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**Datasheet for the decision
of 6 March 2007**

Case Number: T 1343/05 - 3.2.06

Application Number: 97304539.6

Publication Number: 0815820

IPC: A61F 13/15

Language of the proceedings: EN

Title of invention:

Disposable body fluids absorbent article

Patentee:

UNI-CHARM CORPORATION

Opponent:

Paul Hartmann AG

Headword:

-

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

"Amendments (main request and 1st auxiliary request) - added subject-matter"

"Late-filed requests not admissible"

Decisions cited:

T 0284/94, T 1067/97

Catchword:

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Case Number: T 1343/05 - 3.2.06

D E C I S I O N
of the Technical Board of Appeal 3.2.06
of 6 March 2007

Appellant: UNI-CHARM CORPORATION
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 8 July 2005
revoking European patent No. 0815820 pursuant
to Article 102(1) EPC.

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I. European Patent Nr. 0 815 820, granted on application Nr. 9304539.6, was revoked by the opposition division by decision posted on 8 July 2005. The opposition division came to the conclusion that the invention was sufficiently disclosed, that the subject-matter of claim 1 of the main request met the requirements of Article 123(2) EPC and 84 EPC, and was novel over the disclosure in

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but did not involve an inventive step having regard to the third and second embodiments disclosed in D3. The auxiliary request filed at the end of the oral proceedings was late filed and comprised additional features from the description. It was not allowed in view of a further search being considered necessary in order to assess the patentability of this request.

II. The appellant (patentee) filed a notice of appeal against this decision on 7 September 2005, and paid the appeal fee simultaneously. On 18 November 2005 the statement of grounds of appeal was filed, accompanied by new sets of claims in accordance with a main request and an auxiliary request.

III. With a communication dated 9 November 2006, accompanying the summons to oral proceedings, the board set out its preliminary opinion. Further discussion was indicated as being needed as to whether the current claim 1 comprised all the features of the embodiment described in relation to Figure 2 to fulfil the

requirements of Articles 123(2) EPC. Furthermore, D3 appeared to be prior art under Article 54(3) EPC and therefore did not appear a suitable starting point for the discussion of inventive step.

IV. Oral proceedings were held on 6 March 2007.

The appellant requested that the decision under appeal be set aside and the patent be maintained on the basis of the main request filed with the grounds of appeal, alternatively on the basis of the first auxiliary request filed with letter dated 6 February 2007 alternatively on the basis of the second, third or fourth auxiliary requests filed during the oral proceedings.

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

Claim 1 according to the main request reads as follows:

"A disposable body fluids absorbent article comprising

- a) a topsheet (2) on a skin-contactable side,
- b) a backsheet (3) on a non-skin-contactable side,
- c) and a tape fastener (21) adapted to fasten the body fluids absorbent article soiled with excretions in a rolled up condition thereof in a predetermined direction, characterised in that
- d) said tape fastener is unfolded in its un-used condition and comprises:
- e) a lower end member (22),
- f) an upper end member (23) and
- g) an intermediate member (24) between the lower and upper member,

- h) wherein the substantially non-stretchable fixed end portion (22) secured to an outer surface of said backsheet,
- i) a substantially non-stretchable free end portion (32) of the upper end member longitudinally opposite to said fixed end portion (22) and
- j) adapted to be held by the user's fingers,
- k) an elastically stretchable portion (24) longitudinally extending in an unstretched condition from said fixed end portion (22) towards said free end portion (32) and
- l) a substantially non-stretchable adhesive portion (28) longitudinally extending between said free end portion (32) and said elastically stretchable portion (24)
- m) with an inner surface of said adhesive portion (28) facing the outer surface of said backsheet (3) and releasably directly bonded to said outer surface,
- n) the members (22, 23) are formed by stripes provided separately of the intermediate member (24)."

