

Internal distribution code:

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

D E C I S I O N
of 1 June 2006

Case Number: T 1223/04 - 3.2.06

Application Number: 93108691.2

Publication Number: 0572033

IPC: A61F 13/15

Language of the proceedings: EN

Title of invention:
Absorbent article

Patentee:
KIMBERLY-CLARK WORLDWIDE, INC.

Opponent:
The Procter & Gamble Company

Headword:
-

Relevant legal provisions:
EPC Art. 123(2), 83, 84

Keyword:
"Amendments - added subject-matter (no)"
"Disclosure - enabling (yes)"
"Claims - clarity (yes)"

Decisions cited:
G 0011/91, T 0367/96

Catchword:
-



Case Number: T 1223/04 - 3.2.06

D E C I S I O N
of the Technical Board of Appeal 3.2.06
of 1 June 2006

Appellant: The Procter & Gamble Company
(Opponent) One Procter & Gamble Plaza
Cincinnati, OHIO 45202 (US)

Representative: L'Huillier, Florent Charles
Procter & Gamble Service GmbH
Sulzbacher Strasse 40-50
D-65824 Schwalbach am Taunus (DE)

Respondent: KIMBERLY-CLARK WORLDWIDE, INC.
(Patent Proprietor) 401 North Lake Street
Neenah, Wisconsin 54956 (US)

Representative: Davies, Christopher Robert
Frank B. Dehn & Co.
St Bride's House
10 Salisbury Square
London EC4Y 8JD (GB)

Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
16 August 2004 concerning maintenance of
European patent No. 0572033 in amended form.

Composition of the Board:

Chairman: G. Pricolo
Members: G. De Crignis
W. Sekretaruk

Summary of Facts and Submissions

- I. European patent No. 0 572 033 granted on application No. 93 108 691.2 claiming a priority of 29 May 1992 from US 891361 was maintained in amended form by decision of the opposition division posted on 16 August 2004.
- II. The opposition division was of the opinion that the subject-matter of claim 1 in accordance with the patent proprietor's first auxiliary request complied with the requirements of the EPC. In particular, it considered that the patent in suit disclosed the invention in a manner sufficiently clear and complete for it to be carried out by a skilled person (Article 83 EPC), that the subject-matter of independent claims 1 and 25 fulfilled the requirements of Article 123(2) and (3) EPC, was novel (Article 54 EPC) and involved an inventive step (Article 56 EPC) over the cited prior art.

Concerning sufficiency of disclosure, the opposition division stated that the skilled person was capable of realising whether 10 grams of body fluid could be absorbed by the absorbent means. Moreover, as regards the Circular Bend Flex test, the patent in suit disclosed in paragraphs [0090] and [0091] references to ASTM standard test methods and no proof had been presented that it was not possible to perform these tests.

- III. On 15 October 2004 a notice of appeal was filed against this decision by the appellant (opponent) together with payment of the appeal fee. With the statement setting

out the grounds of appeal, submitted on 21 December 2004, the appellant filed document

D12 ASTM D 4032-82

which was cited in paragraph [0091] of the patent in suit as a standard method for measuring the Circular Bend Flex value. Objections in respect of added subject-matter (Article 123(2) EPC), insufficiency (Article 83 EPC), lack of novelty and lack of inventive step (Article 100(a) EPC) were made against claims 1 and 25 as maintained by the opposition division.

- IV. In response to the appeal the respondent filed with letter of 16 May 2005 new sets of claims in accordance with a main request and six auxiliary requests.
- V. In an annex to the summons for oral proceedings pursuant to Article 11(1) Rules of Procedure of the Boards of Appeal dated 20 January 2006 the Board expressed, *inter alia*, doubts concerning the allowability of independent method claim 24 of the main request under Article 123(2), 83 and 84 EPC.
- VI. Oral proceedings were held on 1 June 2006.

The appellant requested that the decision under appeal be set aside and that the European patent be revoked.

