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**Datasheet for the decision
of 19 September 2006**

Case Number: T 0487/05 - 3.2.06

Application Number: 96945020.4

Publication Number: 0939609

IPC: A61F 13/20

Language of the proceedings: EN

Title of invention:

Tampon having improved early expansion characteristics

Patentee:

McNEILL-PPC, INC.

Opponents:

The Procter & Gamble Company
Kimberly-Clark Worldwide, Inc.

Headword:

-

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

"Amendments in late-filed claims not overcoming the objections raised - request not admitted into the proceedings"

Decisions cited:

T 0343/90, T 0095/83, T 0153/85, T 0406/86, T 0295/87,
T 0381/87, T 0831/92

Catchword:

-



Case Number: T 0487/05 - 3.2.06

D E C I S I O N
of the Technical Board of Appeal 3.2.06
of 19 September 2006

Appellant: McNEILL-PPC, INC.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 4 March 2005
revoking European patent No. 0939609 pursuant
to Article 102(1) EPC.

Composition of the Board:

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

Summary of Facts and Submissions

- I. European Patent No. 0 939 609, granted on application No. 96945020.4, was revoked by the opposition division by decision posted on 4 March 2005. The revocation was based on the finding that although the patent in suit was disclosed in a manner sufficiently clear and complete for it to be carried out by a skilled person (Article 100(b) EPC), and the subject-matter of claim 1 of the main request was novel over the disclosure in D1 WO-A-89/01062 or D12 EP-A-0 301 874, it did not involve an inventive step with regard to the combination of teachings of D1 or D12 with those of D2 EP-A-0 611 562. The subject-matter of claim 1 of the first to fourth auxiliary requests did not involve an inventive step for the same reasons. The fifth auxiliary request, filed at the end of the oral proceedings, had not been admitted into the proceedings because the subject-matter of its claim 1 comprised features taken from the description and at such a late stage of the proceedings the filing of such a request constituted an abuse of the proceedings.
- II. The Appellant (patent proprietor) filed a notice of appeal against this decision on 19 April 2005 and simultaneously paid the appeal fee. On 14 July 2005 the statement of grounds of appeal was filed, accompanied by new sets of claims as main request and auxiliary requests I to III.

With letter of 30 November 2005, Respondent I replied to the statement of grounds of appeal and filed
D14 Extract from "Strictly Female" by C.A. Rinzler and
D15 US-A-2 710 007.

III. In a communication dated 3 May 2006, the Board indicated that there was no support to be found for the ranges of the fibre composition claimed in claim 1 of the main request and of auxiliary request II. Furthermore it was noted that on the one hand test product E did not show the claimed increase of the radius, and on the other hand that all the test results of example 1 were obtained with products having undergone a specific manufacturing process which *inter alia* involved certain fibre characteristics. Therefore, when claiming one specific fibre characteristic, this would represent a non-disclosed generalisation of example 1, inconsistent with the requirements of Article 123(2) EPC. With respect to sufficiency of disclosure, the Board noted that the use of the term "for at least 24h" for defining the preconditioning time of the tampon involved periods longer than 24 h as well which would render doubtful whether a reliable and reproducible determination of the feature relating to the increase in radius was possible. The Board also stated, that the provision of a formally acceptable set of claims would be a precondition for the discussion of whether the patent could be maintained in amended form in view of the further requirements of the EPC.

IV. In reply the Appellant filed with letter of 18 August 2006 amended sets of claims in the form of a main request and twelve auxiliary requests together with

D 16 Memorandum on proposed tariff legislation of the 108th congress

D 17 selected EDANA website pages

D 18 EDANA/INDA Standard Test WSP 10.1 (05)

D 19 EDANA/INDA Guidance Document WSP 3.0 (05)

and requested non-admittance of D14 and D15 as being late filed.

V. With letter of 5 September 2006 Respondent I requested to refuse the admittance of these late-filed claims and documents. He argued that the new sets of claims raised issues which were never considered by the Opposition Division, and which were not foreshadowed in the proprietor's statement setting out the grounds of appeal and although in the description of the patent in suit, example 1, test product C and D disclosed the claimed values as individual values, the generalisation of these individual values to a range had not been originally disclosed. D16 to D18 did not constitute prior art and were irrelevant for the issues at stake.

VI. Oral proceedings were held on 19 September 2006, at which Respondent II was not represented as announced by letter of 2 June 2006.