Claim 1 according to the 1st auxiliary request reads as follows:

"A disposable body fluids absorbent article comprising

- a topsheet (2) on a skin-contactable side,
- a backsheet (3) on a non-skin-contactable side,
- and a tape fastener (21) adapted to fasten the body fluids absorbent article soiled with excretions in a rolled up condition thereof in a predetermined direction,
- said tape fastener is unfolded in its un-used condition,

- characterised in that said tape fastener (21) comprises:
 - a substantially non-stretchable fixed lower end member (22), secured to an outer surface of said backsheet,
 - a substantially non-stretchable upper end member (23)
 - and an intermediate member (24) extending between the lower and upper member (22, 23),
 - a substantially non-stretchable free end portion (32) longitudinally opposite to said fixed lower end member (22) and
 - adapted to be held by the user's fingers,
 - wherein the intermediate member (24) having an elastically stretchable portion (31) longitudinally extending in an unstretched condition from said fixed lower end member (22) towards said free end portion (32), and
 - a substantially non-stretchable adhesive portion (28) longitudinally extending between said free end portion (32) and said elastically stretchable portion (24)
 - with an inner surface of said adhesive portion (28) facing the outer surface of said backsheet (3) and releasably directly bonded to said outer surface, wherein
 - the members (22, 23) are formed by the strips provided separately of the intermediate member (24)."

Claim 1 according to the 2nd auxiliary request is based upon claim 1 of the main request, claim 1 according to the 3rd auxiliary request is based upon claim 1 of the 1st auxiliary request. Claim 1 of the 2nd auxiliary request as well as claim 1 of the 3rd auxiliary request

contain additionally the following features which are specified as features o) and p) in claim 1 according to the 2nd auxiliary request and without the letters o) and p) in claim 1 according to the 3rd auxiliary request:

"o) wherein the lower end member (22) having its entire inner surface applied with a first adhesive (26) so that the lower end member (22) is bonded to a lower end portion (27) of the intermediate member (24) over a second applied zone (26B) of the first adhesive (26) and to the outer surface of the backsheet (3) over a first adhesive zone (26A) of the first adhesive (26),
p) and the upper end member (23) having its inner surface applied with second adhesive (28) so that the upper end member (23) is bonded to an upper end portion (29) of the intermediate member (24) over a third adhesive zone (28A) of the second adhesive (28) and to the outer surface of the backsheet (3) over a fourth adhesive zone (28B) of the second adhesive (28)."

Claim 1 according to the 4th auxiliary request is based on claim 1 of the 2nd auxiliary request. It differs from this latter claim 1:

- in feature g) the word "extending" is added between "an intermediate member (24)" and "between"
- in features h) and i) the reference number (22) is deleted
- in features k) and l) the reference number (24) is changed to (31)
- in feature m) the word "directly" is deleted
- in feature p) at the end the wording is added "and to a film member (35) to be held by the user's fingers"

over a fifth adhesive zone (28C) of the second adhesive (28),"

- in additionally containing the following features:
"q) wherein all the adhesive zones (26A, 26B, 28A, 28C) except the fourth adhesive zone (26B) bond to the members (22, 23, 24, 35) and the backsheet (3) to those opposed to them, respectively, so firmly that these members and the backsheet cannot be separated from one another and

r) wherein over the fourth adhesive zone (28B) the tape fastener (21) is releasably bonded to the backsheet (3) by means of applying the outer surface of the backsheet (3) with a mold release agent and/or regulating an adhesive power of the second adhesive (28), and

s) wherein the intermediate member (24) has the elastically stretchable portion (31) of a predetermined length between the lower end member (22) and the upper end member (23)."

V. The appellant argued essentially as follows:

With respect to the main request, the features added to the subject-matter of the granted claim 1 could be identified in Figure 2 of the patent in suit and they were clear in themselves. Since the skilled person would recognize that various options existed for the embodiment disclosed it was not necessary to include each and every feature of the embodiment of Figure 2. Originally filed claim 1 had a much broader scope and therefore, the present wording of the claim represented a restriction of the scope of protection. Hence, the requirements of Article 123(2) and (3) EPC were met.

