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**Datasheet for the decision
of 19 June 2007**

Case Number: T 0872/05 - 3.2.06

Application Number: 98926094.8

Publication Number: 1079778

IPC: A61F 13/15

Language of the proceedings: EN

Title of invention:

Disposable panttype diaper having improved protection against red marking and method for making the same

Patentee:

THE PROCTER & GAMBLE COMPANY

Opponent:

Kimberly-Clark Worldwide, Inc.

Headword:

-

Relevant legal provisions:

RPBA Art. 10b

EPC Art. 56

Keyword:

"Main, first and third auxiliary requests filed in advance of oral proceedings - not admitted because substantially modifying the appellant's case"

"Inventive step (no) - second auxiliary request"

"Fourth auxiliary request filed during oral proceedings - not admitted because not clearly allowable"

Decisions cited:

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Catchword:

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Case Number: T 0872/05 - 3.2.06

D E C I S I O N
of the Technical Board of Appeal 3.2.06
of 19 June 2007

Appellant: THE PROCTER & GAMBLE COMPANY
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Respondent: Kimberly-Clark Worldwide, Inc.
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Representative: Davies, Christopher Robert
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
9 May 2005 concerning maintenance of the
European Patent No. 1079778 in amended form.

Composition of the Board:

Chairman: P. Alting Van Geusau
Members: G. Pricolo
K. Garnett

Summary of Facts and Submissions

I. The appeal is from the interlocutory decision of the Opposition Division posted on 9 May 2005 concerning the maintenance in amended form of European patent No. 1 079 778, granted in respect of European patent application No. 98 926 094.8.

II. In the decision under appeal the Opposition Division considered that claim 1 of the patent as granted lacked novelty over the disclosure of document

D3: JP-A-8038546.

However, the subject-matter of claim 1 according to the patent proprietor's first auxiliary request was novel and also involved an inventive step over the available prior art, including document

D4: EP-A-0 587 196.

III. The patentee lodged an appeal, received at the EPO on 8 July 2005, against this decision and paid the appeal fee on the same date. With the statement setting out the grounds of appeal, received at the EPO on 19 September 2005, the appellant filed main, first and second auxiliary requests for maintenance of the patent in amended form.

IV. In the communication dated 29 March 2007 accompanying the summons to oral proceedings pursuant to Article 11(1) of the Rules of Procedure of the Boards of Appeal, the Board expressed the preliminary opinion that the subject-matter of claim 1 according to the

main request did not appear to be novel over D3 and that the amendments made in accordance with the first and second auxiliary requests did not appear to meet the requirements of Article 123(2) EPC.

V. In response to the communication of the Board the appellant submitted on 16 May 2007 a new main request and new first, second and third auxiliary requests.

VI. Oral proceedings took place on 19 June 2007.

The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request filed with the letter dated 16 May 2007 alternatively on the basis of the first to third auxiliary requests filed with that letter alternatively on the basis of the fourth auxiliary request filed during the oral proceedings.

The respondent (opponent) requested that the appeal be dismissed.

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

"1. A disposable pull-on garment (120) having a front region (26), a back region (28) and a crotch region (30) between the front region and the back region, comprising: a chassis (41) provided in the front, back and crotch regions and having edge lines (222, 242) in the front and back regions, the chassis including a liquid pervious topsheet (24), a liquid impervious backsheet (22) associated with the topsheet, and an absorbent core (25) disposed between the topsheet and the backsheet; and at least one pair of elastically

extensible ear panels (45, 46, 48) extending laterally outward from the chassis in the front or back region, each of the ear panels having an outermost edge line (240); each of the ear panels (45, 46, 48) being joined to the chassis along the corresponding edge lines (222, 242) to form a seam (232), thereby forming two leg openings (34) and a waist opening (36), characterised in that:

at least one of the ear panels having, along the seam (232), a substantially bonded portion starting from the waist opening and an unbonded portion starting from the leg opening; wherein the ratio in length of the unbonded portion to the substantially bonded portion is between about 4:96 and about 20:80, and wherein the ear panels (45, 46, 48) are discrete members, which do not have any unitary element that forms a part of the chassis (41)".

Claim 1 according to the first auxiliary request differs from claim 1 according to the main request only in that the range "between about 4:96 and about 20:80" is replaced by the range "between about 8:92 and about 15:85".

Claim 1 according to the second auxiliary request differs from claim 1 according to the main request in that its characterising portion reads as follows:
"at least one of the ear panels having, along the seam (232), a substantially bonded portion starting from the waist opening and an unbonded portion starting from the leg opening; wherein the ratio in length of the unbonded portion to the substantially bonded portion is between about 4:96 and about 20:80, wherein at least one of the ear panels includes a plane elastomeric

material extending laterally outward from the chassis, wherein the plane elastomeric material includes at least a portion that has a nonuniform lateral width which increases towards the leg opening".

