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**Datasheet for the decision
of 14 December 2007**

Case Number: T 1111/05 - 3.2.06

Application Number: 98923732.6

Publication Number: 0986665

IPC: D04H 13/00

Language of the proceedings: EN

Title of invention:

Breathable elastic film/nonwoven laminate

Patentee:

KIMBERLY-CLARK WORLDWIDE, INC.

Opponent:

SCA Hygiene Products AB

Headword:

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Relevant legal provisions:

EPC Art. 123(2), 100c)

Relevant legal provisions (EPC 1973):

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Keyword:

"Amendments in claim 1 of late-filed requests not clearly allowable - requests not admitted into the proceedings"

Decisions cited:

-

Catchword:

-



Case Number: T 1111/05 - 3.2.06

D E C I S I O N
of the Technical Board of Appeal 3.2.06
of 14 December 2007

Appellant: SCA Hygiene Products AB
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Representative: Hammond, Andrew David
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Respondent: KIMBERLY-CLARK WORLDWIDE, INC.
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Representative: Zimmermann & Partner
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
30 June 2005 concerning maintenance of European
patent No. 0986665 in amended form.

Composition of the Board:

Chairman: P. Alting Van Geusau
Members: G. L. de Crignis
K. Garnett

Summary of Facts and Submissions

- I. European Patent Nr. 0 986 665, granted on application Nr. 98923732.6, was maintained in amended form by decision of the opposition division posted on 30 June 2005.
- II. With regard to the patent proprietor's main request, the opposition division held that the requirements of Article 83 EPC and of Article 123(2) EPC were met and that the subject-matter of claim 1 was novel (Article 54 EPC) and involved an inventive step (Article 56 EPC) having regard to the state of the art disclosed in
- D1 US-A-5 336 545
D2 EP-A-0 707 106
D3 EP-A-0 688 826
D5 US-A-5 529 830.
- III. The appellant (opponent) filed a notice of appeal against this decision on 29 August 2005, and paid the appeal fee simultaneously. On 31 October 2005 the statement of grounds of appeal was filed. The appellant maintained the objections with regard to Article 83 and 123(2) EPC and referred with respect to novelty and inventive step (Articles 54 and 56 EPC) to a number of further documents.
- IV. In response to the grounds of appeal the Respondent filed new sets of claims in accordance with a main request and first to fifth auxiliary requests.

V. In a communication dated 26 September 2007 accompanying the summons to oral proceedings, the Board indicated a number of points requiring further consideration and in particular drew attention to the requirements of Article 123(2) EPC with respect to the new combinations claimed when compared to the dependencies of the dependent claims as originally filed.

With a letter of 14 November 2007 the Respondent (patent proprietor) submitted revised requests (new main and 1st to 5th auxiliary requests).

VI. Oral proceedings were held on 14 December 2007.

The appellant requested that the decision under appeal be set aside and that 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, alternatively on the basis of the first to fifth auxiliary requests.

Claim 1 of the main request:

" A breathable elastic laminate, comprising a breathable elastic film formed from an elastic polymeric material that exhibits an ability to absorb and diffuse water vapor, which film is not microporous or voided, essentially consisting of a polymer having a water vapour permeability of at least about 1000 kgcm/km²-day at 38°C and 100% relative humidity, and a neckable nonwoven web bonded to the film while the nonwoven web is necked in a first direction and the film is unstretched in the first direction;

the laminate having a moisture vapour transmission rate (MVTR) of at least about 2000 grams/m²24h."

In claim 1 of the second auxiliary request the polymer having a specified water vapour permeability is replaced by a polymeric material essentially consisting of vulcanized silicone rubber.

Claim 1 of the fourth auxiliary request is identical to claim 1 of the second auxiliary request but specifies further the breathable elastic film as being "embossed".

The subject-matter of claim 1 of the first, third and fifth auxiliary requests is identical to the subject-matter of claim 1 of the respective previous auxiliary request, but in the set of claims the dependencies of the dependent claims have been adjusted to the ones as originally filed.

VII. With respect to these requests the appellant argued essentially as follows:

The subject-matter of claim 1 of each of the requests did not meet the requirements of Article 123(2) EPC.

The claimed combination of features was not disclosed as originally filed - neither in the description nor in the claims.

Claim 1 of the main request and the first auxiliary request referred to a combination of an elastic film formed from an elastic polymer having a specific water vapour permeability which particular permeability was the subject-matter of claim 10 as originally filed.

However, only the combination with originally filed claim 1 had been disclosed and not the combination with the subject-matter of claim 13, referring to the now-claimed elevated range of MVTR. Also the description as originally filed did not refer to any example or embodiment having the now-claimed combination of features.

Claim 1 of the second to fifth auxiliary requests referred to the elastic film essentially consisting of vulcanized silicone rubber, which was the subject-matter of claim 3 as originally filed. The subject-matter of claim 13 as originally filed comprised the now-claimed range of MVTR. However, this claim 13 was only dependent on claim 1 and a combination with the subject-matter of claim 3, the vulcanized silicone rubber, therefore lacked a clear basis in the application as filed. Furthermore, in the description as originally filed there was no disclosure of either an embodiment or an example concerning a laminate having the claimed MVTR in combination with a film consisting of vulcanized silicone rubber. Furthermore, the support cited by the respondent in the paragraph bridging pages 9 and 10 referred to one specific film of vulcanized silicone rubber, whose manner of vulcanisation was not specified.

Furthermore, the dependencies of the dependent claims as claimed in the main request as well as in the second and the fourth auxiliary requests were not disclosed in the application as filed.

The feature in claim 1 of all requests concerning the film being microporous or voided was not present in any

claim as originally filed and was disclosed in the description as originally filed only in combination with elastic films which did not absorb ammonia to any appreciable extent. No such limitation was present in claim 1 of any of the requests.

