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**Datasheet for the decision
of 22 February 2007**

Case Number: T 0544/05 - 3.3.10

Application Number: 97949745.0

Publication Number: 0971750

IPC: A61L 15/34

Language of the proceedings: EN

Title of invention:

Absorbent articles having lotioned leg cuffs

Patentee:

THE PROCTER & GAMBLE COMPANY

Opponent:

SCA Hygiene Products AB

Headword:

Absorbent articles with lotioned leg cuffs/PROCTER & GAMBLE

Relevant legal provisions:

EPC Art. 54(3)(4), 56, 84, 123(2)

Keyword:

"Main request and auxiliary request 2: "novelty (yes) - no direct and unambiguous disclosure; inventive step (no) - obvious solution"

"Auxiliary request 1: amendments (not allowable) - disclaimer based on non-novelty destroying disclosure"

"Auxiliary requests 3 and 4 (not admitted): late-filed - not clearly allowable - added subject-matter - lack of clarity"

Decisions cited:

G 0009/91, G 0001/03, G 0002/03, T 0301/87, T 0092/93,
T 0859/94, T 0401/95, T 0420/00

Catchword:

-



Case Number: T 0544/05 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 22 February 2007

Appellant: SCA Hygiene Products AB
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
8 March 2005 concerning maintenance of European
patent No. 0971750 in amended form.

Composition of the Board:

Chairman: R. Freimuth
Members: J. Mercey
J. Seitz

Summary of Facts and Submissions

- I. The Appellant (Opponent) lodged an appeal on 28 April 2005 against the interlocutory decision of the Opposition Division posted 8 March 2005 which found that European patent No. 971 750 in amended form met the requirements of the EPC.
- II. Notice of Opposition had been filed by the Appellant requesting revocation of the patent as granted in its entirety on the grounds of lack of novelty and lack of inventive step (Article 100(a) EPC) and of extending the subject-matter of the patent in suit beyond the content of the application as filed (Article 100(c) EPC). *Inter alia* the following documents were submitted in opposition proceedings:
- (1) WO-A-9 705 908,
 - (2) US-A-4 695 278 and
 - (4) US-A-3 896 807.
- III. The decision under appeal was based on an amended set of nineteen claims, independent claim 1 of which reading as follows:
- "1. An absorbent article having two longitudinal side edges, said absorbent article comprising:
- A) a backsheet;
 - B) a liquid pervious, topsheet joined to said backsheet;
 - C) an absorbent core positioned between said topsheet and said backsheet;
 - D) a barrier leg cuff disposed adjacent each of two said longitudinal side edges, wherein each of said barrier leg cuffs has a proximal edge affixed adjacent

to said longitudinal side edge of said absorbent article and a distal edge unsecured to at least a portion of said absorbent article, wherein each of said barrier leg cuffs has an inner surface oriented toward the interior of said absorbent article and an outer surface oriented toward the skin of the wearer when said absorbent article is being worn, wherein at least a portion of said barrier leg cuff outer surface has disposed thereon an effective amount of a lotion coating which is semi-solid or solid at 20°C and which is at least partially transferable to the wearer's skin, and

E) an elastically contractible gasketing cuff disposed adjacent each of said two longitudinal side edges of said absorbent article, said gasketing cuffs extending laterally outward from said absorbent article longitudinal side edges, wherein each of said gasketing cuffs has a front surface oriented toward the skin of the wearer when said absorbent article is being worn and a back surface opposed to said front surface, wherein at least a portion of said gasketing cuff front surface has disposed thereon an effective amount of a lotion coating which is semi-solid or solid at 20°C and which is at least partially transferable to the wearer's skin, said lotion coating disposed on said barrier leg cuff outer surface comprising:

(i) from about 10 to about 95% of a substantially water free emollient having a plastic or fluid consistency at 20°C and comprising a member selected from the group consisting of petroleum-based emollients, fatty acid ester emollients, alkyl ethoxylate emollients, and mixtures thereof; and

(ii) from about 5 to about 90% of an agent capable of immobilizing said emollient on said outer surface of

the barrier leg cuff, said immobilizing agent having a melting point of at least about 35°C, said lotion coating disposed on said gasketing cuff front surface comprising:

(i) from about 10 to about 95% of a substantially water free emollient having a plastic or fluid consistency at 20°C and comprising a member selected from the group consisting of petroleum-based emollients, fatty acid ester emollients, alkyl ethoxylate emollients, and mixtures thereof; and

(ii) from about 5 to about 90% of an agent capable of immobilizing said emollient on said front surface of said gasketing cuff, said immobilizing agent having a melting point of at least about 35°C."