The respondent (patentee) requested that the patent be maintained on the basis of claims 1 to 21, and description pages 2 to 23 as filed during the oral proceedings, and Figures 1 to 13 as granted.

Claim 1 of the respondent's request reads as follows:

"An absorbent article (15; 40; 50; 80) adapted to receive and absorb body fluid and having a central longitudinal axis (y-y), said absorbent article comprising:

a) an absorbent means (20; 60) having a central longitudinal axis substantially aligned along the central longitudinal axis (y-y) of said absorbent article (15; 40; 50; 80), said absorbent means (20; 60) being capable of absorbing at least 10 grams of body fluid deposited on said absorbent article (15; 40; 50; 80); and

b) a substantially resilient layer (19; 58) having a garment-facing side characterized in that said substantially resilient layer (19; 58) is foam polymer and is substantially non-absorbent, has a width greater than the width of said absorbent means (20; 60), and has a Circular Bend Flex in the range of from about 9 grams to about 42 grams at a rebound resiliency of about 50% to have sufficient resilience to resist bunching of said absorbent article (15; 40; 50; 80) and said absorbent article further comprises

c) a substantially liquid-impermeable baffle (18) disposed on said garment facing side of said substantially resilient layer."

VII. The arguments of the appellant were essentially the following:

The feature in claim 1 referring to the Circular Bend Flex Test in the range of from about 9 to about 42 grams at a rebound resiliency of about 50% was

disclosed in the description as originally filed only for a specific polyethylene foam material, not for foam polymers in general (Article 123(2) EPC). Furthermore, in the same feature it was not clear what limitations were implied by the term "about" (Article 84 EPC).

With respect to Article 83 EPC, the patent in suit included a single example of a polyethylene foam having a Circular Bend Flex at 50% rebound resiliency, namely the example referred to in paragraph [0092] which related to a specific polyethylene foam. This single disclosure of one way of carrying out the invention was insufficient to allow the invention to be performed in the whole range claimed. It amounted to an undue burden to reproduce the invention within the broad scope of claim 1 since the patent in suit did not disclose how to select or obtain other foam materials in order to achieve the desired "Circular Bend Flex in the range of from about 9 grams to about 42 grams at a rebound resiliency of about 50%" or how to manipulate any foam polymer in order to achieve alternatives to the sole example of polyethylene foam disclosed.

Further with respect to Article 83 EPC, the patent in suit did not disclose what portions of the absorbent article should be regarded as the "absorbent means". In the examples, the absorbent means was disclosed as one amongst various absorbent components of the absorbent article. It was nowhere explained how to distinguish the absorbency of the absorbent means from the absorbency of other absorbent components, such as the transfer layer or other tissue layers. The absorbency test as disclosed in paragraph [0146] of the patent in suit referred to an entire sanitary napkin being

submerged in a recipient containing a saline solution. Therefore, this test was only suitable to test the "Total Capacity" of an entire napkin, not to test the absorbent capacity of the absorbent means itself.

VIII. The respondent essentially argued as follows:

Claim 1 was based upon claim 1 and dependent claims 6, 7 and 9 of the application as originally filed, which dependent claims referred to "any one of the preceding claims". Thus, the combination of features of claim 1 was already present as such in the application as filed. Moreover, claim 1 directly resulted from the combination of granted claims 1, 11 and 14. Since the specific object of claim 1 was already claimed in the patent as granted, objections against it were not allowable under Article 84 EPC.

With respect to Article 83 EPC, the skilled person would have no difficulties in determining the absorbency of the absorbent means. In the patent in suit an absorbency test was disclosed in paragraph [0146]. The skilled person could perform this test for any absorbent article and then, if necessary, remove the cover layer therefrom in order to determine the absorbency of the absorbent means.

Further with respect to Article 83 EPC, although the patent in suit disclosed only one example of a polymer foam having a CBF at a rebound resiliency of 50% (paragraph [0032]), the skilled person would easily find other polymer foams meeting the requirements of claim 1. In fact, the rebound resiliency was a property of the material. Once a material having a rebound

resiliency of 50% was found, then a suitable Circular Bend Flex value could be arrived at e.g. by selecting an appropriate thickness.