Claim 1 according to the third auxiliary request includes all the features of claim 1 according to the second auxiliary request and additionally the following feature:

"wherein the ear panels (45, 46, 48) are discrete members, which do not have any unitary element that forms a part of the chassis (41)."

Claim 1 according to the fourth auxiliary request differs from claim 1 according to the second auxiliary request in that in the last sentence the expression "includes at least a portion that" is deleted.

VIII. At the beginning of the oral proceedings, the Board pointed out that the feature of claim 1 in accordance with the main request and the first and third auxiliary requests, according to which the ear panels were discrete members which did not have any unitary element that formed a part of the chassis, was taken from the description and was not present in any claim of the previous requests. Claim 1 thus related to an embodiment which was presented in the description of the patent as granted merely as a possible alternative and excluded all the illustrated embodiments in the contested patent. The appellant's case thus took a different and unexpected direction from that set out in the grounds of appeal. Therefore, it appeared that the main, first and third auxiliary requests could not be admitted.

The appellant argued that these requests should be admitted because the amendments were filed in response to the negative communication of the Board, they had a proper basis in the description of the application as filed, they did not involve any complex issue, and the claims clearly defined the matter for which protection was sought.

The respondent submitted that the amendment consisting in the introduction of the mentioned feature taken from the description gave rise to objections under Article 84 and 123(2) EPC. In particular, it was not clear whether the chassis consisted exclusively of topsheet, backsheet and absorbent core, or whether it could include further elements such as waist elastics.

- IX. As regards the second auxiliary request, the appellant submitted that it was clearly admissible because the amended claims resulted from the combination of granted claims. Furthermore, the claimed subject-matter involved an inventive step. D3 did not disclose ear panels including a plane elastomeric material having a portion with a nonuniform lateral width which increased towards the leg opening. This feature contributed to the solution of the problem underlying the patent in suit, consisting in improving protection against red marking. D4 disclosed, in the embodiment of Fig. 21, elastic side panels cut so that their width increased towards the leg opening, in order to provide improved fit of the garment. Therefore, the person skilled in the art confronted with the problem of improving protection against red marking, in particular at the leg opening, would not consider transposing this

feature in the absorbent garment of D3. In fact, D4 rather taught that protection against red marking could be improved by means of other measures, such as changing the dimensions and/or the material of the side panels.

The respondent replied that starting from D3 the objective problem solved by the distinguishing feature could only be seen in improving the fit of the pull-on absorbent garment. In fact, there was nothing in the patent in suit which substantiated a contribution to the protection against red marking of the plane elastomeric material as specified in claim 1. D4 specifically addressed the problem of improving the fit of a pull-on garment, and solved it by means of the distinguishing feature. Therefore, the skilled person would arrive at the claimed subject-matter without the exercise of any inventive activity.

- X. The fourth auxiliary request was filed during the oral proceedings after a final opinion was given by the Board in respect of the other requests.

The appellant submitted that claim 1 was amended to make it clear that it was the whole plane elastomeric material that increased in width and not only a portion thereof.

The respondent objected that this limitation was not reflected by the wording of claim 1, that a plane elastomeric material steadily increasing in width was not disclosed in the application as originally filed, and that anyway the intended limitation was not such as to change the discussion in respect of inventive step.

Since the fourth auxiliary request was filed at a very late stage and was not clearly allowable, it should not be admitted into the proceedings.

Reasons for the Decision

1. The appeal is admissible.
2. *Main, first and third auxiliary requests*
 - 2.1 According to Article 10b(1) of the Rules of Procedure of The Boards of Appeal (RPBA), "*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. The discretion shall be exercised in view of inter alia the complexity of the new subject matter submitted, the current state of the proceedings and the need for procedural economy*".
 - 2.2 The Board accepts that the main, first and third auxiliary requests were filed in an attempt to overcome the objections raised by Board in its communication accompanying the summons to oral proceedings (see above point IV). In fact, claim 1 of these requests has been amended by including a feature which allegedly supports the novelty and inventiveness of the claimed pull-on garment, i.e. the feature according to which the ear panels are discrete members which do not have any unitary element that forms a part of the chassis.

This feature is taken from the description of the patent in suit (see col. 6, lines 2 to 5) and is not present in the claims as granted or in the claims of

any requests previously filed by the appellant. It is presented in the description as a mere possible alternative to the preferred feature, which is present in all the embodiments shown in the figures, that the ear panels include at least one unitary element or a continuous sheet material that forms a part of the chassis (see col. 5, line 56 to col. 6, line 2). Therefore, the introduction of the feature in question has the effect of changing the appellant's case from that set out in the grounds of appeal in a substantial manner and in a direction which, objectively, could not be expected.

