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**Datasheet for the decision  
of 18 December 2006**

**Case Number:** T 0382/05 - 3.3.06

**Application Number:** 97909935.5

**Publication Number:** 0951603

**IPC:** D21H 27/38

**Language of the proceedings:** EN

**Title of invention:**

Layered tissue having improved functional properties

**Patentee:**

THE PROCTER & GAMBLE COMPANY

**Opponents:**

Kimberly-Clark Worldwide, Inc.  
SCA Hygiene Products AB

**Headword:**

Layered tissue/PROCTER

**Relevant legal provisions:**

EPC Art. 107, 108, 110, 111, 54  
RPBA Art. 10 a, b

**Keyword:**

"Admissibility of late first and second auxiliary requests (no)  
- not clearly allowable or, respectively not occasioned by the  
appeal or the first instance decision"  
"Main request: novelty (no) - no distinguishing limitation of  
the claimed subject-matter by specific interpretation of the  
wording of claim 1"

**Decisions cited:**

G 0009/91, G 0009/92, T 0153/85, T 0856/92

**Catchword:**

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Case Number: T 0382/05 - 3.3.06

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.06  
of 18 December 2006

**Appellant:** THE PROCTER & GAMBLE COMPANY  
(Patent Proprietor) One Procter & Gamble Plaza  
Cincinnati, OH 45202 (US)

**Representative:** Nargolwalla, Cyra  
Cabinet Plasseraud  
52 rue de la Victoire  
F-75440 Paris Cedex 09 (FR)

**Respondent:** Kimberly-Clark Worldwide, Inc.  
(Opponent) 401 North Lake Street  
Neenah, WI 54956 (US)

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

**Respondent:** SCA Hygiene Products AB  
(Opponent) S-405 03 Göteborg (SE)

**Representative:** Stratmann, Klemens  
Hoffman Eitle,  
Patent- und Rechtsanwälte  
Arabellastraße 4  
D-81925 München (DE)

**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
9 February 2005 concerning maintenance of  
European patent No. 0951603 in amended form.

**Composition of the Board:**

**Chairman:** P.-P. Bracke  
**Members:** G. Dischinger-Höppler  
A. Pignatelli

## Summary of Facts and Submissions

I. This appeal is from the interlocutory decision of the Opposition Division concerning maintenance of European patent No. 0 951 603 in amended form on the basis of 6 claims according to the then pending fourth auxiliary request, relating to a layered tissue paper comprising five layers.

II. The patent as granted was based upon ten claims, the only independent Claim 1 reading:

"1. A layered tissue paper comprising:

at least one outer layer comprising relatively short papermaking fibers, whereby said at least one outer layer provides a soft tactile sensation to the user;

at least one first inner layer comprising relatively long papermaking fibers, whereby said fibers impart strength to the paper; and

at least one second inner layer comprising low density, high bulking fibers, wherein said fibers increase the bulk of the paper,

each of said layers being superimposed in face-to-face relationship with at least one other layer, whereby that said outer layer is exposed to a user."

Particular embodiments of the subject-matter of Claim 1 are referred to in the dependent claims comprising Claim 4 which reads:

"4. A paper according to Claim 1, comprising four layers,

two outer layers of relatively short papermaking fibers, whereby said outer layers are exposed to and provide a soft tactile sensation to the user,

a first inner layer of relatively long papermaking fibers, said relatively long papermaking fibers imparting strength to said paper, said first inner layer being juxtaposed with one of said outer layers,

a second inner layer of low density, high bulking fibers, said second inner layer being juxtaposed with said first inner layer and the other of said outer layers, whereby both said inner layers are between both said outer layers."

III. Two notices of opposition had been filed against the granted patent, wherein the Opponents sought revocation of the patent on the grounds of Article 100(a) EPC for lack of novelty and lack of inventive step (Articles 52(1), 54(2) and 56 EPC) and Article 100(b) EPC for insufficient disclosure (Article 83 EPC). The Oppositions were based, amongst others, on the following documents

D1 US-A-4 300 981,

D3 US-A-5 405 501,

D10 US-A-5 397 435 and

D13 US-A-3 994 771.