Reasons for the Decision

1. The appeal is admissible.

2. *Amendments*

2.1 The respondent's main request includes only one independent claim, namely claim 1, which contains additionally with respect to claim 1 as originally filed the following features:

- the resilient layer is foam polymer,
- the resilient layer has a Circular Bend Flex in the range of from about 9 grams to about 42 grams at a rebound resiliency of about 50% and
- there is a substantially liquid-impermeable baffle (18) disposed on said garment facing side of said substantially resilient layer.

2.2 Article 123(2) EPC

Claim 1, together with claims 6, 7 and 9 of the application as filed, which literally disclose these additional features, form the basis for the combination of features of claim 1 under consideration.

The appellant considered that, since, the feature referring to the "Circular Bend Flex Test in the range of from about 9 to about 42 grams at a rebound resiliency of about 50 %" was disclosed in the

description of the application as filed only in connection with a specific polymer, there was no basis for a broad claim referring to foam polymers in general.

However, there is no basis to consider that the limited disclosure in the description should prevail over the general disclosure in the claims of the patent application as filed. In this respect it is noted that a literal disclosure of this feature is present in the originally filed dependent claim 7 which refers to "any one of the preceding claims" and thus also to originally filed dependent claim 6, referring to the resilient layer being generally a foam. Decision G 11/91 (OJ 1993, 125) reaffirmed that regarding the concept of the content of the application, the parts of the European patent application which determined the disclosure of the invention were the description, claims and any drawings in the application documents. Accordingly, it is not only the disclosure in the description which is of relevance with respect to the requirements of Article 123(2) EPC, but also the disclosure in the claims.

Therefore, the amendments made to claim 1 meet the requirements of Article 123(2) EPC.

- 2.3 Dependent claims 2 to 21 find their basis in the application as filed. The description has been adapted for consistency to the subject-matter claimed in claim 1. Therefore, none of the amendments made give rise to objections under Article 123(2) EPC.

2.4 Article 84 EPC

With respect to the same feature objected to under Article 123(2) EPC, the appellant objected also to lack of clarity. In particular, the term "about" in the wording "at a rebound resiliency of about 50 %" was considered as not defining a clear limitation.

However, claim 1 results in substance from the combination of claims 1, 11 and 14, and therefore, concerns a specific object which as such was already claimed in the patent as granted. Therefore, the appellant's objection under Article 84 EPC does not arise out of amendments made. Considering that clarity of the subject-matter of the claims is not a ground for opposition specified in Article 100 EPC, the Board takes the view, that the appellant's objection cannot be allowed, in accordance with the case law relied upon by the respondent (see T 367/96) according to which Article 102(3) EPC does not allow objections to be based upon Article 84 EPC if such objection does not arise out of the amendments.

3. *Article 83 EPC*

3.1 Regarding the requirement " said substantially resilient layer (19; 58) is foam polymer and is substantially non-absorbent, ..., and has a Circular Bend Flex in the range of from about 9 grams to about 42 grams at a rebound resiliency of about 50 %"

The Board is satisfied that the rebound resiliency constitutes an inherent characteristic of foam materials, as submitted by the patent proprietor.

Accordingly, the skilled person could test foam materials for this inherent characteristic since such a test was available in the form of the cited ASTM D 3574 method (referred to in the patent in suit in paragraph [0090] and in the Encyclopaedia of Polymer Science disclosed in paragraph [0092] of the patent in suit)). The application of such a standard method is routine for the skilled person and no particular difficulties in this respect have been cited by the appellant.

The appellant objected that the skilled person was not in a position to find other foam polymers meeting the above-mentioned requirements other than the one disclosed in the patent in suit. Too many parameters were involved to find another material. In particular, the skilled person did not know how to change the parameters of the manufacturing method (kind of gas, pressure, nature of bubbles, density of the foam, kind of manufacturing method) to reliably obtain alternative polymer foams. This amounted to an undue burden.