The Opposition Division held that the amendments made to the claims satisfied the requirements of Article 123(2) EPC and the ground for opposition pursuant to Article 100(c) EPC was disqualified. It further held that the invention was novel over document (1), since there was no direct and unambiguous disclosure in this document of a diaper having both gasketing and barrier leg cuffs. With regard to inventive step, document (2) was considered to represent the closest prior art, and the present invention was held to be non-obvious over the teaching of this document in the light of any of the other documents cited during the opposition proceedings, including document (4).

IV. With letter dated 4 January 2006, the Respondent (Proprietor of the Patent) filed a main request, claim 1 of which was identical to that on which the decision under appeal was based, and on 22 January 2007,

submitted auxiliary requests 1 to 4, of which auxiliary requests 1 and 2 corresponded to auxiliary requests filed with the letter dated 4 January 2006.

Claim 1 of the auxiliary request 1 differed from claim 1 of the main request exclusively in that it comprised a disclaimer which excluded a generically defined lotion-coated disposable absorbent article.

Claim 1 of the auxiliary request 2 differed from claim 1 of the main request exclusively in that the immobilizing agent of the lotion disposed on both the barrier and gasketing cuffs was specified as being selected from "polyhydroxy fatty acid amides, C₁₄-C₂₂ fatty alcohols, C₁₂-C₂₂ fatty acids, C₁₂-C₂₂ fatty alcohol ethoxylates, and mixtures thereof".

Claim 1 of the auxiliary request 3 differed from claim 1 of the main request exclusively in that the immobilizing agent of the lotion disposed on both the barrier and gasketing cuffs was specified as comprising C₁₆-C₁₈ fatty alcohol.

Claim 1 of the auxiliary request 4 differed from claim 1 of the main request exclusively in that the definitions of the emollient and the immobilizing agent of the lotion disposed on both the barrier and gasketing cuffs were amended, the definition of the emollient being supplemented with the wording "wherein said emollient contains about 5% or less water and comprises a petroleum based emollient selected from the group consisting of mineral oil, petrolatum, and mixtures thereof" and the immobilizing agent being specified as selected from "polyhydroxy fatty acid

esters, polyhydroxy fatty acid amides, C₁₄-C₂₂ fatty alcohols, C₁₂-C₂₂ fatty acids, C₁₂-C₂₂ fatty alcohol ethoxylates, and mixtures thereof".

- V. The Appellant, although objecting in the Statement of Grounds of Appeal to amendments made to claim 1 under Article 100(c) EPC, did not maintain this objection at the oral proceedings before the Board held on 22 February 2007. The Appellant objected to the novelty of claim 1 of the main request in view of document (1) which was prior art according to Article 54(3) and (4) EPC. Document (1) disclosed a lotion-coated diaper wherein the lotion corresponded to that of the patent in suit, and the diaper had a backsheet, a liquid pervious topsheet, an absorbent core and elasticized leg cuffs. The lotion could be applied to any part of the diaper where it could come into contact with the wearer's skin, for example on elasticized inner standing cuffs or elasticized outer gasketing cuffs. Furthermore, document (1) incorporated document (2) by reference, document (2) disclosing a diaper having all the features (A) to (E) according to the patent in suit.

The Appellant submitted that the subject-matter of claim 1 of the main request and of all the auxiliary requests was not inventive. In the light of the disclosure of document (4), the Appellant argued that the skilled person, faced with the problem of providing a lotion-coated absorbent article such as a diaper having improved liquid containment properties, would have turned to document (2), since this document addressed just this problem, and taught that it may be solved by a diaper having both gasketing and barrier leg cuffs, said document also teaching that the diaper

has a backsheet, a liquid pervious topsheet and an absorbent core between these two sheets. The Appellant held that the lotion coating on the skin contacting surfaces of the two types of leg cuffs made no contribution to liquid containment. Indeed on the contrary, since said lotion may be hydrophilic, this would render the diaper less liquid impermeable.