In his introductory statement the Chairman informed the parties that first it had to be discussed whether the late filed sets of claims should be admitted into the proceedings. Since objections concerning extension of subject-matter (Article 123(2) EPC) and the requirements of Article 84 EPC had already been submitted in writing the claims should at least overcome these objections. Furthermore, it appeared that a number of the newly introduced features gave

rise to objections particularly under Article 123(2) EPC.

The Appellant requested eventually that the decision under appeal be set aside and that the patent be maintained on the basis of one of the requests (main request and auxiliary requests I to XII) filed on 18 August 2006, with the proviso, that in all requests "decitex" before "3.3" or "3.6" should be replaced by "denier".

Respondent I maintained his requests that none of the appellant's requests be admitted into the proceedings and that the appeal be dismissed.

VII. Claim 1 according to the Appellant's main request reads as follows:

" A dimensionally stable tampon (10) comprising a substantially cylindrical mass of compressed fibres substantially enclosed by a fluid-permeable cover (26), the tampon (10) having a central axis, a radius and an improved stability, comprising a fibrous core (12) substantially surrounding the central axis (14), the core (12) having a first average density, and an outer annulus (16) forming a circumferential surface (18) of the tampon (10), the annulus (16) having a second average density which is less than the first average density, wherein the outer annulus comprises a plurality of ribs which extend radially from the core, and wherein each rib is separated from adjacent ribs where it is attached to the core and each rib contacts adjacent ribs proximate the circumferential surface of the tampon, and being capable of radially expanding

upon exposure to a humid environment, wherein the stability is of at least about 15 N, the radius increases by at least about 10% after 15 minutes exposure to 90 % relative humidity at 40 °C, and the fibres comprise 50 wt% to 75 wt% of regenerated cellulosic viscose rayon staple fibres having a multi-limbed cross-section having at least three limbs and a decitex of less than 5.0 and 25 wt% to 50 wt% of non-limbed regenerated cellulosic viscose rayon staple fibres having a denier of 3.6."

Claim 1 of each of the auxiliary requests I to V, IX and X, specifies the same range of the fibres i.e. 50 wt% to 75 wt% for the multi-limbed fibres and 25 wt% to 50 wt% for the non-limbed fibres.

Claim 1 of each of the auxiliary requests VI, VII, VIII, XI and XII, specifies the composition of fibres consisting of either 50 wt% to 50 wt% or 75 wt% to 25 wt% of multi-limbed to non-limbed fibres of the fibre compositions, the respective values having been taken from test products C and D of example 1.

The further amendments in claim 1 of each request are related to the manufacturing method, the denier of the multi-limbed fibres, the length-to-width ratio of the limbs of the multi-limbed fibres in various combinations and the preconditioning time of the tampon being set to 24 h exactly.

VIII. In support of its requests the Appellant essentially relied upon the following submissions:

All requests should be admitted to the proceedings. The subject-matter of their respective claims 1 was clearly derivable from and sufficiently supported by the application as originally filed.

For all requests, an explicit basis for the amendments concerning either the range of the fibres or the individual values chosen for the composition of the fibres could be found in example 1, test results C and D (Table 1), which disclosed a percentage of limbed fibres of 75 % and 50 % and of non-limbed fibres of 25 wt% and 50 wt% respectively and which formed part of the application as originally filed. Since the patent was addressed to persons skilled in the art, it was clear that the test results C and D of example 1 left no room for any other interpretation than that between these individual punctual values the claimed increase of the early expansion of a compressed tampon would be obtained and would be comparable to the one demonstrated by these two test results.

Already in T 343/90 it had been allowed to form a numerical range from viscosity values disclosed in the examples without requiring further details of the examples to be inserted into the claim. Therefore, in line with the case law it was allowable to derive a range from values taken from examples. In T 343/90 the viscosity and its range had never been the subject-matter of any claim whereas in the patent in suit dependent claim 5 as originally filed and as granted already comprised a range for the fibre composition.

The range now claimed was smaller, hence limited the scope of protection, and it was obvious for the skilled person that within the claimed range of the fibre composition the claimed increase of the radius of the tampon could be obtained.

Example 1 was based upon the use of Galaxy and Danufil fibres. However, it was not possible to introduce the trade names of the fibres into the claim. The Galaxy and Danufil fibres were now unambiguously identified via their chemical and structural nature and their decitex/denier values in claim 1. Support therefore could be found in paragraphs [0019] and [0026] of the patent in suit which wording was identical to the one on page 7, second paragraph and pages 10 to 12, example 1 in the application as filed. No further chemical and structural characterisation was necessary.