With respect to the 1st auxiliary request, the features of its claim 1 corresponded to the features of claim 1 of the main request. The amendments concerned the wording "portion" and "member". Hence, this request was made in order to overcome the clarity objections.

The 2nd auxiliary request should be admitted into the proceedings. Further features relating to the embodiment shown in Figure 2 were inserted into claim 1. These features related to the adhesive zones in the upper and lower end members and clarified the location of their different portions. Again, therefore, the clarity objections raised were dealt with. It was not necessary to insert the feature relating to the film member of the free end portion since this feature was not related to the inventive concept of the patent in suit. No new search was necessary in respect of this claim because the features were in close identity with the features already searched in the existing search report. The features limited the scope of protection of the claim and thus the request should be admitted.

Claim 1 of the 3rd auxiliary request corresponded in its features and amendments to claim 1 of the 2nd auxiliary request and thus the arguments set out for claim 1 of the 2nd auxiliary request applied as well. It was filed having regard to the clarity issues and in conformity with the filing of the main and 1st auxiliary requests.

Concerning the 4th auxiliary request, its claim 1 was based upon claim 1 of the 2nd auxiliary request. All features of the embodiment shown in Figure 2 were specified by the additional features o) to s).

Furthermore, feature g) of the claim was amended with a view to clarity (i) by the addition of the word "extending", (ii) by partly deleting and partly changing the reference numbers in features h), i), k), l), and (iii) by deletion of the word "directly" which was objected to in feature m). In particular the added features o) to s) referring to the end members, the adhesive zones, the film member and the intermediate member restricted the scope of claim 1 to the subject-matter of the embodiment shown in Figure 2.

No necessity for a new search arose due to the subject-matter of claim 1 of this request. Mould release agents and agents for regulating the adhesive power of an adhesive did not concern the inventive idea of the claimed subject-matter which related to the design of the fastener and furthermore, were well-known to the skilled person.

VI. The respondent argued essentially as follows:

Claim 1 of the main request contained features which could only be derived from the embodiment shown in Figure 2, for example features e) to g) and the reference in feature m) to the backsheet being "directly" bonded. Since these features were disclosed only in a specific combination it was necessary to insert all the other features of this embodiment. Therefore, the requirements of Article 123(2) EPC were not met. Neither was the claim clear. The terms "portion" and "member" were used such that they seemingly referred to different "portions" or "members".

With respect to claim 1 of the 1st auxiliary request, the amendments concerned the wording in relation to "portion" and "member" and the term "fixed end portion" which was present in claim 1 as granted, was omitted. However, due to this omission, the scope of protection of claim 1 was extended (Article 123(3) EPC). In any event, the amendments neither overcame the clarity objections nor had the effect of meeting the objections under Article 123(2) EPC already made with respect to the main request.

With respect to the 2nd and 3rd auxiliary requests, these requests were late filed. They should not be admitted. When considering claim 1 of these requests, the claim still did not include all features of the embodiment shown in Figure 2. Particularly with respect to the upper end member it was not specified that there had to be a film member 35 over a fifth adhesive zone 32 in order to establish the free end portion which should be adapted to be held by a user's fingers. Other possibilities were now within the scope of the claim for example nonwoven or folded end portions. However, these options were neither disclosed in combination with Figure 2 nor in combination with any other embodiment (Article 123(2) EPC). The clarity issues indicated for claim 1 of the main request persisted in claim 1 of the 2nd auxiliary request. The omission of the term "fixed end portion" and the related objection set out for the 1st auxiliary request remained an issue with regard to claim 1 of the 3rd auxiliary request. Hence, both requests could not be considered as being *prima facie* allowable.