With regard to auxiliary request 3, the Appellant argued that the amendments made to claim 1 of this request offended against the provisions of Article 123(2) EPC, since the freshly introduced features were not disclosed in combination in the application as filed. In addition, the amendments made to auxiliary request 4 lacked clarity. Furthermore, the Appellant challenged auxiliary requests 3 and 4 on the ground of being late filed.

VI. The Respondent submitted that document (1) was not novelty destroying, since there was no direct and unambiguous disclosure in this document of a diaper having both barrier leg cuffs **and** gasketing cuffs. Document (2) was incorporated by reference into this document only insofar as the construction of the elasticized leg cuffs (550) was concerned, these leg cuffs being gasketing cuffs.

The Respondent argued that document (2) should be regarded as the closest state of the art and not document (4), since document (4) was primarily concerned with articles of clothing such as gloves, mentioned diapers merely in passing, and did not address the problem of liquid containment. Starting however from document (4), the Respondent submitted

that the problem to be solved by the patent in suit was to improve liquid containment. It was argued that although it was known from document (2) that a diaper having the features (A) to (E) of the patent in suit contributed toward liquid containment *vis-à-vis* a diaper without such leg cuffs, there was no incentive either in document (2) or in document (4) to apply the lotion of document (4) to the barrier leg cuff outer surface or to the gasketing cuff front surface of the diaper of document (2) in order to achieve even better liquid containment, as was indicated in various passages of the patent in suit (e.g. page 2, lines 44 to 47, page 3, lines 29 to 32 and page 4, lines 8 to 9). Although these passages referred only to the effect of hydrophobic lotions, the Respondent stated that the effect was also achieved for hydrophilic lotions. In addition, in view of its consistency, the lotion filled in microscopic spaces in the cuff materials thus preventing leakage. The skilled person would not have applied the lotions of document (4) to the leg cuffs of an absorbent article, since in view of the teaching in document (4) to apply the lotion to the inside portion of the article which comes into direct contact with the user's skin, the obvious approach would have been to apply the lotion to the largest skin-contacting part of the absorbent article, namely to the topsheet, and not to the leg cuffs. With letter dated 22 January 2007, the Respondent filed a test report to demonstrate reduction in red marking when lotion was applied to diaper leg cuffs.

The Respondent submitted that the amendments to the auxiliary requests found support in the application as filed, and thus complied with the requirements of

Article 123(2) EPC. More particularly, the basis for the disclaimer in claim 1 of auxiliary request 1 was document (1), the basis for the list of immobilizing agents in claim 1 of auxiliary request 2 was original claim 2, the basis for the immobilizing agent being a C₁₆-C₁₈ fatty alcohol in claim 1 of auxiliary request 3 was the first two paragraphs of page 30 of the application as filed, and basis for the particular emollients and immobilizing agents in claim 1 of auxiliary request 4 was original claims 3 and 22.

VII. The Appellant requested that the decision under appeal be set aside and the patent be revoked.

The Respondent requested that the decision under appeal be set aside and the patent be maintained on the basis of the main request or, subsidiarily, on the basis of any of the auxiliary requests 1 to 4 submitted with letter dated 22 January 2007.

VIII. At the end of the oral proceedings, the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.

Main request

2. *Amendments*

2.1 The subject-matter of claim 1 is based on original claims 1 and 20, the combination of lotion coating on

the barrier leg cuff outer surface and gasketing cuff front surface being disclosed in the last paragraph on page 23 of the application as filed. During oral proceedings before the Board, the Appellant no longer maintained its objection regarding lack of disclosure.

2.2 For these reasons, the Board concludes that the subject-matter of claim 1 of the main request does not extend beyond the content of the application as filed such that the requirements of Article 123(2) EPC are satisfied and the ground for opposition pursuant to Article 100(c) EPC is disqualified.

2.3 These amendments bring about a restriction of the scope of the claims as granted, and therefore of the protection conferred thereby, which is in keeping with the requirements of Article 123(3) EPC.

3. *Novelty*

3.1 The Appellant challenged the novelty of the claimed invention exclusively with regard to document (1). In the circumstances of this case, the Board limits its considerations with respect to novelty to this document.

3.2 Document (1) is comprised in the state of the art according to Article 54(3) and (4) EPC. This finding was never contested by the Appellant.

