The newly introduced feature was not clear, because the position of the vaginal orifice was not a feature of the napkin and because it was not clear whether it was the sample which should be centred under the vaginal orifice or rather the portion from which the sample was cut.

Claim 1 according to auxiliary request 1b required a uniform distribution of the hydrogel-forming polymeric material only over an unspecified and limited area of the napkin, which was slightly larger than the area of the sample necessary for measuring the test absorbent capacity. Thus, claim 1 did not necessarily relate to an homogeneous napkin. Accordingly, also in the case of a napkin in accordance with this claim different measurements of the test absorbency capacity could be obtained depending on where the sample was centred. Therefore, by analogy with claim 1 of the main request, claim 1 of auxiliary request 1b did not meet the requirements of Article 123(2) EPC.

Reasons for the Decision

1. The appeal is admissible.
2. *Main request*
 - 2.1 It is an undisputed fact that the feature of claim 1 according to which the value of the test absorbent capacity should be measured on a sample of the napkin which is "*centred on the intersection of the longitudinally and laterally extending centre lines of the napkin*" is not disclosed *expressis verbis* in the application as filed. The latter indeed discloses that the sample "*is cut from the portion of the sanitary napkin which would be centered under the vaginal orifice when the sanitary napkin is worn*" (see column 17, lines 30 to 33 of the application as published).
 - 2.2 The appellant submitted that, although the vaginal orifice is not necessarily positioned in correspondence with the intersection of the longitudinally and laterally extending centre lines of the napkin when the latter is worn, for practical purposes it did not matter whether the sample was positioned in correspondence with the intersection of the longitudinally and laterally extending centre lines or in correspondence with the vaginal orifice.

The appellant did not contest the respondents' assertions that the position of the vaginal orifice with respect to the napkin might differ *substantially* from the intersection of the longitudinally and laterally extending centre lines of a symmetrical

napkin, and that distances of the order of centimetres were possible. As a matter of fact, the position of the vaginal orifice with respect to the napkin depends on various factors, in particular the user's anatomy, the napkin's shape and dimensions, the personal manner of wearing it, the user's position and movements, etc. Considering the preferred absorbent core disclosed in the patent in suit, which is 22 centimetres long and 7 centimetres wide across its midportion (see column 5, lines 14 to 21), it is clear that, with such large dimensions, differences of some centimetres in use will easily arise. This even more so if the napkin has e.g. a rectangular shape (i.e. without a somehow defined central area) as opposed to the dogbone shape shown in Figure 1 of the patent in suit.

If the napkin under consideration is homogeneous, then it can be expected that the value of the measured test absorbent capacity does not depend on the shape of the sample and on where it is centred, but only on its area (66.5cm^2). In this respect, the Board can follow the argument of respondent II, that since D19 and D31 relate to homogeneous napkins, it is irrelevant for the test results whether the samples are centred in correspondence with the intersection of the longitudinally and laterally extending centre lines or in correspondence with the vaginal orifice. However, claim 1 is not limited to homogenous napkins and encompasses napkins in which the absorbent material, in particular the polymeric gelling agent, is not uniformly distributed, as explicitly stated in para. [007] of the patent in suit. In napkins having an absorbent core in which the absorbent material is not uniformly distributed, the position on which the sample

is centred might play an important role in determining the value of the test absorbent capacity. This is clearly evident having regard to the absorbent core for a napkin (see column 2, lines 7 to 10 and 14 to 16) shown in Figures 3 and 4 of D33, which has a reservoir (32, 42) located near one end of the cellulosic batt (30, 40), e.g. one-third of the way or between the center and end of the core (see column 2, lines 54 to 64). The reservoir, which contains superabsorbent particles (see column 3, lines 2, 3), has a relatively high liquid absorbency (see column 2, lines 62 to 64). A sample of the napkin having a plan area of 66.5cm^2 might encompass different portions of the reservoir, depending on where the sample is centred. If the sample is centred on the intersection of the longitudinally and laterally extending centre lines of the napkin, it might include a portion of the reservoir which is smaller than the portion of the reservoir included by a sample which is centred in correspondence of the vaginal orifice, since the position of the latter is closer to the reservoir than the above-mentioned intersection.

2.3 Finally, the appellant has not submitted evidence, or theoretical explanations, which could support a finding that, for *any possible napkin* falling under the scope of claim 1, it makes no difference, for the purpose of measuring the test absorbency capacity, whether a sample centred under the vaginal orifice is taken or rather a sample centred on the above-mentioned intersection.

2.4 From the above it follows that the value of the test absorbent capacity measured on a sample of the napkin

which is *"centred on the intersection of the longitudinally and laterally extending centre lines of the napkin"* does not necessarily correspond to the value of the test absorbency capacity measured on a sample of the napkin which *"is cut from the portion of the sanitary napkin which would be centered under the vaginal orifice when the sanitary napkin is worn"*, at least for some sanitary napkins not having uniform distribution of absorbent matter which are encompassed by the definition of claim 1.

Therefore, the feature of claim 1 according to which the value of the test absorbent capacity should be measured on a sample of the napkin which is *"centred on the intersection of the longitudinally and laterally extending centre lines of the napkin"* introduces subject-matter extending beyond the content of the application as filed, contrary to the requirements of Article 123(2) EPC.

As a consequence, the appellant's main request cannot be allowed.

