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**Datasheet for the decision
of 6 May 2008**

Case Number: T 0141/07 - 3.2.06

Application Number: 98952373.3

Publication Number: 1027022

IPC: A61F 13/15

Language of the proceedings: EN

Title of invention:

Web materials with two or more skin care compositions disposed thereon and articles made therefrom

Patentee:

THE PROCTER & GAMBLE COMPANY

Opponents:

SCA Hygiene Products AB
Johnson & Johnson GmbH

Headword:

-

Relevant legal provisions:

EPC Art. 123(2)

Relevant legal provisions (EPC 1973):

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Keyword:

"Main request: Amendments not allowable"
"Auxiliary requests 1-3: not admitted (reformatio in peius)"

Decisions cited:

G 0001/99, G 0004/93

Catchword:

-



Case Number: T 0141/07 - 3.2.06

D E C I S I O N
of the Technical Board of Appeal 3.2.06
of 6 May 2008

Appellant: SCA Hygiene Products AB
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Other Party: Johnson & Johnson GmbH
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
29 December 2006 concerning maintenance of
European patent No. 1027022 in amended form.

Composition of the Board:

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

Summary of Facts and Submissions

- I. European Patent Nr. 1 027 022, granted on application Nr. 98 952 373.3, was maintained in amended form by decision of the opposition division posted on 29 December 2006.
- II. The opposition division held that the patent in suit disclosed the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 100(b) EPC), but found that the subject-matter of claim 1 in accordance with the patent proprietor's main request and first auxiliary request was not novel (Article 54 EPC) over the disclosure in
D13 DE-A-38 30 056.
Concerning the second auxiliary request, the opposition division came to the conclusion that the subject-matter of its claim 1 met the formal requirements of Article 84 EPC and Article 123(2) EPC, was novel (Article 54 EPC) and also involved an inventive step (Article 56 EPC) with regard to the disclosures of
D2 WO-A-97/05908,
D3 WO-A-97/05909 or
D9 US-A-5 607 760 when taken in combination with the teachings of either
D11 WO-A-94/15562 or
D13 DE-A-38 30 056.
- III. The appellant (opponent I) filed a notice of appeal against this decision on 25 January 2007, and paid the appeal fee simultaneously. On 11 April 2007 the statement of grounds of appeal was filed. It was argued that the subject-matter of claim 1 as maintained by the

- opposition division lacked clarity (Article 84 EPC), contravened Article 123(2) EPC and was not based on inventive step (Article 56 EPC).
- IV. In a communication dated 30 November 2007 accompanying the summons to oral proceedings, the Board indicated that the formal requirements of the EPC (Articles 84 and 123 EPC) would not appear to be met in the request maintained by the opposition division and needed further discussion. In particular, the reference to the group of absorbent articles as now claimed appeared only to be disclosed for disposable absorbent articles (Article 123(2) EPC). Furthermore, the claimed combination of a first skin care composition disposed on the cuffs and a second skin care composition disposed on the topsheet was not consistent with the wording of the original and granted claim 1 which referred to "a" web material as comprising a first and a second region each having corresponding skin care compositions disposed thereon (Article 84 EPC).
- V. With its letter dated 10 February 2008, the respondent (patent proprietor) filed new claims in accordance with first to third auxiliary requests.
- VI. Oral proceedings were held on 6 May 2008. The appellant (opponent I) requested that the decision under appeal be set aside and that the patent be revoked. The other party (opponent II) made the same request.
- As announced with its letter of 10 February 2008 the respondent (patent proprietor) did not attend the oral proceedings and requested in this written submission

that the appeal be dismissed, alternatively that the patent be maintained according to the first to third auxiliary requests filed with the letter.

Claim 1 according to the main request - as maintained by the opposition division - reads as follows:

"An absorbent article selected from the group consisting of diapers, incontinence pads, training pants, pantliners and sanitary napkins to be worn adjacent the skin of a wearer, the absorbent article comprising a web material comprising a first region and a second region characterized in that said first region has a first skin care composition disposed thereon, and said second region has a second skin care composition disposed thereon, said first skin care composition having a different formulation from that second skin care composition, wherein said first skin care composition is disposed in an effective amount to provide a first skin health benefit and said second skin care composition is disposed in an effective amount to provide a second skin health benefit and said article comprising cuffs, containing said first region and said first skin care composition, and a topsheet, containing said second region and second skin care composition."

Claim 1 according to the first auxiliary request differs from claim 1 according to the main request in that it refers in the introductory paragraph to a "*disposable*" absorbent article "*which comprises a chassis, comprising an outer covering layer, comprising a liquid pervious topsheet and a liquid impervious*

backsheet joined to the topsheet and an absorbent core encased within the outer covering layer, to be worn adjacent the skin of a wearer," rather than referring to the group of articles, and further in that the last paragraph starting with *"said article comprising cuffs, ..."* is deleted.

Claim 1 according to the second auxiliary request differs from claim 1 according to the first auxiliary request in that the last paragraph of claim 1 of the main request is re-inserted.

Claim 1 according to the third auxiliary request differs from claim 1 according to the first auxiliary request in that the subject-matter of claim 4 as granted is introduced, which reads as follows:

"wherein said first skin care composition comprises (i) from about 10% to about 95% of an emollient having a plastic or fluid consistency at 20°C; and (ii) from about 5% to about 90% of an agent capable of immobilizing said emollient on said web material," with the further addition: *"and having a melting point of at least 35°C."*

Furthermore, the sets of claims according to the first to third auxiliary requests differ from the set of claims according to the main request in that granted claims 3 and 7 are reinserted.