Moreover, in accordance with the respondent's submissions, the mentioned feature leads to clarity problems (Article 84 EPC) since, contrary to the appellant's argument, it cannot be deduced from the wording of the claim that the chassis consists exclusively of a topsheet, backsheet and absorbent core and does not include other elements such as the waist elastics.

Under these circumstances the Board considers it appropriate to exercise its discretion under Article 10b(1) RPBA not to admit these requests.

3. *Second auxiliary request*

- 3.1 Claim 1 according to the second auxiliary request combines the features of granted claims 1, 5, 7 and additionally includes the feature that the ear panels are *elastically* extensible. This feature is described in the application as filed in connection with a preferred embodiment of the pull-on garment (see page 7,

2nd paragraph: "*Herein, any material or element described as extensible may also be elastically extensible unless otherwise provided*"). These amendments neither give rise to objections under Articles 84, 123(2) or 123(3) EPC nor raise any new issue. Therefore, the Board takes the view that the second auxiliary request is admissible even having regard to the late stage of the proceedings at which it was filed. During the oral proceedings the respondent did not raise the question of admissibility or any objections under Articles 123 or 84 EPC in respect of these amendments.

3.2 Novelty of the subject-matter of claim 1 was not in dispute. The Board is in fact satisfied that the available prior art does not disclose a pull-on garment having all the features of claim 1.

3.3 However, the subject-matter of claim 1 lacks an inventive step (Article 56 EPC), for the following reasons.

3.3.1 The problem underlying the patent in suit is to provide a disposable pull-on garment having improved protection against red marking while maintaining improved "fitness" to the body (see par. [0001] of the patent in suit).

3.3.2 Document D3 undisputedly represents the closest prior art. D3 (reference is made hereinafter to the translation in English filed by the opponent and considered by the Opposition Division in the decision under appeal) indeed relates to a pull-on garment similar to that of the patent in suit and concerns the

same problem of avoiding red markings (see page 3, 2nd paragraph).

Using the wording of claim 1 of the patent in suit, D3 discloses (see Figs. 1 and 2) a disposable pull-on garment (1) having a front region, a back region and a crotch region between the front region and the back region, comprising:

a chassis provided in the front, back and crotch regions and having edge lines in the front and back regions, the chassis including a liquid pervious topsheet (10), a liquid impervious backsheet (4, see page 7, last paragraph) associated with the topsheet, and an absorbent core (12) disposed between the topsheet and the backsheet; and at least one pair of extensible ear panels (see paragraph [0016] starting on page 7, in particular the first sentence on page 8 relating to the extensibility) extending laterally outward from the chassis in the front and back region, each of the ear panels having an outermost edge line; each of the ear panels (14) being joined to the chassis along the corresponding edge lines to form a seam (8), thereby forming two leg openings (3) and a waist opening (2); wherein at least one of the ear panels has, along the seam (8), a substantially bonded portion (8) starting from the waist opening and an unbonded portion (8') starting from the leg opening (see page 5, lines 4 to 7).

The appellant disputed that D3 discloses elastically extensible ear panels. This view cannot be accepted. D3 discloses that the backsheet (4) is non-stretchable (see page 2, 3rd line), in the sense that it elongates when subjected to a tensile force but is not able to

restore itself to its original state (see par. [0016]). It also discloses that a stretchable elastic member (14; see Fig. 2) is attached to each flap (see par. [0011]). Accordingly (see Fig. 2), each ear panel comprises a portion of the non-stretchable backsheet (4) and a portion of the elastic member (14). In the absence of any rigid elements (the presence of which would be ruled out by the skilled person as being wholly impractical), such combination of elements necessarily results in an ear panel which is elastically extensible.

The elastic member (14) is a plane elastomeric material (see page 7, first paragraph: it may consist of a web made of elastomeric non-woven fabric, an elastomeric film, etc., as with the plane elastomeric material described on col. 9, lines 1 to 5 of the patent in suit) extending laterally outward from the chassis (which is formed by topsheet 10, backsheet 4 and absorbent core 12). Therefore, D3 also discloses the feature of claim 1 according to which at least one of the ear panels includes a plane elastomeric material extending laterally outward from the chassis.

Furthermore, according to the teaching of D3 (see par. 0007 on page 5), the ratio in length of the unbonded portion 8' to the total length of the side edge (i.e. 8+8') is *"less than 30% of the total length of the side edge, and more preferably between 10 and 25% of the total length of the side edge"*. This means that the ratio in length of the unbonded portion to the bonded portion is preferably between 0.1 and 0.3, which overlaps the claimed range of 0.09 and 0.18 (8:92 and 15:85).