- IV. In its decision, the Opposition Division found that the subject-matter claimed in the then pending fourth auxiliary request met the requirements of the EPC. The Patent-Proprietor's higher ranking requests were held not to be allowable, inter alia, for lack of novelty of the claimed subject-matter over the disclosure of D1 or lack of inventive step in view of D1 in combination with D13.
- V. The Proprietor (hereinafter Appellant) appealed this decision and filed an amended set of claims as a main request with the letter dated 7 June 2005 setting out its statement of grounds of appeal. Claim 1 of this request differed from Claim 1 as granted in that the term "at least one outer layer comprising" was replaced by "at least one outer layer consisting of" and by replacing the term "at least one second inner layer comprising low density, high bulking fibers" by "at least one second inner layer consisting of low density, high bulking fibers selected from the group consisting of weakly bonded fibers, debonded fibers, curled fibers and fibers combined with fillers to increase the volume".
- VI. Under cover of their letters dated 29 September 2005 and 7 October 2005, the Opponents (hereinafter Respondents), in reply, filed objections under Articles 123(2), 84, 83, 54 and 56 EPC.
- VII. Under cover of a letter dated 17 November 2006, the Appellant replaced its previous main request by the claims as granted and filed amended sets of claims in two auxiliary requests.

Claim 1 of the first auxiliary request reads:

"1. A layered tissue paper comprising four layers,  
  
two outer layers of relatively short papermaking fibers,  
whereby said two outer layers are exposed to and  
provide a soft tactile sensation to the user,  
  
a first inner layer of relatively long papermaking  
fibers, said relatively long papermaking fibers  
imparting strength to said paper, said first inner  
layer being juxtaposed with one of said outer layers,  
  
a second inner layer of low density, high bulking  
fibers, wherein said fibers increase the bulk of the  
paper, said second inner layer being juxtaposed with  
said first inner layer and the other of said outer  
layers, whereby both said inner layers are between both  
said outer layers."

Claim 1 of the second auxiliary request reads:

"1. A layered tissue paper comprising five layers,  
  
two outer layers of relatively short papermaking fibers,  
whereby said outer layers are exposed to and provide a  
soft tactile sensation to the user,  
  
two intermediate inner layers of relatively long  
papermaking fibers, said intermediate layers being  
juxtaposed with said outer layers, whereby said long  
fibers impart strength to paper, and

one central inner layer of low density, high bulking fibers, wherein said fibers increase the bulk of the paper,

each of said layers being superimposed in face-to-face relationship with at least one other layer, and said central layer being juxtaposed with and separating said intermediate layers."

VIII. Upon requests made by all parties, oral proceedings before the Board of Appeal were held on 18 December 2006, as summoned under cover of the official letter dated 17 August 2006.

IX. In essence, the Appellant submitted orally and in writing the following arguments:

- The new first auxiliary request was filed in reaction to the arguments produced by the Respondents in relation to the request filed with the statement of grounds of appeal.
- It was believed that Claim 1 of the first auxiliary request corresponded to the combination of Claims 1 and 4 as granted. Nevertheless, inconsistencies, if any, could be removed by proper amendment.
- Claim 1 of the second auxiliary request corresponded to the claims as maintained by the Opposition Division, except that minor amendments have been made thereto in order to comply with Article 123(2) EPC.

- The subject-matter of Claim 1 as granted was not anticipated by the disclosure of D1 since, in contrast to the two-ply laminate disclosed in D1, the subject-matter of Claim 1 as granted concerned a layered, single-ply tissue paper. This was due to the fact that the term "layered paper" did not include a multi-ply paper laminate as was evident from D3 and D10. In addition, D1 did not disclose the second outer layer implicitly present in the multi-layer, single ply paper of Claim 1.
  
- D1 did further not disclose a four- or five-layer tissue paper as claimed in the first and second auxiliary requests.

X. The Respondents submitted the following arguments:

- The Appellant's first auxiliary request was not allowable at this stage of proceedings, in particular since the filing of this request only one month before the oral proceedings was contrary to Article 10a and b of the RPBA (Rules of Procedure of the Boards of Appeal).
  
- Further, the amendments made to the first auxiliary request were not clearly allowable. Moreover, the Respondents were taken by surprise by that request since the subject-matter claimed therein had never been discussed during opposition and appeal proceedings. Therefore, adjournment of the proceedings was requested in case this request was admitted by the Board.



