

Internal distribution code:

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

**Datasheet for the decision
of 28 September 2006**

Case Number: T 0506/05 - 3.2.06
Application Number: 99921606.2
Publication Number: 1075246
IPC: A61F 13/15
Language of the proceedings: EN

Title of invention:

Absorbent article and absorbent interlabial device with
substance thereon for maintaining the article and device in
position

Patentee:

THE PROCTER & GAMBLE COMPANY

Opponents:

SCA Hygiene Products AB
Kimberly-Clark Worldwide, Inc.

Headword:

-

Relevant legal provisions:

EPC Art. 54, 83, 84, 123(2)

Keyword:

"Main request and auxiliary request I: novelty (no)"
"Auxiliary request II: late-filed - not admitted"
"Auxiliary request III: disclosure (not enabling)"

Decisions cited:

-

Catchword:

-



Case Number: T 0506/05 - 3.2.06

D E C I S I O N
of the Technical Board of Appeal 3.2.06
of 28 September 2006

Appellant:
(Patent Proprietor)

THE PROCTER & GAMBLE COMPANY
One Procter & Gamble Plaza
Cincinnati, OH 45202 (US)

Representative:

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

Respondent I:
(Opponent OI)

SCA Hygiene Products AB
S-405 03 Göteborg (SE)

Representative:

Furlong, Christopher Heinrich
Hoffman Eitle,
Patent- und Rechtsanwälte
Arabellastraße 4
D-81925 München (DE)

Respondent II:
(Opponent OII)

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

Representative:

Beacham, Annabel Rose
Frank B. Dehn & Co.
St Bride's House
10 Salisbury Square
London EC4Y 8JD (GB)

Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted 17 February 2005
revoking European patent No. 1075246 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I. European Patent No. 1 075 246, granted on application No. 99921606.2, was revoked by the opposition division by decision posted on 17 February 2005. The revocation was based on the finding that the invention was sufficiently disclosed, but that the subject-matter of claim 1 of the main request was not novel over the disclosure in either

D1 WO-A-98/57609 or

D2 WO-A-98/08475.

The subject-matter of claim 1 of the first auxiliary request was considered to meet the requirements of Articles 84 and 123(2) EPC, however it was not considered novel over the disclosure in

D7 EP-A-0 692 263.

II. The Appellant (patent proprietor) filed a notice of appeal against this decision on 18 April 2005, and paid the appeal fee simultaneously. On 27 June 2005 the statement of grounds of appeal was filed with a request to maintain the patent as granted.

III. With a communication dated 20 June 2006, accompanying the summons to oral proceedings, the Board set out its preliminary opinion in which it endorsed the finding of the opposition division, in particular that D1 disclosed the features contested by the Appellant relating to the non-adhesive substance on the body-contacting surface of the topsheet. Therefore, the subject-matter of claim 1 as granted appeared to lack novelty. With respect to sufficiency of disclosure the

Board raised doubts regarding the manner and extent, if at all, any assistance as to keeping the absorbent article in place was actually provided by the non-adhesive substance as claimed.

Oral proceedings were held on 28 September 2006. In his introductory statement the Chairman informed the parties present at the oral proceedings, that the Board was of the preliminary opinion that the subject-matter of claim 1 of the new main request and of auxiliary request I lacked novelty over

D4 WO-A-98/55159.

Particularly pages 13, 19, 23 and 27 of D4 were referred to. D4 had already been cited in the statement of grounds of the opposition as novelty-destroying for claim 1 as granted and was also referred to by the Appellant in his letter dated 27 June 2005. After a break to give the Appellant additional time to prepare his arguments in view of this preliminary opinion, the Appellant filed an auxiliary request II. After discussion on novelty of the main request and auxiliary request I, and the finding by the Board that claim 1 of both requests lacked novelty over D4, the admissibility of auxiliary request II was discussed. Subsequently to auxiliary request II not being admitted into the proceedings, the Appellant filed an auxiliary request III. The Board admitted this request into the proceedings. The Appellant as well as Respondent I requested to proceed further with this request in order not to delay the proceedings.

