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**Datasheet for the decision
of 31 January 2008**

Case Number: T 1490/05 - 3.2.06

Application Number: 98946201.5

Publication Number: 0941040

IPC: A61F 13/15

Language of the proceedings: EN

Title of invention:
Absorbent article having flaps

Patentee:
JOHNSON & JOHNSON INC.

Opponent:
The Procter & Gamble Company

Headword:
-

Relevant legal provisions:
-

Relevant legal provisions (EPC 1973):
EPC Art. 100(b)

Keyword:
-

Decisions cited:
-

Catchword:
-



Case Number: T 1490/05 - 3.2.06

DECISION
of the Technical Board of Appeal 3.2.06
of 31 January 2008

Appellant:
(Opponent)

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Representative:

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Respondent:
(Patent Proprietor)

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Representative:

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Decision under appeal:

Decision of the Opposition Division of the
European Patent Office posted 7 October 2005
rejecting the opposition filed against European
patent No. 0941040 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: P. Alting Van Geusau
Members: M. Harrison
W. Sekretaruk

Summary of Facts and Submissions

- I. The appellant (opponent) filed an appeal against the decision of the opposition division, posted on 7 October 2005, rejecting the opposition against European patent number 0 941 040 and requested revocation of the patent.
- II. Subsequent to the response of the proprietor (respondent) in which dismissal of the appeal was requested, the Board summoned the parties to oral proceeding and issued a communication indicating *inter alia* that, with respect to Article 100(b) EPC, due to the apparent need to make an arbitrary choice to arrive at the subject matter of claim 1, the skilled person was faced with an undue burden in performing the invention.
- III. Oral proceedings were held before the Board on 31 January 2008, during which the parties confirmed their original requests.
- IV. Claim 1 reads as follows:
- "1. A sanitary absorbent article (20) comprising:
(A) a main body (21), said main body (21) having a first longitudinal side (40), a second longitudinal side (42) opposing the first longitudinal side (40), two opposing transverse sides (36, 38);
(B) a first flap (44) united with said main body (21), said first flap (44) projecting laterally from the first longitudinal side (40) of said main body when the article (20) is in a flattened state and being capable of being folded over a crotch portion of a wearer's

undergarment (18); said first flap (44) having a garment-facing surface including a fastener (83) for securing said first flap (44) to the undergarment (18); (C) a second flap (46) united with said main body (21), said second flap (46) projecting laterally from the second longitudinal side (42) of said main body (21) when the article is in a flattened state and being capable of being folded over the crotch portion of the undergarment (18), said second flap (46) having a garment-facing surface including a fastener (86) for securing said second flap (46) to the undergarment (18); wherein each fastener (83, 86) has a longitudinal length of not less than 85% of the length of the proximal side of its flap characterised in that each fastener (83, 86) has;

- (1) a central zone having an adhesive strength; and
- (2) a terminal zone closer to a transverse side (248, 250) of the flap (244) than the central zone, the terminal zone having an adhesive strength, the adhesive strength of the terminal zone being less than the adhesive strength of the central zone."

V. The submissions of the appellant may be summarised as follows:

The central zone and terminal zone had no defined boundaries; paragraph [0040] confirmed that the fastener was "loosely" divided into zones, so specific boundaries were not intended. This meant an undue burden for a skilled person attempting to perform the invention over the whole scope of claim 1, since, for any chosen fastener, the zones could be arbitrarily varied to be of almost any size whatsoever within the bounds of the fastener. The adhesive strength of such

arbitrarily determined zones likewise varied arbitrarily. Adhesive strength could only be understood as relating to the zone per se; no support existed anywhere in the patent for interpreting this to mean the adhesive strength per unit area, nor of the particular zone since this was undefined. The various embodiments identified in the patent as being embodiments of the invention used the same adhesive, and thus also had the same adhesive strength per unit area. From the patent it could not be derived that the embodiment of Figure 2b should be the only embodiment falling under the claim, because all other embodiments depicted in the Figures were explicitly disclosed also as embodiments of the invention. Figure 2b was anyway itself not an embodiment, since it did not satisfy the relative dimensional features of claim 1 and it was anyway impossible to identify where the boundaries of the central and terminal zones were in fact positioned in the Figure.