Furthermore, it was not necessary to specify the length-to-width ratio of the limbs of the multi-limbed fibres since nowhere was it shown or expected that this characteristic could influence the early expansion characteristics of the tampon. Nevertheless this ratio had been inserted in claim 1 of auxiliary requests IV, V, VII, X, XII, in order to cope with such an objection.

It was also not necessary to include further features relating to the manufacturing process, but if inserted (as in auxiliary requests I, III, V, VIII), these features were clear and unambiguous and also supported by the disclosure of example 1. The manufacturing processes according to D3 and D2 were identified in example 1 of the patent in suit as the processes which were used and the resultant tampon could be identified

as demonstrated by Figure 4 of D3 as well as by Figure 5 of D2. The structural characteristics of the tampon obtained by the claimed manufacturing processes were clearly specified by the wording of claim 1.

No further information about the cover material was necessary, a cover forming part of the test products of example 1, and such a fluid-permeable cover already being a feature of claim 1 as granted and as originally filed. There was no proof that the stability or early expansion characteristics of the tampon could be influenced by the cover material or any finish of the cover material.

The same applied with respect to the length of the staple fibres which could not influence the test results.

Hence, the requirements of Article 123(2) and 84 EPC were met.

IX. The submissions of Respondent I can be summarized as follows:

All requests of the Appellant were inadmissible because filed at a late stage of the proceedings and the subject-matter of their claims 1 was not clearly allowable for formal reasons. Concerning all requests, there was either no support in the originally filed application for the claimed subject-matter (Article 123(2) EPC) or the claimed subject-matter was not clear (Article 84 EPC). Moreover the invention claimed was not disclosed sufficiently and completely for it to be carried out (Article 83 EPC).

All requests referred either to a range of from 50 wt% to 75 wt% of multi-limbed fibres and from 25 wt% to 50 wt% of non-limbed fibres allegedly derived from the fibre composition of test products C and D of example 1 (main request and auxiliary requests I to V, IX and X), or (auxiliary requests VI, VII, VIII, XI, XII) to the respective individual values (50 wt% of multi-limbed fibres and 50 wt% of non-limbed fibres or 75 wt% of multi-limbed fibres and 25 wt% of non-limbed fibres) of the fibre compositions of test products C and D of example 1.

- With respect to the claimed ranges of the fibre composition comprising 50 wt% to 75 wt% of multi-limbed fibres and 25 wt% to 50 wt% of non-limbed fibres, such ranges were not disclosed at all. In addition, a calculation revealed that with the lower limits set now to 50 wt% of multi-limbed fibres and 25 wt% of non-limbed fibres respectively, only 75 wt% of the fibre composition are thus mandatorily defined and further unspecified fibres (25 wt%) could form part of the fibres of the tampon. Such additional fibres had never been part of the disclosure. Furthermore, the skilled person looking at the test products of example 1 would inevitably conclude that the best performing example was test product B. Therefore, any range not including test product B was an arbitrary one and hence, the choice of such a range was not allowable.

- With respect to the individual values (either 50 wt% of multi-limbed fibres and 50 wt% of non-limbed fibres or 75 wt% of multi-limbed fibres and 25 wt% of non-limbed fibres) of the fibre composition present in

test products C and D of example 1 (auxiliary requests VI, VII, VIII, XI, XII), these values were only disclosed in combination with all other features of these test products C and D. However, not all further features were inserted into claim 1 of any of these requests. Therefore, these requests were also not allowable by reason of the unacceptable generalisation of the disclosed examples and thus added subject-matter.

All requests referred either to a specific range for the decitex of the multi-limbed fibres or to a specific denier value for the multi-limbed and the non-limbed fibres. However, only in relation to the Galaxy fibres a decitex limitation of 5.0 was disclosed, whereas the claims were not limited to Galaxy fibres. The limitation to a value of 3.3 denier and 3.6 denier was related in the description only to Galaxy or Danufil fibres, respectively. The use of the trademark names Galaxy and Danufil was not possible in the claims and already for this reason, it was virtually impossible to arrive at an allowable claim. The Galaxy and Danufil fibres applied in Example 1 were commercially available fibres which existed in a variety of deniers or other forms. It was not even clear whether they would still have the same properties since what was sold under this trade name could very well have changed over the years.

