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**Datasheet for the decision
of 12 February 2009**

Case Number: T 1566/07 - 3.2.06

Application Number: 97904740.4

Publication Number: 0879041

IPC: A61F 13/15

Language of the proceedings: EN

Title of invention:

Backing web in an absorbent article

Patentee:

McNeil-PPC, Inc.

Opponent:

The Procter & Gamble Company

Headword:

-

Relevant legal provisions:

RPBA Art. 13

EPC Art. 83

Relevant legal provisions (EPC 1973):

-

Keyword:

"Late-filed requests - not admitted (Art. 13 RPBA)"

"Late filed requests - not allowable (Art. 83 EPC)"

Decisions cited:

-

Catchword:

-



Case Number: T 1566/07 - 3.2.06

D E C I S I O N
of the Technical Board of Appeal 3.2.06
of 12 February 2009

Appellant: The Procter & Gamble Company
(Opponent) One Procter & Gamble Plaza
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Representative: Boon, Graham Anthony
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Respondent: McNeil-PPC, Inc.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 17 July 2007
rejecting the opposition filed against European
patent No. 0879041 pursuant to Article 102(2)
EPC.

Composition of the Board:

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

Summary of Facts and Submissions

- I. The mention of grant of European Patent Nr. 0 879 041 in respect of European patent application Nr. 97904740.4 was published on 28 May 2003. A notice of opposition was filed on 27 February 2004 against the granted patent in which revocation of the patent on the grounds of Articles 100(a), (b) and (c) EPC was requested.
- II. By decision posted on 17 July 2007 the opposition division rejected the opposition. The opposition division based its positive finding of sufficient disclosure on the examples which were considered as giving a clear guidance for the skilled person as to the size of the apertures of the film and with respect to the claimed flexibility and strength. Moreover, a web having the defined apertures was considered as producible irrespective of whether or not the intended properties would be achieved. With regard to the point in time when recovery should be measured, the opposition division pointed to paragraph [0045] indicating that it should be measured when the tension force equalled zero. The subject-matter of claim 1 was considered to be novel and inventive when assessing these issues on the basis of the prior art disclosed in the documents
- D1 US-A-4 829 096 and
D2 EP-A-0 296 364.
- III. The appellant (opponent) filed a notice of appeal against this decision on 14 September 2007, and paid the appeal fee on the same date. In the statement of

grounds of appeal filed on 27 November 2007 the following documents were referred to:

Annex A

D2 EP-A-0 296 364

D10 US-A-3 881 489

D11 Chambers Science and Technology Dictionary, p. 288

D12 US-A-5 322 728.

- IV. With its letter of 10 June 2008 the respondent (proprietor) requested as its main request the maintenance of the patent in suit as granted and also submitted auxiliary requests 1 to 8.
- V. In a communication dated 5 August 2008, accompanying the summons to oral proceedings, the Board indicated that the subject-matter of claim 1 of the main request was not considered to be novel with regard to the disclosure in D10 (Article 54 EPC). Moreover, it was not considered clear that the examples disclosed in the patent in suit corresponded to the claimed subject-matter. Therefore, in the absence of a sufficient basis it was doubtful whether the skilled person could define and reproduce the claimed subject-matter (Article 100(b) EPC) over the whole scope of the claim.
- VI. In reply to the summons, the respondent filed with its letter of 9 January 2009 three sets of requests each including an amended main request and auxiliary requests 1 to 3.
- VII. Oral proceedings were held on 12 February 2009.

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

The respondent (patent proprietor) requested that:

1. In respect of the opposition based on Article 100(b) EPC, it be decided whether this ground of opposition had been substantiated before the opposition division such that it might form part of the proceedings before the Board of Appeal.

2. A decision be made as to whether all or some of the new objections raised by the appellant/opponent should be admitted into the proceedings, these objections being raised for the first time in the appeal proceedings and thus forming no part of the decision of the Opposition Division dated 17th July 2007.

3. The case be remitted to the Opposition Division.

4. Alternatively, that the decision under appeal be set aside and the patent be maintained on the basis of the main request, or the first, second or third auxiliary requests, or the "a" versions of the main request, or of the corresponding first, second or third auxiliary requests, alternatively the "b" versions of the main request, or of the corresponding first, second or third auxiliary requests, all as filed with the letter dated 9 January 2009.

