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**Datasheet for the decision
of 16 April 2009**

Case Number: T 0314/07 - 3.3.10

Application Number: 99930242.5

Publication Number: 1091771

IPC: A61L 15/48

Language of the proceedings: EN

Title of invention:

Apertured film covers with localized wettability and method
for making the same

Patentee:

KIMBERLY-CLARK WORLDWIDE, INC.

Opponent:

The Procter & Gamble Company

Headword:

-

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

"Amendments (not allowable) - not directly and unambiguously
derivable from application as filed - characteristic described
for an intermediate product not automatically transferable to
the claimed end product"

Decisions cited:

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Catchword:

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Case Number: T 0314/07 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 16 April 2009

Appellant: The Procter & Gamble Company
(Opponent) One Procter & Gamble Plaza
Cincinnati, OHIO 45202 (US)

Representative: L'Huillier, Florent Charles
Procter & Gamble Service GmbH
Sulzbacher Strasse 40-50
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Respondent: KIMBERLY-CLARK WOLRDWIDE, INC.
(Proprietor of the patent) 401 North Lake Street
Neenah, WI 54956 (US)

Representative: Grünecker, Kinkeldey,
Stockmair & Schwanhäusser
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
27 December 2006 concerning maintenance of
European patent No. 1091771 in amended form.

Composition of the Board:

Chairman: R. Freimuth
Members: P. Gryczka
F. Blumer

Summary of Facts and Submissions

I. A notice of opposition was filed in which entire revocation of European patent 1 091 771 based on the international patent application PCT/US99/13386 was requested on the grounds of insufficiency of disclosure and lack of novelty and inventive step (Article 100(a) and (b) EPC), *inter alia*, in view of document

(1) US-A-5 520 875.

II. In an interlocutory decision issued in writing on 27 December 2006, the Opposition Division found that the European patent could be maintained in amended form on the basis of claims 1 to 14 of the then pending second auxiliary request. Claim 1 of said request (present main request) reads as follows:

"1. An absorbent material comprising:
an absorbent core;
a backing material which is substantially liquid impervious; and
a cover material comprising a polymeric film having a top planar surface and a bottom planar surface and forming a plurality of apertures; at least a portion of said plurality of apertures having an aperture region having a higher wettability than a portion of said top planar surface; and
said polymeric film comprising a surfactant reservoir whereby said aperture region is replenished with a surfactant after contact by a fluid; and
wherein said polymeric film comprises a plurality of layers and said surfactant is disposed in at least one

of said layers other than a top layer of the polymeric film."

The Opposition Division came, *inter alia*, to the conclusion that the amended claim 1 fulfilled the requirements of Article 123(2) EPC since the added feature requiring that the "surfactant is disposed in at least one of said layers other than a top layer of the polymeric film" was based on page 7, lines 16 and 17 of the application as filed.

III. The Opponent (Appellant) lodged an appeal against the above decision.

IV. With a letter dated 6 March 2009 the Respondent (Proprietor of the patent in suit) filed seven amended claims 1 as basis for seven auxiliary requests.

In claim 1 of all these auxiliary requests the feature "other than a top layer of the polymeric film" of claim 1 of the main request was replaced by the feature "except a top layer of the polymeric film".

V. According to the Appellant the basis given by the Respondent for the amendment to claim 1, namely the second full paragraph of page 7 of the application as filed, did not describe the claimed absorbent material but the method for preparing the cover material and the multilayer cover film before aperturing and bonding it to the other elements of the final absorbent material. This passage of the application as filed which described that the surfactant was present in an internal layer of the film before aperturing and further processing could not form an adequate basis for

the amendment requiring that the surfactant was not in a top layer of the film in the final absorbent article claimed, since it was known from document (1) and from the patent application itself that the surfactant present initially in an internal layer of the film migrated to the surface layer during aperturing and further processing to the final absorbent material. There was consequently no support in the application as filed for the amendment to claim 1 of the main request requiring that in the claimed absorbent article "the surfactant is disposed in at least one of said layers other than a top layer of the polymeric film" or that of claim 1 of the auxiliary requests requiring that "the surfactant is disposed in at least one of said layers except a top layer of the polymeric film", with the consequence that the amendments extended the subject-matter beyond the content of the application as filed.

- VI. According to the Respondent, the amendment to claim 1 requiring that the surfactant was not in a top layer of the polymeric film was based on the second full paragraph of page 7 of the application as filed. Although, this passage concerned the method for preparing the cover material, it described nevertheless that the surfactant was compounded internally and not in a top layer of the polymeric film. The migration of the surfactant to the top layer described in document (1) required that the film be heated during a sufficient time at a given temperature. This migration could, however, not occur when aperturing the film according to the patent in suit and bonding it to the other elements of the absorbent material since the exposition to heat was not sufficient during these

steps. Therefore, the location of the surfactant in the internal layer described on page 7 of the application as filed remained unchanged during the further processing steps leading to the final claimed absorbent article. There was consequently a support in the application as filed for the amendment to claim 1 of the main request requiring that in the claimed absorbent article "the surfactant is disposed in at least one of said layers other than a top layer of the polymeric film". The same conclusions applied to the amendment of claim 1 of the auxiliary requests 1 to 7 requiring also by the introduction of the expression "the surfactant is disposed in at least one of said layers except a top layer of the polymeric film" that the surfactant was not in a top layer of the film in the final absorbent article. Thus, amended claim 1 of the main request and that of the auxiliary requests 1 to 7 fulfilled the requirements of Article 123(2) EPC.