VI. The submissions of the respondent may be summarised as follows:

Viewing the invention through the eyes of a skilled person, there would be no difficulty in performing the invention of claim 1; this merely required identifying a central zone which was the zone of higher strength compared to a terminal zone of lesser strength. Producing a difference in strength was disclosed in the patent in e.g. paragraph [0041]. Adhesive strength clearly referred to strength per unit area; the whole zone should be considered and any other meaning was nonsensical in the context of the patent. Evidence of the understanding of this terminology was available,

for example by looking at the meaning of "adhesive strength" in the internet. Paragraphs [0039], [0040], [0041] indicated clearly to a skilled person how such zones of differing adhesive strength could be created. Following this teaching the skilled person had no difficulty in arriving at the subject matter of claim 1. If, in a particular fastener, no zones of differing strength per unit area were present (unlike the embodiment illustrated in Figure 2b where such zones were depicted), the arrangement would simply not fall under the claim. Although the embodiments in the patent, apart from Figure 2b, were identified in the patent itself as being "embodiments" of the invention, this was simply an error of adapting the description correctly to the claims during prosecution. These embodiments in fact related only to the disclosed invention in the first filed application and adaptation of the description would overcome the inconsistency. In the embodiment depicted in Figure 2b, the central zone was clearly identifiable as being the central fastener strip whereas the gaps on either side of its ends belonged to the terminal zones, these latter zones being made up of the outer strips and the gaps. This was clearly explained in paragraph [0070]. The skilled person thus had all the information required to perform the invention over its whole scope.

Reasons for the Decision

Sufficiency (Article 100(b) EPC 1973)

1. Claim 1 defines a central zone and a terminal zone, without specifying any size limits to either of these

zones. The area and boundaries of the zones are thus entirely indeterminate. When attempting to resolve this matter by reference to the description, this states in paragraph [0040] that:

"a fastener is loosely divided into three zones, a first terminal zone closer to the first transverse side of the flap, a second terminal zone closer to the second transverse side and a central zone intermediate the two terminal zones."

From this statement, it is also evident that no "specific" boundaries for the zones are intended to be present, merely "loose" ones. It is also clear that the ends of the central zone do not necessarily form the start of the terminal zone(s) and that the terminal zones themselves are not necessarily conterminous with the outer ends of the fastener.

In relation to the zones in general, the description states in paragraph [0040] that:

"the term "zone" should be understood as including discontinuities (e.g. gaps) in the fastener which the length of such gaps is small relative to the longitudinal length of the fastener."

2. Thus, the skilled person is presented with the information that, there are no fixed boundaries for the zones and that in the zones themselves there may be discontinuities. There is nothing indicating that this statement is directed only to the terminal zone(s); as

far as can be understood, it may equally apply to the central zone. Whether a discontinuity along a fastener should be included within a central zone or a terminal zone will thus seemingly be an arbitrary choice, but nevertheless a choice which would alter the adhesive strength.

3. The respondent has argued that only Figure 2b, which contains such discontinuities corresponds to the claimed invention and that this would be clear to a skilled person. However, the patent contains several examples which are described as "embodiments" of the invention. For example, paragraph [0044] contains a brief description of the Figures, referring to each of Figures 1 to 4 as being embodiments of the invention, while paragraph [0045] refers to the drawings as illustrating "preferred embodiments". Paragraph [0046] continues by referring to Figure 1 as being "the preferred embodiment", while paragraphs [0070] to [0072], under the heading "Alternate Embodiments", describe Figures 2b, 3 and 4 as being "an alternate embodiment of the present invention", "another embodiment of the present invention" and "another alternate embodiment of the invention" respectively.

4. Thus, the Board finds that it cannot be deduced unambiguously by a skilled person that only Figure 2b must be regarded as being the only "true" embodiment of the invention. The argument that the description has simply not been adapted properly to the claims is thus found unconvincing. Moreover, the invention defined by claim 1 still includes the embodiments of Figures 1, 3 and 4, for example, within its scope. Additionally, it may be noted that even if the description were adapted

by removing the embodiments, the scope of claim 1 would remain unaffected.