Claim 1 of all requests referred to the cylindrical mass of compressed fibres being substantially enclosed by a fluid-permeable cover without further defining the cover. The influence of the fluid-permeable cover upon the early expansion characteristics was not demonstrated in the patent in suit and moreover it was not even clear which kind of cover formed part of the

experimental test products. Even the information that the cover was manufactured according to the process of Friese, US-A-4,816,100, did not suffice to enable the skilled person to manufacture identical tampons, since in this document a great number of possibilities with regard to the material of the cover were given. It had to be considered that with respect to early expansion behaviour, the use of a non-woven cover, an apertured film as cover material and the possible use of a hydrophobic finish as well as its nature could have substantial influence upon the results.

With respect to claim 1 of all requests, but particularly with respect to those requests whose claims 1 comprise the process feature (auxiliary requests I, III, V, VIII), it had to be noted that example 2 already demonstrated that for the fibre composition of test product C the manufacturing process could have considerable influence since the folded product (Example F) only slightly surpassed the claimed early expansion characteristic of an increase of the radius by at least about 10%, whereas with, the rolled and cut products (Examples G and H) the claimed result could be obtained without difficulty. Therefore, further processing or other characteristics clearly influenced the result. The manufacturing processes according to D2 or D3 used for the test products of example 1 referred to two alternative processes and already involved a lot of choices and possibilities, but did not allow clear identification of the resultant tampons. Hence, the skilled person did not have sufficient information as to how to obtain the claimed tampons.

Concerning auxiliary requests I - III, VI, VIII, IX, XI, the structural characterisation of the fibres with respect to the limbs was not clear. It was absolutely necessary to define the length-to-width ratio of each limb since it was not shown that any other ratio as specified for example 1 would result in similar early expansion behaviour of the tampon.

T 343/90 relied upon by the Appellant did not provide a general justification for introducing values of a parameter which was found only in examples. It stated explicitly that the importance of the viscosity in the context of the invention was clear from the description. This apparent importance of the viscosity and its range allowed to be introduced in T 343/90 was not comparable to the importance of the fibre composition and its range in the patent in suit:

- Contrary to T 343/90 where all viscosity values demonstrated in the examples were included in the claimed range (the lowest viscosity value and the highest viscosity value demonstrated by the examples were chosen as the lower and the upper limit of the viscosity range), in the present requests the fibre composition shown in test product B performed best, but was not included into the range claimed.

- Contrary to T 343/90, where numerous examples were given, all of whose values supported the claimed range, here only two individual test products were shown.

- Again contrary to T 343/90, there was no further combination of features each showing on their own that the fibre composition/blend was an important factor. On

the contrary, test product B demonstrated that a tampon made from Galaxy fibres only (100 wt%) performed best. According to page 4, lines 7 to 10 of the patent in suit, the requirements as to the nature of the fibres were stated as being quite low.

Hence, obviously neither the requirements of Article 123(2) EPC nor those of Article 84 EPC were met and the claims were clearly not allowable. Further, since the requests were late-filed they should not be admitted into the proceedings.

Reasons for the Decision

1. The appeal is admissible.
2. Admissibility of the requests filed with letter of 18 August 2006
 - 2.1 The Opposition division already decided not to admit auxiliary request V, its claim 1 comprising the modified range of the fibre composition, because it was not considered a formally unambiguously and clearly allowable request. In its communication attached to the summons to oral proceedings, the Board had already drawn attention to the fact, that the ranges of the fibre composition introduced in the main request and auxiliary requests II and III then on file, lacked support in the original application (Article 123(2)EPC). Nevertheless, one month before the oral proceedings the Appellant submitted a new main request together with twelve auxiliary requests and claim 1 of all these requests comprised either ranges of the fibre

composition without support and arbitrarily defined or individual values of the fibre composition derivable from example 1 but without inserting all relevant features of the test products concerned.

- 2.2 In accordance with Article 10b of the Rules of Procedure of the Boards of Appeal (OJ EPO 3/2003, pages 89 to 98) any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the Board's discretion. Amended requests can be admitted in appeal proceedings if they are serious attempts to overcome objections, or if their late filing can be justified and the Board can see *prima facie* that they are admissible (T 95/83 OJ 1985,75; T 153/85, OJ 1988,1; T 406/86, OJ 1989,203; T 295/87, OJ 1990,470; T 381/87, OJ 1990,213; T 831/92).