- The second auxiliary request was not allowable since the amendments made therein were not occasioned by the first instance decision.
- Concerning the main request, it was submitted that the subject-matter claimed therein was not novel over the disclosure of D1.

XI. The Appellant requested that the decision under appeal be set aside and the patent be maintained on the basis of the claims as granted or in amended form on the basis of the claims according to the first or second auxiliary requests filed under cover of the letter dated 17 November 2006.

The Respondents requested that the appeal be dismissed.

## **Reasons for the Decision**

### *1. Admissibility of the auxiliary requests*

1.1 The Appellant has replaced the single request filed with the statement of grounds of appeal by the claims as granted as its main request and the amended claims filed in two new auxiliary requests under cover of the letter dated 17 November 2006, i.e. only one month before the oral proceedings.

1.2 It is apparent from points V to VII above that the auxiliary requests have been filed for the first time more than 17 months after the statement of grounds of appeal and more than 13 months after the Respondents had filed their observations with regard to the

Appellants single request presented with the statement of grounds of appeal.

- 1.3 It is the established jurisprudence of the Boards of Appeal of the EPO that the appeal procedure as laid down in Articles 108, 110 and 111 EPC is designed to ensure that the proceedings are as brief and concentrated as possible and ready for decision at the conclusion of oral proceedings, if scheduled. Therefore, amendments to the patent documents should be filed at the earliest possible moment and the Board may disregard amendments, if they are not submitted in good time prior to oral proceedings (see e.g. T 153/85, OJ EPO 1988, 1, reasons no. 2.1).

This principle is set out in the RPBA as published in the OJ EPO 2003, 89 and 2004, 541. Accordingly, Article 10a(2) RPBA stipulates that an Appellant's complete case shall be presented with the statement of grounds of appeal. In particular, an Appellant's statement of grounds of appeal shall indicate the reasons for requesting that the decision under appeal be reversed or amended.

It is appropriate to observe that amendments made to the previously filed requests made at a late stage of the proceedings may be admissible, if they are justified in the particular circumstances of the case. However, this does not mean that a party is completely free as to which steps are to be taken to that end. Rather on the contrary, Article 10b(1) of the RPBA stipulates that the Board's discretion to admit amendments to a party's case should be exercised in view of, inter alia, the need for procedural economy.

In other words, late requests shall not be admitted if their admission would delay the proceedings. Such delay may, for example, be due to amendments which are not clearly allowable.

- 1.4 As to the justification of the lateness of the filing of the new requests, no reason for the lateness was given when they were filed and the only reason given at the oral proceedings was that the amendments resulted from a meeting shortly before filing the new requests where it was decided how to further proceed in reply to the Respondents' objections against the previous request.

The Board cannot however accept this argument as a justification for filing the auxiliary requests only one month before oral proceedings since internal meetings of the parties or their representatives are circumstances extraneous to the proceedings (see Case Law of the Boards of Appeal of the European Patent Office 2001, VII.D.14.2.3.c)). Furthermore, the auxiliary requests could have already been filed with the statement of grounds of appeal and since the objections made by the Respondents with regard to the Appellant's then pending single request were already known for 13 months. On the contrary, the Board holds that those conducting proceedings must plan their approach so as not to prejudice the other party(ies).

- 1.5 Concerning the first auxiliary request, the Board wishes to observe that the amendments made therein result in a totally different scope of the claimed subject-matter as compared to the former request which was limited to a paper wherein at least one second

inner layer consisted of high bulking fibers selected from a particular group.

In addition, the Board concurs with the opinion presented by the Respondents at the oral proceedings that the amendments made to Claim 1 of the first auxiliary request are not clearly allowable. Whilst the wording of Claim 1 of the first auxiliary request corresponds in essence to that of Claim 4 as granted, which was dependent on granted Claim 1, non-allowability of the new request results from the fact that the wording of granted Claim 1 was not completely transposed into the new independent claim. Thus, contrary to Claim 1 as granted, Claim 1 of first auxiliary request does not require a face-to-face relationship of the layers, a fact which is likely to broaden the scope of the claim contrary to Article 123(3) EPC. Further, the wording "layer(s) of ... fibers" used in Claim 4 as granted and in Claim 1 of the first auxiliary request might be given a different meaning by ceasing to be dependent on Claim 1 as granted where the layers were defined as "comprising ... fibers", which again is open to question under the EPC, depending on how the meaning of the claim is to be interpreted.