IV. The Appellant eventually requested to set aside the decision under appeal and to maintain the patent on the basis of the claims filed as main and first auxiliary requests with letter dated 28 July 2006, or on the basis of the claims filed as second and third auxiliary request during the oral proceedings.

Respondent I (opponent OI) requested that the appeal be dismissed.

Respondent II (opponent OII) who had announced that he would not be represented at the oral proceedings had requested with letter of 26 September 2006 to remit the case to the first instance if any set of claims was found novel by the Board.

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

"An absorbent device (20) insertable into the interlabial space of a female wearer, said absorbent device (20) having at least one body-contacting surface (20A), said absorbent device (20) characterized in that it comprises a non-adhesive substance, having no initial tack, on said body-contacting surface (20A) wherein said non-adhesive substance contacts the inside surfaces of the wearer's labia minora, the wearer's labia majora, or both the labia minora and labia majora, to assist the interlabial device (20) in staying in place in the desired position in the interlabial space, wherein said non-adhesive substance is selected from the group consisting of: waxes, fatty alcohols, fatty acids, petroleum jelly, and sealing ointments."

Claim 1 according to the first auxiliary request differs from claim 1 according to the main request in that the non-adhesive substance comprises a moisture-activated substance selected from the group consisting of: sodium carboxymethylcellulose, polyethylene glycols, glycols, polyols, ethoxylated alcohols, and sugars.

Claim 1 according to the second auxiliary request differs from claim 1 according to the first auxiliary request in that the non-adhesive substance comprises a moisture-activated substance selected from sodium carboxymethylcellulose.

Claim 1 according to the third auxiliary request differs from claim 1 according to the first auxiliary request in that the non-adhesive substance comprises a moisture-activated substance which comprises a mixture of sodium carboxymethylcellulose, polyethylene oxide, and water.

VI. The Appellant essentially argued as follows:

The subject-matter of claim 1 of the main request and of auxiliary request I was novel over D4. The substances specified in D4 were neither to be considered as non-adhesive substances having no initial tack nor as moisture-activated substances. D4 did not aim at the same purpose. D4 provided an interlabial device which could be inserted with less friction and thus was not related to the "assistance in staying in place" as the patent in suit.

Auxiliary request II should be admitted into the proceedings. It was a direct response to the previous

novelty discussion with respect to claim 1 of auxiliary request I. D4 did not disclose sodium carboxymethyl-cellulose and therefore, this request overcame the novelty objection submitted with respect to auxiliary request I. The limitation to sodium carboxymethyl-cellulose as the only moisture-activated substance represented a limitation within the group disclosed in claim 6 as granted. None of the other cited documents disclosed this substance and sodium carboxymethyl-cellulose represented an inventive alternative component when starting from D4 and solving the problem of finding another moisture-activated substance.

The subject-matter of claim 1 of auxiliary request III combined the subject-matter of granted claims 1, 4 and 7 corresponding to originally filed claims 1, 2, 5, and 8. Such a combination had always been part of the patent in suit and hence, it could not give raise to formal objections with regard to Articles 123(2) EPC or 84 EPC. This request was filed in direct response to the discussion of auxiliary request II and hence, it was admissible. Its subject-matter was sufficiently disclosed and supported in the description particularly by paragraph [0076] of the patent in suit. The subject-matter of its claim 1 was novel and involved an inventive step. The fact that the subject-matter of claim 1 of auxiliary request III was not sufficiently clear was not relevant for this combination of granted claims. Concerning possible sufficiency issues, the skilled person clearly recognized that an intermediate product was claimed and that the device was to be inserted only after drying. The skilled person knew that such a drying step had to be performed before the device could be used since sodium carboxymethyl-

cellulose represented a tacky substance when in contact with water. Therefore, the requirements of Article 83 EPC were met. No document disclosed the claimed combination of features and thus the subject-matter of claim 1 was novel. It also involved an inventive step because the closest prior art was represented by D4 and D4 referred to a completely different problem. Since no document taught such a preferred combination of moisture-activated substances, the subject-matter of claim 1 necessarily involved an inventive step.