With respect to the 4th auxiliary request, this request was filed at the last possible moment during the oral proceedings. For it to be admitted it was necessary that it *prima facie* met the requirements of Article 123(2) EPC which was not the case. In the embodiment shown in Figure 2, the intermediate member (24) was identical to the elastically stretchable portion (31). According to the inserted feature s) no such identity was required. Even the appellant was of the view that Figure 2 disclosed only one material for the intermediate member (24), whereas the claim now included further options in this respect. This led not only to an intermediate generalisation of the embodiment shown in Figure 2 (Article 123(2) EPC) but also to a lack of clarity with respect to the location of the elastically stretchable portion (Article 84 EPC).

Furthermore, in the originally filed application the wording of feature q) also included the term "these members and the backsheet practically cannot be separated from one another" [emphasis added]. The omission of the term "practically" resulted in an extension of the content of the application as filed (Article 123(2) EPC). Further objections with regard to Articles 84 and 83 EPC could be raised in particular with regard to feature r) which included the application of "a mold release agent and/or regulating an adhesive power of the second adhesive" without indicating how this was done. Furthermore, this feature was taken from the description and the search had probably had not covered this aspect. For all these reasons, this request was not *prima facie* allowable and should not be admitted into the proceedings.

Reasons for the Decision

1. The appeal is admissible.
2. *Main request and 1st auxiliary request (Article 123(2) EPC)*
 - 2.1 Claim 1 of the main request comprises in addition to the features of claim 1 as originally filed the following features quoted in italics which all concern further details of the tape fastener mentioned in the pre-characterising portion of the claim:
 - e) *a lower end member (22),*
 - f) *an upper end member (23) and*
 - g) *an intermediate member (24) between the lower and upper member,*
 - h) *wherein the substantially non-stretchable fixed end portion (22) secured to an outer surface of said backsheet,*
 - i) *a substantially non-stretchable free end portion (32) of the upper end member longitudinally opposite to said fixed end portion (22) and*
 - m) *with an inner surface of said adhesive portion (28) facing the outer surface of said backsheet (3) and releasably directly bonded to said outer surface,*
 - n) *the members (22, 23) are formed by the strips provided separately of the intermediate member (24).*
 - 2.2 Claim 1 of the 1st auxiliary request incorporates the features of claim 1 of the main request and additionally specifies that

- the lower and the upper end member are substantially non-stretchable and
- the elastically stretchable portion (specified in claim 1 of the main request) is now part of the intermediate member.

- 2.3 The above features are taken from the description on page 7, lines 10 to 20 and page 11, lines 13 to 15 of the originally filed application. The quoted paragraph on page 7 refers to Figure 2 which is a sectional view taken along line II-II of Figure 1. It is not in dispute that these features are mentioned *expressis verbis* in the application as filed.
- 2.4 However, since the subject-matter of claim 1 of the main and 1st auxiliary requests is directed to the embodiment disclosed in relation to Figures 1 to 3, it first has to be assessed whether the new combination of features claimed has a proper basis in the application as filed. Figure 2 shows first to fifth adhesive zones of the upper and lower members. The relevance of these adhesive zones with respect to either firmly or releasably bonding the different portions of the two members is referred to on page 8, first paragraph of the application as filed, which paragraph forms a continuation of the paragraph cited on page 7. In Figure 2, the features referring to the five adhesive zones show a technically functional relationship of the different parts of the fastener. Thus they represent essential parts of the tape fastener disclosed in this embodiment. These features cannot be deleted from the set of features which were originally disclosed in combination for that embodiment. Since these features are missing in the respective claims 1 of the main and

1st auxiliary requests, the requirements of Article 123(2) EPC are not met.

2.5 The appellant argued that it would be immediately apparent to the skilled person that the omitted features were not essential to the invention and since the scope of the claim was limited by features themselves clearly disclosed in the application as filed, the objection was unfounded. Anyhow, it was the practice before the national courts when establishing the scope of protection to ignore all features in a claim that were non-essential to the invention so that any introduction of non-essential features did not really limit the scope of the claim.