The Appellant's offer at the oral proceedings to remove any "inconsistencies" in Claim 1 of the first auxiliary request is not acceptable at that stage of proceedings since it would leave the Respondents' representatives in a position, where, depending on the amendments finally made, they might require time to take fresh instructions and prepare further arguments with regard to the merits of the subject-matter of the new claims.

It must be borne in mind that the present appeal is the last opportunity for the Respondents to defend their own position before the EPO. Therefore, they have good reasons to request adjournment of the proceedings should the first auxiliary request be admitted by the Board.

The Appellants argued that a delay in the proceedings was not required since the subject-matter claimed in the first auxiliary request was known to the parties as it essentially corresponded to the granted Claim 4 and since the Respondents had already presented arguments against this claim during opposition proceedings.

This argument is not convincing since, firstly, - as pointed out above - the subject-matter of Claim 1 of the first auxiliary request differs from that of granted Claim 4. Secondly, the Board concurs with the argument produced by the Respondents that observations with regard to dependent claims need not necessarily be complete as long as the main arguments are directed against patentability of the subject-matter of the independent claim(s).

- 1.6 The second auxiliary request has been filed with the intention to bring the claims maintained by the Opposition Division into accordance with the requirements of Article 123(2) EPC (see IX above).

According to the case law of the Boards of Appeal, the main purpose of appeal proceedings is to give losing parties the opportunity to challenge first-instance decisions adversely affecting them (G 9/91, OJ EPO 1993, 408, reasons no. 18). However, if the patent proprietor

is the sole appellant against an interlocutory decision by the Opposition Division to maintain the patent in amended form, neither the Board nor the non-appealing parties can challenge maintenance of the patent thus amended (G 9/92, OJ EPO 1994, 875), even if the sole appellant appealed only in respect of the maintained claims (T 856/92).

In the present case, the Board observes that the Patent Proprietor is the sole Appellant and that the interlocutory decision of the Opposition Division to maintain the patent in amended form implies that the Opposition Division considered that the claims as maintained actually meet the requirements of the EPC, hence, also those of Article 123(2).

The amendments made to the second auxiliary request cannot, therefore, be considered to be occasioned either by appeals by the Opponents or by the first instance decision, the latter since the Appellant is not adversely affected under Article 107 EPC as far as the maintained claims are concerned.

1.7 The Board, therefore, concludes that the new auxiliary requests are not admissible.

2. *Main request*

2.1 Lack of novelty of the subject-matter of Claim 1 was challenged by the Respondents and in the contested decision in the light of the disclosure of D1, in particular in the light of the embodiments disclosed in Figures 38 and 39 as described in column 20.

D1 thus discloses in column 20 three alternate embodiments which are shown in Figures 37 to 39.

There is no question that Figure 37, showing a structure of three layers in face-to-face superposition wherein a long fibered, high strength middle layer is sandwiched between two short fibered, soft outer layers (column 20, lines 41 to 49), is not appropriate as anticipation since it lacks the claimed second inner layer of high bulking fibers.

A layer of high bulking fibers is, however, present in the three-layer structure shown in Figure 38 consisting of a soft top layer (71) of short fibers, followed by a strong layer (75) of long fibers, which again is followed by a bottom layer (221) having a textured outer surface (222), preferably textured in the manner disclosed in D13 (see D1, column 20, lines 50 to 62 and Figure 1 and corresponding description). As D13 is said to be incorporated in the disclosure of D1 by reference and since the method disclosed in D13 results in a paper which is not only textured but also relatively highly bulked (D1, column 20, lines 59 to 62 and column 3, lines 46 to 60, D13, abstract), Figure 38 discloses a tissue paper consisting of three sequential layers in face-to-face relationship to each other, which corresponds to the outer layer, first inner layer and second inner layer of Claim 1, whereby the outer layer is exposed to the user.