VII. Respondent I argued essentially as follows:

D4 disclosed the combination of features claimed in claim 1 of the main request and of the auxiliary request I. The disclosure on page 19, third paragraph of D4 could only be interpreted such that all emollients which were present on the flexible extensions represented a non-adhesive substance because of the explicit option of providing an adhesive. On page 22, third paragraph of D4, the composition of the emollient was specified as comprising (1) an emollient, (2) an immobilizing agent for the emollient; (3) optionally a hydrophilic surfactant and (4) other optional components. Suitable emollients were specified as being petroleum based, fatty alcohol type and on page 27, it was set out that "Besides petroleum-based emollients..., the emollients ... can include minor amounts of other, conventional emollients/solvents ... include ... propylene glycol, polyethylene glycol, ..., fatty acids, ..., propoxylated fatty alcohols, glycerides," Hence, it was clear that a combination of a petroleum based emollient could include such compositions. No selection was to be

performed because each composition was mentioned on its own. Hence, D4 referred to an absorbent device comprising a non-adhesive substance (the emollient based on petroleum) in combination with a glycol or polyethylene glycol. Therefore, the subject-matter of claim 1 of the main request and also that of the first auxiliary request was not novel.

Auxiliary request II should not be admitted into the proceedings. The subject-matter of its claim 1 with respect to the moisture-activated substance represented an arbitrary selection out of the group claimed in claim 6 as granted, without any proof that a special effect was linked to this selection and it was nowhere shown which inventive activity could be linked to such a selection. There also remained doubts on sufficiency of disclosure with respect to all requests. In view of the request being late filed and not clearly allowable, it should not be admitted.

The subject-matter of claim 1 of auxiliary request III comprised inconsistent subject-matter. The degree of inconsistency was so substantial that it even amounted to insufficiency of disclosure. The skilled person did not know which device was defined by the claim. Either the absorbent device comprised a moisture-activated substance and in use this substance should assist the device in staying in place so that activation by moisture was necessary, or the absorbent device also comprised water together with the moisture activated substance, in which case the question arose how and when a moisture activation should take place and, in view of the examples disclosed, whether it was possible that the non-adhesive substance could have no initial

tack. Given such severe contradictions, no clear and complete teaching was present and sufficient information on the subject-matter for which protection was sought was not available. Therefore, this request did not meet the requirements of Article 83 EPC.

Reasons for the Decision

1. The appeal is admissible.

2. Main Request

Claim 1 according to the main request includes the subject-matter of granted claims 1 and 2 corresponding to originally filed claims 1, 2 and 3 with the non-adhesive substance being selected from the group of surfactants being deleted. Consequently, the subject-matter of claim 1 does not give rise to objections under Article 84 EPC or Article 123(2) and (3) EPC.

D4 represents the closest prior art. It discloses an absorbent interlabial device (title, Figures 1 to 4) with at least one body-contacting surface (20A, Figures 1 to 4), said device comprising an emollient composition (claims 1, 4) having no initial tack (page 19, third paragraph), wherein said emollient composition contacts the inside surfaces of the wearer's labia minora, the wearer's labia majora, or both (page 19, third paragraph) to assist the interlabial device in staying in place in the desired position in the interlabial space (page 12, fourth paragraph), wherein said emollient can be petroleum-based hydrocarbons (mineral wax, petroleum jelly,

page 23, last paragraph), fatty alcohol type (page 23, last paragraph), and can include minor amounts of glycols, waxes, fatty acids (page 27, first paragraph).

These features are identical to those of claim 1 and, as a consequence, its subject-matter is not novel.