Therefore, the subject-matter of claim 1 differs from the disposable pull-on garment according from D3 in that the plane elastomeric material includes at least a portion that has a nonuniform lateral width which increases towards the leg opening.

- 3.3.3 The appellant submitted that the distinguishing feature contributes to an improvement in protection against red marking, in particular at the leg openings.

The Board concurs with the respondent's view that there is no basis in the patent in suit to conclude that this feature effectively provides improved protection against red marking. According to the disclosure of the patent in suit, improved protection against red marking is achieved by the specific choice of the ratio of the lengths of the unbonded and bonded portions of the ear panels (see par. [0038] of the patent in suit). Although according to the disclosure of the patent in suit the lateral width of the plane elastomeric material may increase towards the leg opening (see col. 9, lines 25 to 27) it may alternatively decrease towards the leg opening (see col. 9, lines 27 to 29). Therefore, considering that the choice of a plane elastomeric material having a portion with a nonuniform lateral width which increases towards the leg opening might well contribute to a better fit to a wearer's body, the objective technical problem solved by the subject-matter of claim 1 can be seen in improving the fit of the pull-on garment.

- 3.3.4 The skilled person seeking a solution to this problem would look for prior art teachings directed to improving the fit of pull-on garments. He would take

document D4 into consideration because it relates to a similar pull-on garment and because it is specifically concerned with the problem of improving the fit thereof (see col. 15, lines 44 to 50 and 55 to 59). In particular, D4 discloses that the fit is further improved if the upper portions of the elastic side panels (136, 138) are *"cut so that they slope inwardly and upwardly from the intermediate portions of side panels 6,8 toward waist opening 10"* (see col. 15, lines 51 to 55). Accordingly, D4 teaches the improvement of the fit of the garment by providing the elastic side panels with a portion that has a nonuniform lateral width which increases towards the leg opening. The skilled person would recognise that this feature could be implemented in the pull-on garment of D3 with corresponding effect. He would therefore consider providing the distinguishing feature in the pull-on garment of D3 in order to solve the above-mentioned problem, thereby arriving in an obvious manner at the subject-matter of claim 1.

- 3.3.5 The Board notes that this conclusion remains the same even if the objective technical problem were seen as being the improvement of protection against red marking, as stated by the appellant. Indeed, in order to solve this problem the skilled person would not only look for prior art teachings specifically directed to improving protection against red marking but also to those directed to improving the fit of pull-on garments, since an improved fit usually has as a result a better distribution of the elastic forces acting on the wearer's skin and, as a consequence, less incidence of red markings. He would therefore consider modifying the pull-on garment of D3 in accordance with the teaching

of D4, as stated above, in order to improve protection against red marking.

4. *Fourth auxiliary request*

4.1 The appellant's fourth auxiliary request was filed with the intention of overcoming the negative opinion expressed by the Board during the oral proceedings in respect of the previous requests.

4.2 Claim 1 is amended over claim 1 according to the second auxiliary request only in that it requires that "*the plane elastomeric material*", rather than "*at least a portion*" thereof, has a nonuniform lateral width which increases towards the leg opening. However, this amendment does not substantially restrict the claimed subject-matter and therefore does not appear such as to overcome the above-mentioned lack of inventive step. By requiring that the plane elastomeric material includes at least a portion that has a nonuniform lateral width which increases towards the leg opening, claim 1 according to the second auxiliary request encompasses both the case in which only a portion of the plane elastomeric material increases in width and the case in which the whole plane elastomeric material increases in width. The same applies in respect of claim 1 according to the fourth auxiliary request, because a plane elastomeric material having a nonuniform lateral width which increases towards the leg opening does not necessarily have a width which *continuously* increases towards the leg opening, but may well include portions in which there is no increase in the width.

- 4.3 The appellant submitted that claim 1 should be read such as to include only a plane elastomeric material having a width which *continuously* increases towards the leg opening. In such case, however, claim 1 is directed to an embodiment which clashes with all the illustrated embodiments (see in particular Figs. 3 and 5), in which only a portion of the plane elastomeric material increases in width towards the leg opening. Therefore, if claim 1 were to be interpreted in accordance with the appellant's submissions, it would give rise to objections under Article 123(2) and 84 EPC.
5. It follows from the above that the fourth auxiliary request is not clearly allowable. Since it was filed at a very late stage of the proceedings, namely during the oral proceedings and after the previous requests of the appellant had been discussed, the Board considered it appropriate to exercise its discretion under Article 10b(1) RPBA not to admit this request.

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Kiehl

P. Alting Van Geusau