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**Datasheet for the decision
of 17 December 2009**

Case Number: T 0068/09 - 3.2.06

Application Number: 00954194.7

Publication Number: 1274379

IPC: A61F 13/15

Language of the proceedings: EN

Title of invention:

Thin sanitary napkin manifesting high level of stability

Patentee:

JOHNSON & JOHNSON INC., et al

Opponent:

KIMBERLY-CLARK WORLDWIDE, INC.
The Procter & Gamble Company
SCA Hygiene Products AB

Headword:

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Relevant legal provisions:

EPC Art. 83

Relevant legal provisions (EPC 1973):

-

Keyword:

"Sufficiency - no, no conditions specified for saturating a napkin, no disclosure concerning the radius of curvature of the curved holder for determining the lateral stiffness"

Decisions cited:

-

Catchword:

-



Case Number: T 0068/09 - 3.2.06

D E C I S I O N
of the Technical Board of Appeal 3.2.06
of 17 December 2009

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Decision under appeal: Decision of the Opposition Division of the European Patent Office posted 3 November 2008 revoking European Patent No. 1274379 pursuant to Article 102(1) EPC.

Composition of the Board:

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

Summary of Facts and Submissions

- I. European patent No. 1 274 379, granted on application No. 00954194.7, was revoked by the opposition division by decision announced during the oral proceedings on 24 September 2008 and posted on 3 November 2008.

Claim 1 underlying this decision (and now forming the main request) has the following wording:

"A sanitary napkin (20) adapted to be worn in the crotch portion of an undergarment, said sanitary napkin (20) comprising:

a fluid pervious cover layer (42);

an absorbent system (44) under said fluid-pervious cover layer (42), said absorbent system comprising superabsorbent material and cellulosic fibers; and

a liquid-impervious barrier layer (50) under said absorbent system (44), wherein;

said sanitary napkin (20) has a first lateral stiffness in a saturated condition; and

said sanitary napkin has a second lateral stiffness in a dry condition;

characterized in that:

said sanitary napkin (20) has a thickness less than about 5 mm;

said sanitary napkin (20) manifests an increase in thickness of at least about 2 times when saturated with liquid;

a ratio of said first lateral stiffness to said second lateral stiffness is not less than about 0.9; and

the sanitary napkin (20) further comprises flaps (38, 40) projecting laterally outward from each of two longitudinal sides (30, 32) of said sanitary napkin."

- II. The decision of the opposition division was based on the finding that with regard to the request including an amended set of claims - granted claims 6, 8, 9 and 11 deleted and granted claim 10 amended - the requirements of Article 123(2) EPC were met. However, since there was no clear and unambiguous teaching on how to construct a device for determining consistent values for the lateral stiffness, the skilled person was not in a position to know with certainty, for any given sanitary napkin, whether it fell inside or outside the scope of the claims. It followed that the request did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.
- III. On 13 January 2009 the appellant (patent proprietor) filed an appeal against this decision and simultaneously paid the appeal fee. A statement setting out the grounds of appeal was received at the European Patent Office on 12 March 2009, together with a main request, being the same as the main request before the opposition division, explanations as to how to determine the lateral stiffness and an Annex I specifying the parts of the test apparatus of Figure 7a of the patent in suit.
- IV. With a communication of 29 July 2009 annexed to the summons to oral proceedings, the Board indicated provisionally that it concurred with the findings of the opposition division and pointed further to the lack of any reference within the claim to any method for determining the thickness of the sanitary napkin as

well as to any method for determining the lateral stiffness.

V. In its letter of 17 November 2009 in reply to the summons, the appellant withdrew its request for oral proceedings and filed two auxiliary requests. Moreover it requested the deferral of any amendment of the description until final agreement had been reached on the claims. Subsequently the Board submitted a short communication to the parties indicating that during the oral proceedings the decision would have to be based on the documents submitted so far and any inconsistencies might lead to the non-admittance of the late-filed requests. The appellant announced with its letter of 14 December 2009 that it would not be represented at the oral proceedings and filed amended pages 17 to 20 of the description.

VI. Oral proceedings were held on 17 December 2009.

The appellant was not represented as announced in its last letter. Its written requests were to set aside the decision under appeal and to grant a patent on the basis of the main request, in the alternative on the basis of one of the two auxiliary requests on file.

The respondents requested dismissal of the appeal.