VIII. Claim 1 according to the appellant's main request reads as follows:

"A web (20), suitable for contact with skin, comprising an apertured polymeric film characterising in that said film exhibits strength, flexibility and breathability

with resistance to water permeation and absorption, with an elasticity accommodating stretch elongation of at least 50% when subjected to a tension force in the range of 0.5 pounds per inch (8.93 kg/m) to 2.25 pounds per inch (40.18 kg/m) of film and a recovery of at least 70% from a stretch elongation of 50%, and a ratio of recovery energy to stretch energy multiplied by 100 that is greater than 25 for a 50% stretch elongation; wherein said film is produced from a solid polymeric precursor film which includes a copolymer of ethylene and a comonomer polymerized in a polymer structure using a single-site metallocene-type polymerization catalyst."

Claim 1 according to auxiliary request 1 further specifies: "and wherein the open area of the apertured film is in the range of 0.5 to 20 percent."

To claim 1 according to auxiliary request 2 it is further added:

"and wherein the average hole size expressed as an equivalent circular diameter is in the range of 0.00254 mm to 2.54 mm (0.1 to 100 mils)."

Claim 1 according to auxiliary request 3 differs from claim 1 of auxiliary request 2 in that the term "comprising" in the first line of the claim is substituted by "said web consisting of".

The second set of requests, denominated as the "a"-requests, differs from the above discussed requests in that dependent claims 3 and 4 of the above sets of claims are deleted.

In the third set of requests, denominated as the "b"-requests, claim 1 reads as follows:

"A disposable absorbent article (10) comprising:
an absorbent pad (16); and
a backing web (20) secured to the absorbent panel
wherein the backing web comprises an apertured
polymeric film characterised in that said film exhibits
strength, flexibility and breathability with resistance
to water permeation and absorption, with an elasticity
accommodating stretch elongation of at least 50% when
subjected to a tension force within the range of 0.5
pounds per inch (8,93 kg/m) to 2.5 pounds per inch
(44.65 kg/m) of film and a recovery of at least 65%
from a stretch elongation of 50%; wherein said film is
produced from a solid polymeric precursor film which
includes a copolymer of ethylene and a comonomer
polymerized in a polymer structure using a single-site
metallocene-type polymerization catalyst."

The amendments in auxiliary requests 1 to 3 of the "b"-requests are consistent with the amendments in the corresponding auxiliary requests as specified above.

IX. In support of its requests, the appellant argued essentially as follows:

The requests of the respondent filed for the first time during the oral proceedings (requests 1 to 3, above) should not be admitted. The change of the representative was not acceptable as justification for the late filing of the requests (T 830/90). The appeal was correctly based upon the opposition division's decision and there was no reason for a remittal.

The main set of requests and the set of "a"-requests should not be admitted either. Although the added feature in claim 1 relating to the ratio of recovery energy to stretch energy was supported by the disclosure as originally filed, the addition of this feature could not have been expected. This feature was only once cited in the description. Its presence in claim 10 as granted as well as in some claims as originally filed was linked to an exhaustive list of further properties of the film such that it could not reasonably have been expected that specifically this feature would be chosen when amending claim 1. The filing of these requests raised issues which could not have been expected in the light of either the previous submissions or the Board's annex to the summons. It was not possible to check the prior art with regard to this parameter within the short period of one month. Moreover the method for determination of the ratio was not specified and the skilled person could rely on any suitable method concerning appropriate tension/temperature/ time. Accordingly, it was not even clear whether comparable results would be obtained when choosing a suitable method. In line with Article 13(3) RPBA these late-filed requests should not be admitted.

Claim 1 of main request "b" did not meet the requirements of Article 83 EPC. The examples were of very specific polymer films which did not disclose the invention in a manner sufficiently clear and complete for it to be performed over the whole range claimed. The precursor film included a metallocene-type catalyzed polymer which was a copolymer of ethylene and a comonomer. All the examples showed a ratio of 80% of

such a polymer being polymerized with additionally either 20% LDPE (in 11 of the 12 examples) or 20% EVA (in the other example, no. 3). With regard to other percentages of the metallocene-type catalyzed polymer, no data were provided. Moreover, the film was disclosed in the specification as being produced by forming surfaces A to G, which were exactly described and thus the film was only disclosed as having very specific perforations obtained via these specific forming surfaces. Only films apertured in such a manner were disclosed as achieving the desired characteristics.

With regard to the claimed property of the film concerning the stretch elongation, it was not said whether it referred to the property in the cross-direction (CD) or in the machine-direction (MD) or both. Accordingly, it was not clear whether any of the exemplary films met the parametrical claimed requirements.