VII. In support of its requests the appellant argued essentially as follows (the other party (opponent OII) arguing the same):

The subject-matter of Claim 1 of the main request did not meet the requirements of Article 123(2) EPC. The group of absorbent articles to which claim 1 referred was defined specifically by reference to disposable absorbent articles but not to absorbent articles in general. Also absorbent articles comprising cuffs were originally disclosed only in relation to special disposable absorbent articles. The omission of the term "disposable" thus represented an unallowable extension beyond the content as originally filed.

All the late-filed auxiliary requests should not be admitted into the proceedings. The omission of the wording "selected from the group consisting of diapers, incontinence pads, training pants, pantliners and sanitary napkins," in all the auxiliary requests amounted to an extension of the protection sought and was contrary to the principle of the *reformatio in peius*. Furthermore, none of these requests met the requirements of Article 84 EPC.

VIII. With respect to its requests the respondent (patent proprietor) argued in writing essentially as follows:

With regard to the main request, original claim 9 related to "absorbent articles" and the absorbent articles were to be selected from a group of articles which were listed in paragraph [0024] and now reiterated in claim 1. Hence, there was a disclosure in the application as originally filed for a broader definition of the article claimed.

Concerning the auxiliary requests, it was originally disclosed that all these articles comprised a topsheet,

a backsheet and an absorbent core (paragraphs [0024] - [0025]). Thus, the group of articles could be replaced by such a structure of the disposable articles.

Original claim 9 was dependent on any of the preceding original claims. There was therefore a basis for all other claim amendments of the first auxiliary request. Furthermore, it was disclosed that the absorbent articles might have cuffs and a topsheet comprising different skin care compositions. Therefore, there was also a clear basis for the amendments made in claim 1 of the second auxiliary request.

Reasons for the Decision

1. The appeal is admissible.
2. *Main Request*
- 2.1 Amendments

Claim 1 according to the main request consists of a combination of originally filed claims 1, 8, 10 and additionally an insertion A requiring that the absorbent articles are "*selected from the group consisting of diapers, incontinence pads, training pants, pant liners and sanitary napkins*" and an insertion D requiring that the article comprises "*cuffs, containing said first region and said first skin care composition, and a topsheet, containing said second region and second skin care composition*".

2.2 Disclosure of the amendments

2.2.1 Originally filed claim 10 relates to an absorbent article which comprises the web material "according to any of the preceding claims". The preceding claims 1, 2 and 3, are independent claims. Therefore, there was originally disclosed the combination of the absorbent article according to claim 10 with either the web material according to claims 1, 2 or 3. The subject-matter of claim 8 was dependent on claims 1, 2 or 3 in the alternative and thus its combination with the subject-matter of claims 1 and 10 was within the scope of the claims as originally filed.

2.2.2 The wording of claim 1 includes features in addition to the combination of the features of claims 1, 8 and 10 as originally filed. One of these additional features refers to the absorbent articles being selected according to insertion A from a group of articles which is disclosed originally on page 7, lines 24 - 27. This group of articles is disclosed in this paragraph as representing "disposable absorbent articles".

2.2.3 Contrary thereto, the wording of claim 1 is not limited to "disposable" absorbent articles. Thus, there is no disclosure of the selection of such a group of articles not being "disposable" absorbent articles. Hence, the requirements of Article 123(2) EPC are not met. Therefore, the main request is not allowable and it is not necessary to consider the further objections with regard to this request.

3. *First, Second and Third Auxiliary Requests*

3.1 In claim 1 of all the auxiliary requests, the absorbent article is limited to a "disposable" absorbent article in order to overcome the above objection. Furthermore, the feature in claim 1 of the main request concerning the disposable absorbent article being "selected from the group consisting of diapers, incontinence pads, training pants, pant liners and sanitary napkins," is deleted in claim 1 of each of the auxiliary requests.

3.2 In accordance with G 1/99 (OJ EPO 2001, 381, see in particular §9.1) and G 4/93 (OJ EPO 1994, 875) a non-appealing patent proprietor may not in principle request another version of the patent during the appeal proceedings, unless this version is a restriction of the maintained version (prohibition of *reformatio in peius*).

As an exception to this principle such a request may be made in order to meet an objection put forward by the opponent/appellant or the Board during the appeal proceedings, in circumstances where the patent as maintained in amended form would otherwise have to be revoked as a direct consequence of an inadmissible amendment held allowable by the Opposition Division in its interlocutory decision (for the further conditions that apply see the Order of G 1/99).

3.3 Considering the subject-matter of claim 1 of each of the auxiliary requests this means that the introduction of "disposable" could be allowed. However, the deletion of the group of specific absorbent articles, from claim 1 of each of the auxiliary

requests is not an acceptable amendment because it is neither introduced to avoid an inadmissible amendment held allowable by the Opposition Division nor does it limit the scope of protection when compared to the maintained version. In fact the amendment leads to claims with an extended scope of protection when compared to the request allowed by the Opposition Division.

- 3.4 If only for this reason the claims in accordance with the late filed first to third auxiliary requests are not acceptable. These requests are therefore not admitted 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

T. Buschek

P. Alting van Geusau