3.3 The Board observes that it is a generally applied principle that for concluding lack of novelty, there must be a direct and unambiguous disclosure in the state of the art which would inevitably lead the

skilled person to subject-matter falling within the scope of what is claimed.

- 3.4 In the present case, document (1) discloses a lotion-coated diaper wherein the lotion (cf. claim 1) corresponds to that of the patent in suit, and the diaper (cf. Fig. 3) has a backsheet (530), a liquid pervious topsheet (520), an absorbent core (540) and elasticized leg cuffs (550), said cuffs corresponding to the gasketing cuffs of the present invention, and which may be constructed (cf. page 13, lines 15 to 20) in a configuration described *inter alia* in document (2). The lotion may be applied to any part of the diaper where it could come into contact with the wearer's skin, for example on elasticized inner standing cuffs or elasticized outer gasketing cuffs (cf. page 39, lines 22 to 27).
- 3.5 There is however, no direct and unambiguous disclosure in this document of a diaper having both barrier leg cuffs **and** gasketing cuffs.
- 3.6 With regard to the Appellant's argument that the reference on page 39 of document (1) to the lotion being applied to **any** part of the diaper where it can come into contact with the wearer's skin implied that the lotion is applied to both types of cuff which are subsequently disclosed, the Board notes that these two types of cuff are linked by the word "or" and not by the word "and", such that the simultaneous presence of both types of cuff is not disclosed in document (1). Furthermore, document (2) is incorporated by reference into document (1) only insofar as the construction of the elasticized (gasketing) leg cuffs (550) is

concerned, such that document (1) does not disclose a diaper having two different types of leg cuffs simultaneously, even though document (2) does disclose such a diaper.

3.7 Therefore, the Board concludes that the subject-matter of claim 1 of the main request is novel within the meaning of Articles 52(1), 54(3) and (4) EPC.

4. *Inventive step*

4.1 According to the established jurisprudence of the Boards of Appeal it is necessary, in order to assess inventive step, to establish the closest state of the art, to determine in the light thereof the technical problem which the invention addresses and successfully solves, and to examine the obviousness of the claimed solution to this problem in view of the state of the art. This "problem-solution approach" ensures assessing inventive step on an objective basis and avoids an *ex post facto* analysis.

4.2 The patent in suit is directed to a lotion-coated absorbent article, the aims of the present invention outlined on page 3, lines 11 to 12 and 16 to 17 of the specification of the patent in suit including less skin irritation and improved liquid containment properties. A similar lotion-coated absorbent article already belongs to the state of the art in that document (4) describes a diaper (cf. col. 2, line 34), the inside portion of which comes into direct contact with the user's skin in the area to which the cream is to be applied (cf. col. 2, lines 35 to 38) and is coated (cf. col. 6, line 61) with a dry non-oily solid, said solid

comprising 30 to 70% of an oily material (cf. col. 3, lines 30 to 31 and 33) such as mineral oil or petrolatum (cf. col. 3, line 37) and 70 to 30% of an emulsifier such as cetyl alcohol (cf. col. 3, lines 34 to 35 and 48). Since mineral oil and petrolatum are described in the patent in suit as suitable petroleum-based emollients (cf. claim 3) and cetyl alcohol as a suitable C₁₄-C₂₂ fatty alcohol for use as an immobilizing agent (cf. claim 10), the non-oily solid of document (4) fulfils the melting point requirements of claim 1 of the patent in suit. Document (4) describes the cream therein as being skin-soothing (cf. col. 1, line 8) and addresses the problem of chafing due to friction in relation to diaper liners (cf. col. 7, lines 15 to 17) i.e. it relates to the objective of the claimed invention of achieving less skin irritation.

The Respondent argued that not document (4), but rather document (2), was the closest state of the art, since document (4) was primarily concerned with articles of clothing such as gloves, mentioned diapers merely in passing and did not address the problem of liquid containment.

However, on the one hand the claimed subject-matter is not restricted to diapers but is directed to absorbent articles in general and on the other hand document (4) addresses explicitly diapers as examples of lotion-coated articles (cf. col. 2, line 34, col. 3, line 16, col. 7, line 15 and claim 13), diaper use necessarily implicating problems associated with liquid containment. Furthermore, the disclosure of document (4) is structurally closer to the claimed invention than that of document (2), since it is directed to a lotion-

coated diaper comprising the specific lotion of the present invention, whereas document (2) discloses merely a non-coated diaper.