The film was further characterised as exhibiting strength, flexibility and breathability with resistance to water permeation and absorption. As none of these features was followed by any parametrical values, the skilled person did not know how to distinguish films with these characterising features from prior art films.

Accordingly, the examples did not form a sufficient and proper basis for enabling the skilled person to reproduce the claimed invention. Nor was any other basis disclosed. These arguments also applied for all of the auxiliary requests of the "b"-set of claims.

X. The respondent argued essentially as follows:

The grounds of appeal did not relate to the reasons given in the decision under appeal. Nor was the appeal based upon grounds substantiated within the opposition period. Although all the grounds of opposition under Articles 100(a), (b) and (c) EPC had originally been raised, they were not discussed during the first instance proceedings in relation to the present issues. The case had changed to such an extent that it would only be fair to have the opportunity to argue the case at two levels. Accordingly, in line with G 10/91 (in particular its paragraph 18), the case should be remitted back to the opposition division. Moreover, a change in representation had taken place which had led to the late-filed requests.

Although late-filed, the main set of requests and the "a"-set of requests should be admitted. The subject-matter added to the corresponding claims 1 addressed the objections set out in the notice of appeal and was added also in response to the Board's comments with regard to Article 123(2) EPC which had been made in the annex to summons. Accordingly, these requests could not have been filed earlier. The main set of requests included two independent claims which were necessary in order to have a clear and unambiguous support in the originally filed specification for the web as well as for the disposable absorbent article. The added feature concerning the ratio distinguished the claimed subject-matter clearly from the cited prior art.

The "b"-set of requests was further limited to one independent claim referring to the disposable absorbent

article. All examples which were disclosed in the specification fell within the scope of the main claim. The skilled person would easily recognize that the stretch elongation could only relate to the CD-direction since in the examples the value for the recovery after 50% stretch was only specified for the CD direction. The objection concerning the meaning of "strength, flexibility and breathability with resistance to water permeation and absorption" represented an objection under Article 84 EPC and was not relevant in the context of sufficiency. In the description relevant test methods were disclosed. No evidence had been provided by the appellant that the skilled person did not know how to obtain such a backing web including the specific film. Accordingly, the invention as claimed was sufficiently disclosed.

Reasons for the Decision

1. The appeal is admissible.
2. *Requests 1 - 3*
 - 2.1 Article 13(1) of the Rules of Procedure of the Boards of Appeal ("RPBA", OJ EPO 2007, p. 536) provides:

"Appeal proceedings shall be based on

 - (a) the notice of appeal and statement of grounds of appeal filed pursuant to Article 108 EPC;
 - (b) in cases where there is more than one party, any written reply of the other party or parties ...;

(c) any communication sent by the Board and any answer thereto filed pursuant to directions of the Board."

Article 13(2) goes on to provide, so far as is relevant:

"The ... reply shall contain a party's complete case. [It] shall set out clearly and concisely the reasons why it is requested that the decision under appeal be ... upheld, and should specify expressly all the facts, arguments and evidence relied on. ..."

2.2 The grounds of appeal in the present attacked the decision rejecting the opposition, arguing for revocation on the basis of extension of subject matter (Art. 100(c) EPC), insufficiency (Art. 100(b) EPC) and lack of novelty and inventive step (Art. 100(a) EPC). In its reply the respondent requested dismissal of the appeal or alternatively that the patent be maintained on the basis of eight alternative auxiliary requests; the reply also dealt in detail with the arguments of the appellant. In the communication sent on 5 August 2008 with the summons to oral proceedings, the Board raised various points for consideration by the parties. On 9 January 2009, and in response to the Board's communication, the respondent filed new main and first to third auxiliary requests for maintenance of the patent on an amended basis, together with detailed arguments.

2.3 Requests 1 to 3 of the respondent were filed shortly after the oral proceedings were opened. The effect of these requests is to launch a quite different attack on the appellant's appeal. The respondent seeks first to

raise the issue whether the ground of opposition under Art. 100(b) EPC had been substantiated in the proceedings before the Opposition Division. This was a wholly new point which had never been raised in the opposition proceedings. Second, the respondent argued that certain points had been raised by the appellant for the first time in the grounds of appeal and so should not be admitted. Whether or not this was so, the fact is that the respondent had already filed a detailed reply to these grounds, coupled with requests for maintenance of the patent on an amended basis. Thirdly, the respondent requested remittal, the premise of this request being the success of the first two requests.