Finally, Figure 39 shows a 2-ply tissue paper comprising two plies of the alternate paper shown in Figure 38 which have been combined in texture-side to texture-side relationship so that both outer surfaces

of the product are soft, smooth and velutinous (column 20, lines 63 to 68).

Consequently, Figure 39 discloses a layered tissue paper comprising one outer layer, one first inner layer and one second inner layer in accordance with Claim 1 and, in a second ply, further inner layers (221, 75) and a second outer layer (71).

In the Respondents' opinion, the paper shown in Figure 39 of D1 corresponds, therefore, to the paper of Claim 1 as described in paragraph [0050] of the patent in suit.

2.2 The Appellant essentially argued that Claim 1 implicitly postulated a second outer layer of any material useful as outer layer of a layered tissue paper. Therefore, the subject-matter of Claim 1 was not anticipated by the three-layered paper shown in Figure 38 of D1.

This definition also applied to the plies of the 2-ply structure disclosed in paragraph [0050] of the patent in suit. Insofar, the plies disclosed in paragraph [0050] differed from the paper of Figure 38 of D1.

By referring to D3 (column 12, lines 47 to 53) and D10 (column 6, lines 11 to 14), the Appellant in particular argued that in the relevant technical field of tissue papers the term "layered paper" indicated a single ply structure. The Appellant, thus, concluded that unlike the two-ply structure shown in Figure 39 of D1, the claimed paper was a single-ply multi-layer paper.



2.3 The Board agrees with the Appellant insofar as Claim 1 may implicitly relate to a paper having two outer layers and, therefore, at least four layers in total.

However, the Board does not see any reason to conclude that both outer layers belong to the same ply.

Concerning the Appellant's reference to D3 and D10, the Board observed during the oral proceedings that the citations quoted therefrom (D3, column 12, lines 47 to 53 and D10, column 6, lines 11 to 17) define a ply as a single- or multi-layered tissue paper **web**. Such webs are produced from one or more aqueous paper making furnishes on an endless foraminous wire of a paper machine (D3, column 11, lines 62 to 67; D10, column 5, line 65 to column 6, line 4) and may, thus, be considered as separate plies.

In contrast, the subject-matter of Claim 1 is not referred to as a paper web but as a "layered tissue paper" which, in the Board's opinion also extends to layered paper products which according to D3 and D10 may consist of more than one layered plies or webs (D3, column 11, lines 54 to 55, D10, column 6, lines 11 to 14).

This is corroborated by the fact that in paragraph [0050] of the patent in suit a 2-ply structure containing several layers is referred to as a "two ply paper".

This paper is made by combining two identical papers, each having one outer layer (240) of relatively short fibers and intermediate layers (24IN). The combination

is carried out so that both outwardly facing surfaces of the 2-ply paper comprise the relatively short fibers which impart softness to the user.

Concerning the intermediate layers (24IN), paragraph [0050] refers to the preceding description ("as set forth above") where it is said in paragraph [0049] that the paper may have two intermediate layers 24IN, one inner layer of bulking fibers and one inner layer of longer fibers for strength. There is nothing in paragraphs [0049] and [0050] suggesting that the two separate plies of the 2-ply paper necessarily contain a further layer as a second outer layer before they are combined. Hence, before combining, the "second outer layer" of the two separate plies may be represented by one of the two layers 24IN which actually form intermediate layers after combination of the plies.

Therefore, the 2-ply paper disclosed in paragraph [0050] of the patent in suit covers a 2-ply structure wherein - in accordance with the wording of Claim 1 as well as with the paper illustrated in Figure 39 of D1 - two layers of relatively long fibers and two layers of bulking fibers are sandwiched between two outer layers of relatively short fibers.

Also the other parts of the description of the patent in suit do not suggest that the term "layered paper" in Claim 1 solely refers to single webs or plies as obtained from the foraminous wire.

The Board, therefore, concludes that the subject-matter of Claim 1 also covers a layered tissue paper having

e.g. two plies. This paper is, however, anticipated by Figure 39 of D1 as is set out above under point 2.1.

Consequently, the subject-matter of Claim 1 of the main request does not fulfil the requirements of Articles 52(1) and 54 EPC.

## **Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:

G. Rauh

P.-P. Bracke