The Appellant's argument that D4 referred to another problem, which was related to the insertion with less friction, is not valid for deciding on novelty, in that this decision has to be based exclusively on the presence of identical features. The further argument that the substances specified in D4 were neither to be considered as non-adhesive substances having no initial tack nor as moisture-activated substances is not convincing either, since the same substances are mentioned in claim 1. Of particular relevance in this context is page 19, third paragraph of D4 which refers to an adhesive being optionally present. It is to be understood from this reference that usually the emollient should not be adhesive, otherwise an additional adhesive would not be necessary.

3. Auxiliary request I

The subject-matter of claim 1 of auxiliary request I includes the subject-matter of granted claims 1, 4 and 6 corresponding to originally filed claims 1, 2, 5 and 7. Consequently, the subject-matter of claim 1 does not give rise to objections under Article 123(2) EPC.

In addition to the subject-matter discussed for the main request above, D4, page 27, first paragraph discloses the now additionally claimed moisture-

activated substances, particularly glycols and polyethylene glycol. D4, page 22, third paragraph refers to such compositions as preferred emollient compositions. Hence, the disclosure of D4 included the teaching to select such compositions as ingredients of the emollient. Hence, the subject-matter of this claim 1 is also not new (Article 54 EPC).

4. Auxiliary request II

The subject-matter of claim 1 of auxiliary request II differs from the subject-matter of claim 1 of auxiliary request I in that from the group of moisture-activated substances which is claimed in the latter request, only sodium carboxymethylcellulose has been selected and the other substances have been deleted. However, there is no disclosure anywhere in the patent in suit or apparent to the skilled person that sodium carboxymethylcellulose has any special property for the specific use when compared to the deleted compositions. The selection is therefore totally arbitrary and cannot support an inventive step. This late-filed request thus not being clearly allowable, in accordance with the case law of the Boards of Appeal it was not admitted into the proceedings.

5. Auxiliary request III

5.1 The subject-matter of claim 1 of auxiliary request III combines the subject-matter of granted claims 1, 4 and 7 corresponding to originally filed claims 1, 2, 5, and 8. In the (unamended) description, paragraph [0076] of the patent in suit discloses the claimed mixture of sodium carboxymethylcellulose, polyethylene oxide and

water as a particularly preferred moisture-activated substance. Thus, the claim is supported by the description, it represents a limitation of the granted subject-matter and this mixture is not arbitrarily selected. Furthermore, the combination of the subject-matter of granted claims cannot be surprising and no abuse of the proceedings can be identified. For these reasons this request, although late-filed, was admitted into the proceedings.

- 5.2 The features of this claim 1 refer to an absorbent device comprising a non-adhesive substance, having no initial tack; the non-adhesive substance is further specified as comprising a moisture-activated substance which comprises a mixture of sodium carboxymethylcellulose, polyethylene oxide, and water.

This preferred mixture comprises, according to the (unamended) description, paragraph [0076], 1.75 g sodium carboxymethylcellulose, 0.25 g polyethylene oxide and 125 ml distilled water. Considering particularly the high amount of water, the claimed features are contradictory: A moisture-activated substance like sodium carboxymethylcellulose which is present together with such a high amount of water is already "activated" and cannot at the same time represent a non-adhesive substance having no initial tack.

The Appellant's allegation that an intermediate product is claimed and that, therefore, the device is used only after drying to become non-adhesive, is neither derivable from the description nor from the features of this claim. It is also pointed out that the claim only

requires the non-adhesive substance to comprise the moisture-activated substance which in turn, comprise a mixture of sodium carboxymethylcellulose, polyethylene and water. Therefore, other constituents for achieving non-adhesivity can be present and there is a great number of them. As to them, no information is given to help the skilled person in carrying out the invention as claimed over the entire scope of protection sought.

5.3 For these reasons, the invention as claimed according to auxiliary request III is not disclosed in a manner sufficiently clear and complete for it to be carried out and thus the requirement of Article 83 EPC is not met.

6. In conclusion, none of the Appellant's requests admitted into the proceedings meets the relevant requirements of the Convention. This means also, that the request of Respondent II to remit the case to the first instance has become obsolete.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Patin

P. Alting van Geusau