- 2.4 It is not necessary to examine the merits of these attacks; the requests can be rejected on purely procedural grounds. The Board accepts, of course, that it has a discretion under Article 13 RPBA to allow an amendment to a party's case even at a very late stage of the appeal proceedings but the general principle is that the later such an amendment is requested, the less likely it is to be allowed. Each case of course depends on its own facts but in the present case the Board can see no good reason to allow late-filed requests of such a radical nature. It would have meant that the appellant and the Board would have had to examine the merits of two completely new issues, neither of which was straightforward and in respect of which no one apart from the respondent was prepared, and that all the preparatory work of the parties and the Board to date would potentially have been wasted. This would have been wholly unfair to the appellant. The respondent made the point that there had been a change of

representation. However this by itself will seldom be a valid reason for allowing such a change in a party's case: see T 382/97, point 5.5. In any event, the representative attending the oral proceedings, who is a partner in the same firm as the named representative, was merely attending the proceedings on the latter's behalf due to his unavailability (see the letter of 11 December 2008). The representative attending the oral proceedings had also written the detailed letter of 9 January 2009, referred to above, and so by this date at least was already well acquainted with the case.

3. *Main set of requests: main request and auxiliary requests 1 to 3; and "a"-set of requests: main request and auxiliary requests 1 to 3*
- 3.1 Amendment to the subject-matter of claim 1
- 3.1.1 Claim 1 of all these requests includes *inter alia* the feature:

"and a ratio of recovery energy to stretch energy multiplied by 100 that is greater than 25 for a 50% stretch elongation".
- 3.1.2 This feature is based upon page 35, second paragraph of the PCT-application and formed part of claim 10 as granted. No objection was raised in respect of the requirements of either Article 84 EPC or Article 123(2) EPC. In relation to examples 1 to 4, 6, 7 and 9 to 12 in Tables 1 to 3 the resultant ratio is specified.
- 3.1.3 The requests comprising such amended claims were filed one month before the oral proceedings. Accordingly, the requirements set out in Article 13 RPBA apply. In

exercising its discretion to admit such late amendments, the Board has to take into account whether the amendments raise issues which the Board or the other party could reasonably be expected to deal with without adjournment of the oral proceedings (Art. 13(3) RPBA).

3.1.4 Claim 10 as granted indeed included the feature in question but combined it with further properties of the film, relating to thickness, basis weight, elasticity, tensile strength, elongation at break, Frazier air permeability, shape of apertures, hole size and open area. The same goes for claims 4, 8, 12, 14 and 20 as originally filed. The great number of further properties linked to this feature suggest that it is only relevant in such combination. It thus could not have been expected that the feature concerning the ratio would be singled out and introduced into the subject-matter of claim 1 on its own.

3.1.5 With regard to the amended feature neither the exact method nor the means for determining the stretch elongation and recovery are specified in claim 1 or the description. Accordingly, in order to verify the claimed ratio in the available prior art films, any investigation required the assumption of a variety of test conditions, none of which are specified in the claim, most importantly the tension/temperature/time profile of such tests. Accordingly, even if the skilled person were to try to determine such values, they could not be sure of obtaining a result which reliably corresponded to or represented the claimed values, due to the large number of other variables. Thus the experiments would not simply involve the repetition of a standard test but would require the evaluation of

suitable methods and their applicability with regard to the claimed subject-matter. Such evaluation to the required degree of reliability is considered by the Board not to have been reasonably possible within the short time available.

3.1.6 The claimed ratio is very specific as it is taken at a 50% stretch elongation. A related search in the prior art would be difficult in view of the unspecified underlying constraints such as tension/temperature/time. In order to find comparable results, such parameters would have to be evaluated by usual standardized methods. This not being the case here, the skilled person would have difficulty in performing a search for relevant documents - even if more time were available.

3.1.7 Accordingly, the issue raised by this amendment could not reasonably have been dealt with in a reliable manner in the short time available. Hence, in accordance with Art. 13(3) RPBA the Board exercised its discretion not to admit these requests.

4. *"b"-set of requests - claim 1*

4.1 The characterising portion of claim 1 of these requests is amended with regard to the characterising portion of the granted claim 1 in that the tension force of the apertured film is specified to lie within the range of 0.5 pounds per inch (8.93 kg/m) to 2.5 pounds per inch (44.65 kg/m) and in that the material of the film is specified as being produced from a solid polymeric precursor film which includes a copolymer of ethylene and a comonomer polymerized in a polymer structure using a single-site metallocene-type polymerization

catalyst. The amendments are based upon page 33, line 1 to 7 of the PCT-application. No objection was raised in respect of the requirements of either Article 84 EPC or Article 123(2).