5. The embodiments (in addition to that shown in Figure 2b) contain rectangular adhesive fasteners having adhesive material over their entire surface, whereby it is not possible to identify any physical zone boundary which would necessarily belong to the central zone or the terminal zone. Nevertheless, an arbitrary placement of the boundaries of the central zone so as to lie a certain distance on either side of the centre, with at least one terminal zone starting at the end of one fastener and extending towards the centre of the fastener so as to cover a smaller distance than covered by the central zone, would meet the requirements of the claim since the central zone (by virtue of its larger surface area and the same type of adhesive used over the entire surface area) would automatically provide a greater adhesive strength than in the terminal zone. Choosing, again arbitrarily, the terminal zone to extend towards the centre so as to cover a larger area than the central zone would produce the opposite result. A product having a fastener lying within, or outside, the subject matter of claim 1 thus relies on an arbitrary selection of where to place the boundaries of the zones. The patent is however silent on the way in which the selection is to be made.

6. With reference to Figure 2b as such, the description thereof in paragraph [0070] refers to a "centre rectangle" with four further rectangles, two of which are positioned "on either side of the central one". The patent further states that the gaps present between the rectangles are to "reduce the adhesive strength of the

adhesive 283 in the areas closer to the transverse sides 248, 250 of the flap." In conjunction with paragraph [0041] of the patent, the Board finds that, although the terminology "area" is used to describe the rectangles of adhesive in Figure 2b, a skilled person would be able to understand the embodiment of Figure 2b as representing one single embodiment whereby the adhesive strength of the terminal zones had been reduced by including gaps and that a central zone could be chosen somewhere within the central area, without gaps, to have a greater strength than the terminal zones. The boundary of the terminal zones and the central zone is however not indicated. Even if the central area were taken to be the same thing as the central zone, and the entire area of gaps and strips outside of that to be the terminal zones, the Figure 2b embodiment would then represent only one specific example of how to configure zones, as such, to fall within claim 1. Claim 1 however is not limited by any means to the embodiment of Figure 2b. Thus, the scope of the invention according to claim 1 includes fasteners with for example any shape or type of adhesive or discontinuity at any location thereon, also including rectangular areas of continuous coverage of adhesive (as in e.g. Figures 1, 3 and 4 of the patent) where only the arbitrary selection of the boundaries of the central and terminal zones provides a result which may or may not meet the requirements of the claim.

Although further examples are given in paragraph [0041] of how the adhesive properties of the terminal zones could be altered (e.g. by using different chemical formulations), claim 1 is also not limited in any way

to embodiments where the different zones themselves are defined by different adhesive properties.

7. The respondent's argument that the zones are simply chosen so as to lie where the adhesive strength (as measured per unit area) meets the requirements of claim 1, is unconvincing. First, the patent itself does not define adhesive strength as being a strength per unit area. Nor is there any evidence which suggests that this would be the normal and accepted interpretation for a skilled person. The patent teaches, on the contrary (see e.g. paragraph [0070] lines 4 to 10,) that the adhesive used may indeed be the same in all areas of the fastener, such that the adhesive strength per unit area, depending on where it was measured, may be identical. A determination of the strength per unit area of the entire zone could produce a different result, but this in turn would require that the boundaries of the zones (which were to be measured for a test of adhesive strength per unit area) were also known in advance, i.e. something not stated in the patent.

8. Thus, in summary, whilst the Board accepts that some specific embodiments can be arrived at which would fall within the scope of claim 1, claim 1 includes within its scope innumerable embodiments (including those indicated within the patent as being embodiments of the invention) where only an arbitrary selection of zone boundaries allows the skilled person to perform the invention. The necessary reliance upon an arbitrary choice of where to place particular zones is however, for a skilled person, neither sufficiently clear nor

complete information for performing the invention over the whole scope of the claims.

The appellant's objection based on Article 100(b) EPC (1973) therefore prejudices maintenance of the patent.

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:

M. Patin

P. Alting van Geusau