VII. The Appellant requested that the decision under appeal be set aside and that the patent be revoked.

The Respondent requested that the appeal be dismissed (main request), or subsidiarily, that the patent be maintained on the basis of one of the auxiliary requests 1 to 7 filed with the letter dated 6 March 2009.

VIII. At the end of the oral proceedings which took place on 16 April 2009 the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.

Main request

2. *Amendments (Article 123(2) EPC)*

- 2.1 Claim 1 as maintained by the Opposition Division comprises the substantial amendment requiring that in the claimed absorbent article the surfactant is disposed in at least one of the layers of the polymeric film "other than a top layer of the polymeric film". This amendment is intended to specify that there is no surfactant in a top layer of the polymeric film in the claimed absorbent material. According to the Respondent this amendment finds a support in the second full paragraph on page 7 of the application as filed.

- 2.2 It is established jurisprudence of the Boards of Appeal that an amendment to a claim offends against Article 123(2) EPC, if the amended subject-matter is not directly and unambiguously derivable from the application as filed. In the present case, it is not disputed that the passage on page 7 cited by the Respondent as support for the amendment to claim 1 does not describe the absorbent material *per se* but the method for preparing the film used in the preparation of the claimed absorbent material. In these circumstances, the question arises whether the amendment of the claim directed to the absorbent material is nevertheless directly and unambiguously derivable from a passage of the application as filed

not describing the final absorbent material as such but the preparation of the intermediate film used there for.

The particular characteristics of the intermediate film described in the application as filed could be automatically transferred to the final absorbent material only if these characteristics would remain unchanged throughout the process of preparing the absorbent material, in other terms, if the location of the surfactant in the intermediate film is not altered by the process steps leading to the final absorbent material, such as aperturing and bonding the film to the other parts of the article.

However, it is known in the art, for example from document (1), that the surfactant initially disposed in an internal core layer of a multilayer film migrates into the outer layer, the rate of migration increasing with increasing temperature (column 6, lines 62 to 67). In order to avoid the migration of the surfactant to the outer layer the film has to be stored at room temperature or below (column 6, last line to column 7, line 6). Thus, the location of the surfactant in the intermediate film does not remain unchanged, the surfactant migrating from the core layer into the outer layer already at a temperature around room temperature. Since the film described on page 7, second full paragraph of the application as filed, is not only handled at room temperature during the preparation of the final absorbent but is even heated for aperturing and bonding it to the other elements of the absorbent article (patent application as filed, page 7, last paragraph; page 11, second full paragraph; page 12, lines 1 and 2), the surfactant located initially in the

internal layer migrates to the outer layer. Therefore, the location of the surfactant in the intermediate film is altered by the process steps leading to the final absorbent material with the consequence that the passage describing in the application as filed that the surfactant is internally compounded is not automatically applicable to the final absorbent material.

2.3 Therefore, the amendment to claim 1 intended to specify that in the final absorbent article the surfactant is not disposed in a top layer of the polymeric film cannot directly and unambiguously be derived from the passage at page 7, second full paragraph of the application as filed. The Respondent did not rely on any other part of the application as filed as support for the objected amendment and the Board on its side is not aware of an adequate support for this amendment. The amended claim 1 of the main request does, thus, not fulfil the requirements of Article 123(2) EPC.

2.4 According to the Respondent, the migration of the surfactant into the top layer described in document (1) required that the film be heated during a sufficient time at a given temperature. Such heating did, however, not occur when aperturing the film according to the patent in suit and bonding it to the other elements of the absorbent material since the exposition to heat was not sufficient during these process steps. Therefore, the location of the surfactant in the internal layer described on page 7 of the application as filed remained unchanged during the further processing steps leading to the final claimed absorbent article. There

was consequently a support in the application as filed for the amendment to claim 1 of the main request.

However, this line of argumentation is not supported by any evidence and contradicts document (1) which clearly teaches that a migration of the surfactant takes place even without substantial heating since the film has to be stored at room temperature or below to prevent migration (column 6, last line to column 7, line 4). In addition, whether a migration of the surfactant effectively takes place is irrelevant for the question of support of the amendment under Article 123(2) EPC since already the fact that such a migration can occur implies alone that the position of the surfactant in the final absorbent material cannot be directly and unambiguously derived from the passage of the application as filed disclosing the location of the surfactant in the intermediate film. The line of argumentation of the Respondent must, thus, be rejected.

- 2.5 Hence, claim 1 according to the main request does not fulfil the requirements of Article 123(2) EPC and this request must therefore be refused.

Auxiliary requests 1 to 7

3. *Amendments (Article 123(2) EPC)*

In claim 1 of the auxiliary requests 1 to 7 the expression "other than a top layer of the polymeric film" introduced in claim 1 of the main request was replaced by the expression "except a top layer of the polymeric film". As acknowledged by the Respondent, this expression is also intended to specify, but with

other terms, that there is no surfactant in a top layer of the polymeric film of the claimed absorbent material. Consequently, the negative findings and conclusions reached with regard to the support of the amendment of claim 1 of the main request apply *mutatis mutandis* to the amendment of claim 1 of the auxiliary requests 1 to 7 (see point 2 *supra*). Hence, claim 1 according to the auxiliary requests 1 to 7 does not fulfil the requirements of Article 123(2) EPC and these requests must also be refused.

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

C. Rodríguez Rodríguez

R. Freimuth