3. *Auxiliary request 1a*

- 3.1 Claim 1 according to the first auxiliary request 1a is amended by replacing the feature that the sample is *"centred on the intersection of the longitudinally and laterally extending centre lines of the napkin"* with the feature disclosed in the description of the application as filed according to which the sample is *"cut from the portion which would be centred under the vaginal orifice when the sanitary napkin is worn"*. Furthermore, the claim comprises a disclaimer according

to which the claimed subject-matter does not include a *"sanitary napkin whose test capacity is less than 8.0 g sterile saline solution, measured on a sample of the napkin having a plan area of 66.5cm², when said sample is centred on the intersection of the longitudinally and laterally extending centre lines (58,61) of the napkin"*.

The appellant's intention in introducing the disclaimer is to avoid an extension of the scope of protection due to the replacement of the above-mentioned feature of claim 1 as granted with a feature taken from the description. The disclaimer excludes the range of less than 8.0 g for the test absorbent capacity, measured on a sample *centred on the intersection of the longitudinally and laterally extending centre lines*, i.e. the range which is complementary to the range of at least 8.0 g referred to in granted claim 1. By excluding this complementary range, the disclaimer should prevent that subject-matter excluded from the scope of protection of granted claim 1 is included in the scope of protection of claim 1 of auxiliary request 1a which refers to a different range, namely the range of at least 8.0 g for the test absorbency capacity, measured on a sample cut from the portion which would be *centred under the vaginal orifice when the sanitary napkin is worn*.

- 3.2 However, irrespective of considerations whether the disclaimer is acceptable for the purpose intended by the appellant, the amendments made lead to a lack of clarity of the claimed subject-matter, contrary to Article 84 EPC, and already for this reason the request must be rejected.

In particular, the feature relating to the sample being "*cut from the portion which would be centred under the vaginal orifice when the sanitary napkin is worn*" leads to an unclear definition of the matter for which protection is sought, because the position of said portion is not a characteristic of the napkin as such but obviously depends on how the napkin is worn and by whom. As a matter of fact, the position of the vaginal orifice with respect to the napkin does not depend on the intrinsic characteristics of the napkin only, but also, as already stated above (point 2.2), on the circumstances of its use (e.g. the user's anatomy, her position and movements, the personal manner of wearing the napkin).

The appellant's argument that the position of the vaginal orifice with respect to the napkin is easy to determine is not contested by the Board. This, in fact, might be true under specific circumstances (i.e. for a given napkin and a given wearer). However, the decisive point is that, for a given napkin, it is not possible to clearly identify a position which directly corresponds to the position of the vaginal orifice under all possible circumstances that can arise when the napkin is in use.

- 3.3 These considerations are independent of the amendment made to the description to limit the sample to a specific configuration of 4.75 x 14.0 centimeters, and therefore, the auxiliary request 1a cannot be allowed.

4. *Auxiliary request 1b*

- 4.1 Claim 1 according to auxiliary request 1b differs from claim 1 according to the main request in that it refers to a liquid impermeable "sheet", rather than to a liquid impermeable "means", and in that it additionally recites the feature according to which "said hydrogel-forming polymeric material being uniformly distributed throughout at least 100.0 cm² of the napkin".

Although these features are derivable from the application as filed (see column 8, lines 18 to 25 and Figures 1, 2 of the application as published), they do not have the effect of restricting the claimed subject-matter to a napkin which is homogeneous over its whole extent. Indeed the feature that the hydrogel-forming polymeric material is uniformly distributed throughout at least 100.0cm² of the napkin only implies a uniform distribution of the hydrogel-forming polymeric material over a limited and unspecified portion of the napkin (which might have an absorbent core greater than 144 cm², see column 5, lines 16 to 20 of the patent in suit). Moreover, the hydrogel-forming polymeric material is not necessarily the unique constituent of the absorbent core, as the latter might comprise, as usual, fibrous absorbent material, which might be non-uniformly distributed and, in the absence of any indication concerning the concentration of the hydrogel-forming polymeric material, even provide the major absorbent function.

Thus, it cannot be excluded that very different results of the test absorbent capacity are obtained depending on where a sample of the napkin having a plan area of

66.5cm² is centred. Therefore, having regard to the reasoning in respect of the main request, it is concluded that the definition of claim 1 of auxiliary request 1b according to which the value of the test absorbent capacity should be measured on a sample of the napkin which is "*centred on the intersection of the longitudinally and laterally extending centre lines of the napkin*" introduces subject-matter extending beyond the content of the application as filed, contrary to the requirements of Article 123(2) EPC.

4.2 As a consequence, the appellant's auxiliary request 1b cannot be allowed.

5. *The request for correction*

The correction under Rule 88 EPC requested by the appellant, if allowed, would be without effect on the above reasons for refusing the appellant's requests, since it is exclusively concerned with the feature of claim 1 relating to the flexure resistance. This feature plays no role in the above considerations. As a consequence of the fact that none of the appellant's sets of claims according to the main and auxiliary requests 1a and 1b is allowable, there is no allowable text which could form the basis for maintaining the patent in amended form, irrespective of the correction under Rule 88 EPC requested by the appellant. This means that the request for correction is unfounded and thus must be rejected independently of the provisional finding of the Board, announced during the oral proceedings, that the request for correction was not allowable under Rule 88 EPC.

Order

For these reasons it is decided that:

1. The request for correction under Rule 88 EPC is rejected.
2. The appeal is dismissed.

The Registrar:

The Chairman:

P. Cremona

P. Alting van Geusau