The Board concludes therefore that document (2) represents prior art which is further away from the patent in suit than document (4).

Thus, the Board considers that in the present case the lotion-coated diaper of document (4) represents the closest state of the art and, hence, takes it as the starting point when assessing inventive step.

4.3 In view of this state of the art, the problem underlying the patent in suit, as formulated by the Appellant at the oral proceedings and indicated on page 3, lines 16 to 17 of the specification of the patent in suit, consists in providing a lotion-coated absorbent article having improved liquid containment properties.

4.4 As the solution to this problem, the patent in suit proposes a lotion-coated absorbent article as defined in claim 1 wherein the article is characterised as having a backsheet, a liquid pervious topsheet, an absorbent between these two sheets, barrier leg cuffs, elastically contractible gasketing cuffs, with lotion coatings on the barrier leg cuff outer surface and gasketing cuff front surface.

4.5 The Appellant never disputed that the claimed lotion-coated absorbent article had improved liquid containment properties in view of the presence of the two types of cuff in this specific article

configuration, and the Board is also of the opinion that it is credible that the problem is solved.

The Respondent argued that the lotion coating of the barrier leg cuff outer surface and the gasketing cuff front surface led to further improvement of the liquid containment properties of the absorbent article, the specification of the patent in suit alleging that lotion coating increased the hydrophobicity of the cuffs, thereby improving leakage performance. The Respondent further argued that hydrophilic lotions also resulted in a similar effect and submitted that the lotion filled in any small holes in the cuff materials, resulting in less leakage.

However, the Respondent who bears the onus of proof for its allegations, has neither provided substantiating facts nor corroborating evidence that the lotion coating contributes in any way to an improvement in liquid containment and the Appellant contested that the lotion contributed to such an improvement. The test report filed by the Respondent on 22 January 2007 is not related to liquid containment properties and, therefore, was not referred to by the Respondent in its argumentation with respect to that property. Thus, the Respondent has merely speculated about any impact on the liquid containment properties due to the presence of the lotion on the cuffs.

The Board concludes that it has not been convincingly demonstrated that the lotion coating on the cuffs contributes to the liquid containment properties of the absorbent article. Consequently, this feature does not contribute towards solving the problem underlying the

invention of improving those liquid containment properties, with the consequence that it is to be discarded when assessing obviousness.

- 4.6 Finally, it remains to decide whether or not the proposed solution to that objective problem underlying the patent in suit is obvious in view of the state of the art.

Thus when starting from the lotion-coated diaper of undisclosed configuration known from document (4) where the lotion is coated on the inside portion coming in direct contact with the user's skin, it is a matter of course that the person skilled in the art seeking to improve the liquid containment properties thereof would turn his attention to that prior art in the field of diapers dealing with just the same technical problem. As a skilled person, he would be struck by document (2) which addresses the improvement in the containment characteristics of absorbent articles (cf. col. 1, lines 8 to 9). This document teaches that leakage prevention is enhanced by the presence of barrier leg cuffs and yet further enhanced by the presence of gasketing cuffs (cf. col. 2, lines 22 to 31), and discloses a diaper configuration (cf. Fig. 4) comprising such cuffs and all the other features as to the configuration of the absorbent article according to the present invention. Figure 4 of document (2) is identical to Figure 4 of the patent in suit, and the fact that the diaper according to document (2) falls within the ambit of the absorbent article configuration of present claim 1 was not contested by the Respondent. The skilled person, thus acting routinely, would use the diapers having the particular configuration

described in document (2) as lotion-coated diapers according to document (4) in order to solve the problem underlying the invention, namely of improving the liquid containment properties. The lotion is applied on the inside portion of that article which comes into direct contact with the user's skin as taught in document (4), said portion including the barrier leg cuff outer surface and the gasketing cuff front surface, thereby arriving at the absorbent article claimed without the exercise of inventive ingenuity.

- 4.7 The Respondent argued in support of inventive step that the skilled person, when combining the teachings of documents (4) and (2), would not have applied the lotion of document (4) to the leg cuffs of the diaper of document (2) but rather to the topsheet thereof.