Furthermore, claim 1 of all requests used the expression "essentially consisting of ..." whereas as originally filed the wording was "comprising of ...". The term "consisting essentially of ..." was explained in the patent in suit in combination with the term "as used herein". The term "consisting essentially of ...", however, had not been present in the specification elsewhere, and this definition would certainly not apply to the now-amended wording in claim 1. Moreover, it was also not clear (Article 84 EPC).

Concerning all requests, the wording in claim 1 referring to "a neckable nonwoven web bonded to the film while the nonwoven web is necked in a first direction and the film is unstretched in the first direction" could not be found in the originally filed specification (Article 123(2) EPC). The description as originally filed nowhere referred to a "first direction". A stretchability of the laminate in more than one direction was, however, disclosed (page 17, lines 15 to 22). Therefore, the insertion of such a feature did not satisfy the requirement that an amendment should be clearly and unambiguously derivable from the application as filed (Article 123(2) EPC). However, having regard to Article 123(3) EPC, it would also appear that it could not be removed .

As none of the late-filed requests was clearly allowable, they should not be admitted into the proceedings.

VIII. In support of its requests the respondent argued essentially as follows:

Claim 1 of the main request and of the first auxiliary request was amended by combining the subject-matter of claims 1, 10 and 13 as originally filed. The subject-matter of claim 1 of the second and third auxiliary requests was amended by combining the subject-matter of claims 1, 2, 3 and 13 as originally filed. The subject-matter of claim 1 of the fourth and fifth auxiliary requests was amended by combining the subject-matter of claims 1, 2, 3, 13 and 15 as originally filed. Therefore, the requirements of Article 123(2) EPC were met.

Additionally, Table I in combination with the description on page 8, last paragraph and the description on page 9 provided support for the embodiment claimed in claim 1 of the main request and the first auxiliary request. The most preferred values for the MVTR were claimed in combination with the most preferred values for the water vapour permeability of the elastic polymer, which resulting preferred embodiment would be immediately envisaged by the skilled person when reading the application as filed. Furthermore, page 11, second paragraph highlighted that the moisture breathability of the film should determine the breathability of the laminate which emphasized that the MVTR value was dependent on the characteristics of the film.

With regard to the subject-matter of claim 1 of the second to fifth requests, the MVTR of vulcanized silicone rubber was disclosed in page 9, last line to page 10, line 4. When taking into account the disclosure on page 11, second paragraph, the MVTR value of the laminate was determined by the vulcanized silicone rubber film and hence the claimed combination was disclosed.

Concerning all requests, the additional feature of the film being not microporous or voided was to be found on page 2, lines 11/12 of the PCT-application. It was referred to in general terms and concerned all claimed elastic films as this paragraph was located in the summary of the invention.

The term "consisting essentially of" was explained in the section "definitions" on page 6, last paragraph of the application as originally filed and could therefore be inserted in claim 1 of all requests.

For the feature concerning the nonwoven web being necked in the first direction and the film being unstretched in the first direction, the general description of the process and the process figures (Figures 1 and 3) supported such a combination of features.

Reasons for the Decision

1. *Amendments in view of Article 123(2) EPC*

1.1 The subject-matter of claim 1 of all requests has been amended with regard to the subject-matter of claim 1 as originally filed by adding the following feature:

"which film is not microporous or voided".

Literal support for this wording can be found in the description as originally filed on page 2, lines 11 to 13.

This literal support, however, additionally specifies that the films

- do not absorb ammonia to any appreciable extent,
- do not transmit ammonia to any significant extent, and
- that ammonia odours are "contained".

As there is no other support to be found in the description for such an amendment, it remains to be evaluated whether the feature of "not microporous or voided" can be claimed independently of the feature relating to the ammonia absorption/transmission.

In the originally filed application a definition of suitable elastic films by reference to their limited transmissibility and lack of absorption with respect to ammonia was provided, in addition to the above cited passage, by the subject-matter of originally filed claims 16 and 31, which disclosed a laminate wherein the film substantially blocked the passage of ammonia odour. Such a film clearly had to be free of micropores

and voids which would be large enough to allow the passage of ammonia.

The requirement that the features of "no micropores or voids" and "blockage of ammonia odours" be combined imposes certain limitations on the choice of the material for the elastic film. A suitable polymeric material for the breathable elastic film has to have appropriate absorption, penetration and diffusion characteristics relative to the specific small molecules of water and ammonia. These diffusion characteristics vary depending on the material characteristics (chemical structure, sort and degree of cross-linking, thickness) of the polymer, as well as on atmosphere, temperature and pressure difference. These diffusion characteristics are not further specified in the patent in suit but are included via the functional features of blockage of ammonia odour and an appropriate water vapour transmission rate. In particular, the thickness of the film is determined via such a combination of features.

Thus, the application as originally filed does not provide a disclosure of an elastic film of the kind defined by the wording in claim 1, which refers only to the film being neither microporous nor voided. Instead, the application as filed discloses only a breathable elastic film formed from an elastic polymeric material that exhibits an ability to absorb and diffuse water vapour, which film is neither microporous nor voided and which film substantially blocks the passage of ammonia odour. As a consequence, the terminology used to define the film in claim 1 is a generalisation of the features disclosed in the application as filed for

which there is no basis, and consequently the requirements of Article 123(2) EPC are not met.

- 1.2 This objection applies to claim 1 of all requests. For this reason alone, none of the requests is allowable.
2. In view of the above negative conclusions regarding in particular the requirements set out in Article 123(2) EPC, the Board decided not to admit into the proceedings any of the late-filed claims submitted as the main or first to fifth auxiliary requests. 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:

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

The Registrar:

The Chairman:

S. Sánchez Chiquero

P. Alting van Geusau