4.2 In accordance with the requirements of Article 83 EPC, the subject-matter of the invention as defined in claim 1 must be capable of being realised on the basis of the disclosure. As set out in the Case Law of the Boards of Appeal (see Chapter II.A.3), the disclosure of one way of performing an invention is only sufficient if it allows the invention to be performed over the whole range claimed rather than only in respect of some members of the claimed class. In principle, the assessment to this effect has to take into account the examples as well as the other parts of the description in the light of the skilled person's common general knowledge.

4.3 The invention is exemplified in the patent in suit by twelve different films. All these examples rely upon a specific polymeric precursor film including 80% of a single-site metallocene-catalyzed polymer. The remaining 20% are specified as being either LDPE (in 11 of the 12 examples) or EVA (in the other example). With regard to the apertures of the resultant film, these are obtained by applying a very specific process. By this process the planar precursor film is deformed using columnar water jets to apply force to the film while it is supported on specific three-dimensional forming surfaces. By this means a three-dimensional apertured film having irregularly shaped apertures as shown in all the corresponding figures (Figures 8A/B,9A/B,10A/B,11A/B, 12A/B,13) is obtained. The

tables disclose some characteristics of the precursor films and of the resultant three-dimensional films. They demonstrate *inter alia* that for such a three-dimensional apertured film a stretch force at 50% stretch of between 0.76 lb/in and 2.023 lb/in is necessary. Accordingly, on the basis of the disclosure it is this specific three-dimensional film which can be realised.

4.4 The examples rely exclusively on a process using forming structures A to G for obtaining a three-dimensional film having particularly structured apertures and particular characteristics concerning elongation/tension/recovery. No other means for obtaining such structure and characteristics are disclosed. However, the subject-matter of the claims neither includes the use of such forming structures nor refers to an apertured three-dimensional film being obtained by such forming structures. The specific characteristics of the claimed film depend on the specific forming structures applied upon the precursor films. Thus the invention claimed in claim 1 is not disclosed in a manner sufficiently clear and complete for it to be carried over its whole scope out by the skilled person. Added force is given to this conclusion having regard to the feature concerning the components of the film, as will appear from the discussion which follows.

4.5 All the examples rely on particular polymeric blends including as comonomer either butene or hexene. The description refers to further possible comonomers and specifies either styrene or ethylenically unsaturated olefins having from 3 to about 20 carbon atoms, or to

combinations thereof. In particular for styrene, or an ethylenically unsaturated olefin like eicosene, or combinations thereof, the properties of the resultant polymer are quite different from the ones of the examples. The skilled person would need further information in order to be able to maintain the elongation-tension-recovery requirements of the claimed film. Such information might set out the degree of block and branched structure of the polymer, the percentage of such material to be used and the processing conditions. No such information is available in the patent in suit.

- 4.6 Moreover, all the examples rely on a blend of 80% of a single-site metallocene-type catalyzed polymerized copolymer and 20% added polymer of either LDPE or EVA forming the precursor film. No information whatever is given about whether it would be possible to modify - and if so in which direction - the percentage of copolymer/comonomer or to add other polymers than LDPE or EVA - and if so which - and still arrive at the claimed film web.
- 4.7 Accordingly, the claimed invention is not disclosed in a manner sufficiently clear and complete for it to be carried out beyond the scope of the disclosed examples in the light of the issues concerning the percentage of the claimed copolymer and the use of added polymers, having regard to either their percentage or nature.
- 4.8 In view of these conclusions, it is not necessary to evaluate the further issues raised by the appellant concerning the relevance of MD/CD elongation and recovery, the temperature/humidity-conditioning of the

sample before the testing of the claimed properties or the meaning of strength, flexibility, breathability, resistance to water permeation and absorption in the context of the claim.

5. In summary, the requests 1 to 3 filed at the beginning of the oral proceedings are rejected; the main request and auxiliary requests 1 to 3 and the "a"-set of requests (main request MRa, and auxiliary requests 1a to 3a) are not admitted into the proceedings since they all raise issues which could not reasonably be expected to be dealt with. The "b"-set of requests (main request MRb, and auxiliary requests 1b to 3b) are not allowable under Article 83 EPC.

Order

For these reasons it is decided that:

The decision is set aside.

The patent is revoked.

The Registrar:

The Chairman:

M. Patin

P. Alting van Geusau