However, document (4) clearly teaches (cf. col. 2, lines 36 to 38 and 40 to 43) the application of the lotion to the inside portion of the article which comes into direct contact with the user's skin, this inner portion embracing thus the barrier leg cuff outer surface and the gasketing cuff front surface of the absorbent article of the present invention, as these are the cuff surfaces which come into contact with the skin (cf. specification of patent in suit, page 11, lines 18 to 20). Therefore, document (4) does not teach that the lotion may be applied only to the topsheet of a diaper, nor is there a deterrent teaching in document (4) which would discourage the skilled person from applying the lotion disclosed therein to cuffs of an absorbent article.

4.8 For these reasons, the solution proposed in claim 1 to the problem underlying the patent in suit is obvious in the light of the prior art.

4.9 As a result, the Appellant's main request is not allowable for lack of inventive step pursuant to Article 56 EPC.

Auxiliary request 1

5. *Amendments (Article 123 EPC)*

5.1 The amendment made to claim 1 of auxiliary request 1 *vis-à-vis* claim 1 of the main request comprises the insertion of a disclaimer which excludes a generically defined lotion-coated disposable absorbent article.

5.2 The Appellant and the Respondent concur on the fact that this disclaimer has no basis in the application as filed and that it was introduced into claim 1 during the appeal proceedings in order to delimit the claimed subject-matter from document (1). Nor is there dispute between the parties that this document forms part of the state of the art according to Article 54(3) and (4) EPC.

5.3 Following the decisions G 1/03 and G 2/03 of the Enlarged Board of Appeal (OJ EPO 2004, 413 and 448), an undisclosed disclaimer may be allowable and is considered as not extending the subject-matter of the application as filed within the meaning of Article 123(2) EPC if it restores novelty by delimiting a claim against state of the art under Article 54(3)

and (4) EPC (*loc. cit.*, point 2.1.3 of the reasons of the decisions).

5.4 In the present case, document (1) does not anticipate the subject-matter of claim 1 of the main request (cf. point 3 *supra*), such that it is not allowable to incorporate a disclaimer based on document (1) into claim 1 of the auxiliary request 1.

5.5 For those reasons, the incorporation of the disclaimer into claim 1 is an amendment which extends the subject-matter claimed beyond the content of the application as filed, contrary to the requirements of Article 123(2) EPC, with the consequence that auxiliary request 1 is not allowable.

Auxiliary request 2

6. *Amendments (Article 123 EPC)*

6.1 The amendment made to claim 1 of auxiliary request 2 *vis-à-vis* claim 1 of the main request comprises the specification that the immobilizing agent of the lotion disposed on both the barrier and gasketing cuffs is selected from polyhydroxy fatty acid amides, C₁₄-C₂₂ fatty alcohols, C₁₂-C₂₂ fatty acids, C₁₂-C₂₂ fatty alcohol ethoxylates, and mixtures thereof.

6.2 Basis for this list of immobilizing agents is original claim 2.

6.3 Therefore, the amendment made to claim 1 does not generate new subject-matter extending beyond the content of the application as filed or beyond the scope

of the granted claims, such that the requirements of Article 123(2) and (3) EPC are satisfied.

7. *Inventive step*

7.1 Claim 1 according to the auxiliary request 2 differs from claim 1 of the main request exclusively in that the immobilizing agent is specified as being selected from a list of particular fatty acid derivatives. At the oral proceedings before the Board, the Respondent submitted that this amendment was designed to render the subject-matter novel over the disclosure of document (1). The Respondent conceded that no particular effect was achieved by that additional feature.

7.2 The Board considers that the specification of the particular immobilization agents cannot contribute to the inventiveness of the subject-matter claimed, since the closest prior art document (4) already discloses (cf. point 4.2 *supra*) a C₁₄-C₂₂ fatty alcohol, namely cetyl alcohol, as a component of the lotion disclosed therein. Therefore, the considerations having regard to inventive step given in points 4.2 to 4.7 *supra* and the conclusion drawn in point 4.8 *supra* with respect to the main request apply also to auxiliary request 2, i.e. the subject-matter claimed is obvious and does not involve an inventive step.

7.3 In these circumstances, the auxiliary request 2 shares the fate of the main request in that it too is not allowable for lack of inventive step pursuant to Article 56 EPC.