- 2.3 In the present requests, no such serious attempts to overcome the objections raised by Respondent I and the Board can be recognized.

Claim 1 of all the requests is based upon claim 1 as originally filed. With respect to the amendments, the alleged basis in the application as originally filed for the range of fibre composition as well as for the individual values chosen alternatively, is given by table 1 of example 1, test products C and D, and by table 2, test products F, G and H which, however, relate to two particular embodiments comprising a particular fibre composition of Galaxy fibres and Danufil fibres of a certain denier and to a specific manufacturing process for the tampons including a cover.

2.4 The late filed requests comprising the ranges of fibre compositions allegedly taken from test products C and D of example 1 (main request and auxiliary requests I to V, IX and X) are clearly not allowable for the following reasons and, therefore, were not admitted into the proceedings.

2.4.1 Claim 1 of these requests incorporates a range of fibres (50 wt% to 75 wt% of multi-limbed fibres and 25 wt% to 50 wt% of non-limbed fibres), the upper and lower limit of the range being chosen respectively from the two individual values of test products C and D of example 1. No such range has been disclosed as such in the original application. The two values taken from test products C and D can only be considered as representing individual punctual specific values of these products. The arguments set out by the Appellant with respect to T 343/90, namely that it would be possible to create a new range from given examples, do not apply here. Therefore, the Board is of the view that the two values of test products C and D of example 1 cannot be generalised to such an arbitrarily chosen range and the requirements of Article 123(2) EPC are not met.

2.4.2 Furthermore, the range now claimed does not necessarily cover 100 wt% of the fibres (taking the lower limits of both fibres only results in 75 wt% of fibres) and thus implicitly allows the use of further fibres which possibility lacks any basis in the application as filed. This amounts to a further violation of the requirements of Article 123(2) EPC.

- 2.4.3 Moreover, there is no support in the examples for the conclusion that such percentages in the more general definition of the claimed range of fibres will lead to the claimed result concerning the increased radius.
- 2.5 Requests referring to the individual values of test products C and D of example 1 as alternatives (auxiliary requests VI, VII, VIII, XI, XII):
- 2.5.1 The claims according to all of these requests incorporate two individual, specific features concerning the percentage of fibre compositions taken from test products C and D of example 1. These test products C and D represent two specific combinations of Galaxy and Danufil-fibres manufactured via one of two manufacturing processes disclosed for example 1 including a cover for the tampon. Particularly with respect to the manufacturing method, example 1 does not disclose which one of the two manufacturing processes (according to D2 or D3) exactly has been used. The disclosed two processes differ with respect to the pressing equipment used, leave a lot of other choices open and there is no disclosure whether the tampons alternatively obtained can be compared with respect to their characteristics. The outer appearance of the tampons may be quite similar, however this is no reason to believe that all the characteristics of the tampons are similar or even the same. Hence, it is not clear which manufacturing method has to be followed in order to obtain the tampons claimed.
- 2.5.2 With respect to the cover of the tampon, the general disclosure in example 1 to use nonwoven fabrics or apertured films as cover materials (paragraph [0025])

in a manufacturing process according to Friese, US-A-4,816,100, offers a variety of choices for the cover in example 1. With respect to early expansion behaviour the material applied for the cover will inevitably influence the claimed result of increase in radius. Therefore, it is also neither clear which cover material has been used for obtaining the results of tables 1 and 2 nor which cover material is to be used in order to obtain the tampons claimed.

2.5.3 As to the structure and nature of the Galaxy and Danufil fibres, it is not clear whether other regenerated cellulosic viscose rayon staple fibres in the same composition and denier, but for example differing in staple length, would lead to the claimed increase in radius. Since no staple length is given for the fibres used in example 1, the skilled person cannot know how to obtain the tampons claimed in a consistent manner.

2.5.4 Hence, the subject-matter of claim 1 of these requests has been amended without the insertion of all the characteristics and manufacturing details of these test products C and D and there remains at least considerable doubt whether the skilled person can clearly and reliably obtain the tampon claimed according to claim 1 and thus carry out the invention (Article 83 EPC). Hence, these late-filed alternative claims were not admitted.

2.6 In view of the above negative conclusions regarding the criteria of allowability, the Board decided not to admit into the proceedings any of the late filed claims submitted as main request and as auxiliary requests I

to XII. None of the requests of the patent proprietor being admissible, there is no basis for further substantive discussion.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Patin

P. Alting van Geusau