However, in the absence of any evidence, the appellant's submissions must be regarded as unsubstantiated allegations. The Board has no apparent reason to put in doubt the respondent's assertion according to which the skilled person has sufficient knowledge at his disposal to find alternative polymer foams having a rebound resiliency of 50% with a reasonable degree of experimentation. As already explained, the rebound resiliency is an inherent property of the polymer, and the skilled person can also be expected to gain further knowledge from his experiments to finally arrive at a material having the desired inherent property. As regards the Circular Bend

Flex, the Board also has no apparent reason to put in doubt the respondent's view, supported by the content of D12, that the CBF is a mechanical property of a given layer, which value depends in particular on the thickness of the layer. Accordingly, once the skilled person has identified an alternative foam polymer having a rebound resiliency of 50%, he can without difficulty provide a layer having a Circular Bend Flex within the claimed range by adapting the thickness of such an identified foam polymer.

Accordingly, the skilled person is in a position to provide suitable polymer foams other than the polyethylene foam specifically disclosed in the patent in suit.

- 3.2 Regarding the requirement "absorbent means being capable of absorbing at least 10 grams of body fluid deposited on said article"

Claim 1 defines the absorbent article as comprising an absorbent means (20; 60), a resilient layer (19; 58) and a baffle (18). Hence, according to claim 1 these three components are specified. The baffle is defined as being liquid-impermeable. The resilient layer is defined as being a non-absorbent foam polymer. Accordingly, the baffle and the resilient layer can be disregarded with respect to absorbency.

The absorbent means is specified as either a laminate (paragraph [0052]) or as a composite (paragraph [0055]). It is further specified (paragraphs [0036 and 0063]) as constituting the significant absorbing portion of the napkin with a capacity of absorbing at least about 80%

of the body fluid deposited on the napkin. The absorbent means does not comprise a transfer layer or further tissue layers which are specified separately in the description, the figures and in the dependent claims. Claim 1 requires the absorbent means to be capable of absorbing at least 10 g of body fluid. The wording "when deposited on an absorbent article" implies also that this absorbent capacity of the absorbent means has to be present when the absorbent means is in the absorbent article.

With regard to the determination of the absorbent capacity the test procedure specified in paragraph [0146] as the "Total Absorbent Capacity Test" only refers to an entire sanitary napkin. No procedure for the determination of the absorbent capacity of an "absorbent means" is present. The respondent argued that by removing the cover from the claimed absorbent article the capacity of the absorbent means could be determined. In view of the remaining parts of the absorbent article (resilient layer, baffle) being non-absorbent, the Board is also of the opinion that the skilled person is capable of applying such a modification to this test and that it is within his usual knowledge to do so. Furthermore, when a transfer layer and further tissue layers are present - as shown in the embodiments represented by the figures - the absorbent capacity of these layers can be determined independently after identification of the concerned material by deducting their absorbent capacity from the overall absorbent capacity.

In this respect it is noted that the appellant did not provide any evidence that it would not be possible to determine the absorbent capacity of the claimed article. Accordingly, the skilled person is in a position to determine whether an absorbent means meets the above mentioned requirement.

3.3 It follows that the disclosure of the patent in suit is to be regarded as sufficient within the meaning of Article 83 EPC.

4. *Article 54(2) EPC, Article 56 EPC*

During the oral proceedings, the appellant withdrew all objections in respect of lack of novelty and lack of inventive step. Considering that claim 1 is more restricted in scope than claim 1 as allowed by the Opposition Division by the introduction of the feature that the resilient layer is foam polymer, that claims 2 to 21 are dependent claims defining further embodiments of the absorbent article of claim 1, and that the Board sees no apparent reason to deviate from the view taken by the Opposition Division in respect of novelty and inventive step, there is no need for the Board to investigate these issues further. Therefore, the patent specification amended in accordance with the respondent's request forms a suitable basis for maintenance of the patent in such amended form.