Auxiliary requests 3 and 4

8. *Admissibility*

Both of these auxiliary requests were submitted by the Respondent with letter dated 22 January 2007, i.e. shortly before oral proceedings. Admission into the proceedings of requests filed at such a late stage of the appeal proceedings is a matter of discretion for the Board of Appeal and is not a matter as of right. In exercising due discretion, it is established jurisprudence of the Boards of Appeal that crucial criteria are whether or not the amended claims of those requests are clearly allowable and whether or not those amended claims give rise to fresh issues which the other party can reasonably be expected to deal with properly without unjustified procedural delay (see T 92/93, point B of the reasons; T 401/95, point 5.2 of the reasons, neither published in OJ EPO).

Auxiliary request 3

9. The amendment made to claim 1 of auxiliary request 3 *vis-à-vis* claim 1 of the main request comprises the specification that the immobilizing agent of the lotion disposed on both the barrier leg cuff outer surface and gasketing cuff front surface comprises C₁₆-C₁₈ fatty alcohol.

9.1 However, there is no disclosure in the application as filed of the immobilizing agent in the lotion on the barrier leg cuffs being a C₁₆-C₁₈ fatty alcohol, as well as the immobilizing agent in the lotion on the gasketing cuffs being both simultaneously a C₁₆-C₁₈ fatty

alcohol, such that a particular combination of specific features has been singled out, thereby generating new subject-matter (cf. T 859/94, point 2 of reasons, not published in OJ EPO). Nor is there a basis for this combination on page 30, lines 1 and 10 to 11 of the application as filed, as argued by the Respondent, since C₁₆-C₁₈ fatty alcohols are disclosed herein merely as preferred immobilizing agents, there being no indication that such alcohols should be the immobilizing agent in the lotion coating simultaneously for both particular types of cuff.

- 9.2 As a consequence the fresh amendment to claim 1 results in the generation of a new combination which extends beyond the content of the application as filed, such that late filed auxiliary request 3 is clearly not allowable under Article 123(2) EPC with the consequence that the Board exercises its discretion not to admit this request into the proceedings.

Auxiliary request 4

10. Claim 1 of auxiliary request 4 has been amended in opposition (appeal) proceedings (cf. point IV *supra*) by supplementing the definition of the emollient such that said definition now comprises "a member selected from the group consisting of petroleum-based emollients, fatty acid ester emollients, alkyl ethoxylate emollients, and mixtures thereof *wherein said emollient contains about 5% or less water and comprises a petroleum based emollient selected from the group consisting of mineral oil, petrolatum, and mixtures thereof*" (the amendment is italicised). This amendment

results from a combination of claim 1 as granted with dependent claim 3 as granted.

10.1 Although Article 84 EPC may not be raised as ground for opposition in the sense of Article 100 EPC, Article 102(3) EPC stipulates that, taking into consideration the amendments made to the patent in suit during opposition (appeal) proceedings, the patent and the invention to which it relates meet the requirements of the European Patent Convention. Thus, according to established jurisprudence of the Boards of Appeal, the Board has the power to examine whether the patent satisfies all requirements of the EPC, as long as the objections **arise** out of the amendments made thereto. That examination requires to consider whether or not those amendments introduce any contravention of any requirement of the EPC, including Article 84 EPC (see decisions T 301/87, OJ EPO 1990, 335, point 3.8 of the reasons; G 9/91, OJ EPO 1993, 408, point 19 of the reasons). In contrast to the Respondent's view, this principle applies also when a feature of a dependent granted claim is incorporated into an independent claim thereby rendering the amended independent claim ambiguous (see decision T 420/00, point 3.6.3 of the reasons, not published in OJ EPO). Therefore it must be examined whether or not the amendment made to claim 1 is in keeping with the requirements of Article 84 EPC, in particular with that of clarity.

10.2 In amended claim 1 of auxiliary request 4, the definition of the emollient is unclear, because it is defined on the one hand as comprising a member selected from a list of emollients which includes petroleum-based emollients, and on the other hand as comprising a

petroleum-based emollient selected from mineral oil and petrolatum. Such a definition, wherein the second part thereof appears either contradictory to the first part or would render said first part superfluous, leads to confusion, with the consequence that the subject-matter covered by that claim is opaque.

10.3 Claim 1 thus fails to meet the requirement of clarity imposed by Article 84 EPC, such that late filed auxiliary request 4 is not clearly allowable, with the consequence that the Board exercises its discretion not to admit this request into the proceedings.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:

C. Moser

R. Freimuth