2.6 The board is unaware of a general practice of the national courts of the kind alleged by the appellant. In any case such practice would be contrary to Article 69 EPC, which stipulates that the extent of protection conferred by a European patent shall be determined by the terms of the claims. Having regard also to the protocol on the Interpretation of Article 69 EPC, there is no legal basis for saying that technical features specified in a claim can be ignored when assessing the scope of protection.

When amending a claim to incorporate further features, it is not sufficient to establish that the additional features are themselves present in the application as filed: it is the combination in which these features are disclosed that is decisive for answering the question whether the requirements of Article 123(2) EPC are fulfilled or not. When assessing whether any new combination is "complete", so as to comprise all the

features disclosed in the original combination, this should be done on the basis of what the skilled person in the technical field involved would derive in a clear and unambiguous manner from the application as filed.

Applying these principles to the subject-matter of the preferred embodiment disclosed in relation to Figures 1 to 3 of the application as filed, for the reasons set out above the skilled person has no basis whatsoever to consider the specific arrangement of the adhesive regions as shown in Figure 2 as irrelevant to the embodiment disclosed or that they do not belong to the "invention" now further specified on the basis of the embodiment of Figures 1 to 3.

3. *Procedural considerations concerning the 2nd to 4th auxiliary request*

In its communication the board raised the point of added subject-matter as regards the assertion that the embodiment shown in Figure 2 formed the basis of the amendments. The appellant submitted amended claims in form of the 2nd to 4th auxiliary requests during the oral proceedings in disregard of the time limit set by the board. No reasons were given for the delay. It is in the discretion of the Board to accept late filed requests (Article 10b(1) RPBA, Article 114(2) EPC). Also in accordance with the case law of the Boards, late filed requests should *a priori* constitute formally acceptable requests.

3.1 2nd and 3rd auxiliary requests

3.2 As already pointed out above, the embodiment shown in Figure 2 and its corresponding description contain explicit reference (*inter alia*) to the first to fifth adhesive zones. All these adhesive zones represent functionally related parts of the tape fastener disclosed in this embodiment. Thus, there is no clear and unambiguous disclosure to be found in the application as filed of a tape fastener as claimed in claim 1 comprising only four adhesive zones. Such a claim would include *inter alia* the possibility of having no adhesive at all on the free end portion which is adapted to be held by a user's fingers. For this reason claim 1 of both requests contains added subject-matter.

For this reason, claim 1 of the 2nd and 3rd auxiliary requests is not *prima facie* clearly allowable for reasons of Article 123(2) EPC and therefore neither the 2nd auxiliary request nor the 3rd auxiliary request were admitted into the proceedings.

3.3 4th auxiliary request

3.3.1 According to the embodiment shown in Figure 2, the intermediate member (24) is identical to the elastically stretchable portion (31). For the intermediate member (24) no other/differing portions or members are shown and the length of the elastically stretchable portion is identical to the length of the distance between the upper and the lower members.

3.3.2 Contrary to this, in the claimed feature s), the chosen wording "wherein the intermediate member (24) has the elastically stretchable portion (31) of a predetermined

length between the lower end member (22) and the upper end member (23)" leaves various options open. On the one hand it allows other or differing portions to be comprised in the intermediate member. On the other hand it also leads to the assumption that the length of the elastically stretchable portion is not the same as the distance between the upper portion and the lower portion. The length of the elastically stretchable portion plays an important functional role and the structural identity of the intermediate member with the elastically stretchable portion further clarifies the extension of the elastically stretchable portion.

3.3.3 Hence, the board cannot agree with the appellant's view that all features which are functionally and structurally relevant in the claimed embodiment are reflected in the claim. Thus, the subject-matter of claim 1 of the 4th auxiliary request is also not *prima facie* clearly allowable and this request was not admitted into the proceedings.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Patin

P. Alting van Geusau