Claim 1 of the second auxiliary request comprises additionally to the wording of claim 1 of the main request the following features:

"... wherein the thickness is measured using a footed dial thickness gauge with a 51 (2") diameter foot and readout accurate to 0.025 mm (0.001") and, if the sanitary napkin is individually folded and wrapped, the sample is unwrapped and flattened by hand, the release paper, if present is removed and repositioned back across the positioning adhesive, if present, ensuring that the release paper lies flat, the foot of the gauge is raised and the sample is placed on the anvil such that the foot of the gauge is centred to the sample and care is taken, when lowering the foot, to avoid the foot to drop, a load of 480 Pa (0.07 p.s.i.g.) is applied to the sample and the readout is allowed to stabilise for 5 seconds, the thickness reading is then taken, and the thickness of the release paper, if present, is deducted from the total thickness, and wherein the lateral stiffness is measured using the Curved Longitudinal Bending Test described in paragraphs [0064] to [0068]."

Claim 1 of the first auxiliary request corresponds to this request, but differs in that the wording of paragraphs [0064] to [0068] is written out in full.

VII. The arguments of the appellant submitted in the written proceedings may be summarised as follows:

The patent in suit sufficiently disclosed how to measure the lateral stiffness of the claimed napkin. The apparatus illustrated in Figures 7a and 7b was explained in paragraph [0065] with regard to the dimensions of its individual parts. Even if the precise dimensions of the curved holder could not be deduced

from the patent in suit, there was no lack of sufficiency.

The claim did not impose any limitations on the absolute stiffness values, it merely put a limitation on the ratio of the two stiffnesses. No evidence had been advanced to show that, given a curved holder with the size and dimension of a female crotch, minor variations in the length or curvature would have any effect on the ratio of the lateral stiffnesses.

Both auxiliary requests specified in claim 1 how the parameters were to be measured. Moreover, the terms "dry" and "saturated" were defined in paragraph [0062] and thus were clear. It was irrelevant whether the differences between "wet" and "saturated" were clarified because the claim only referred to the saturated state. One definition for saturation was enough to meet the criteria of sufficiency.

The late-filed requests should be admitted as they were filed in reply to the objections raised in the Board's communication.

VIII. The arguments of the respondents may be summarised as follows:

The term "saturated condition" in claim 1 was not sufficiently defined in the specification to allow it to be determined by the skilled person. The data shown in Table 1 corresponded to articles which were either wet or dry. According to the description, the sanitary napkins in a wet condition can accept a further insult,

something which is excluded by the term "saturated condition".

The apparatus for performing the stiffness measurement could not be manufactured since the curvature of the holder was not indicated in the description of the patent in suit. This was an essential property of the apparatus because the curvature of the article to be tested obviously influenced the lateral stiffness of such a generally flat article. Hence, the patent in suit did not disclose the invention sufficiently clearly or completely for it to be carried out by a skilled person.

The subject-matter of claim 1 of both auxiliary requests did not overcome the above objections as the insufficiency related to the whole patent specification and the above objections could not be remedied. Therefore, the late-filed auxiliary requests should not be admitted into the proceedings.

Reasons for the Decision

1. The appeal is admissible.
2. Main Request - Sufficiency
 - 2.1 In claim 1 the determination of two parameters depends on the dry and the saturated condition of the sanitary napkin. These parameters are the thickness and the lateral stiffness of the article. Accordingly, in order to determine the claimed thickness, the increase in thickness and the ratio of lateral stiffness, a

- reliably reproducible instruction with regard to both the dry and saturated condition is necessary.
- 2.2 With regard to the status of the sanitary napkin being "saturated", the opposition division held that the skilled person would have no difficulties in saturating a napkin by adding much more liquid than could be absorbed. However, the patent discloses both "wet" and "saturated" conditions so it has to be examined what condition is actually claimed.
- 2.3 The patent in suit discloses in paragraph [0062] that the lateral stiffness is sufficient to reduce the incidence of bunching in use, particularly when the sanitary napkin is in the **wet** condition. According to paragraph [0069] the data of Table 1 are representative of typical average values for thickness and lateral stiffness. Table 1 refers to ratios of lateral stiffness and of thickness in **wet**/dry conditions. Consistently, the patent in suit discloses in paragraph [0007] that the sanitary napkin, when **wet**, is stable against the perineal area of the wearer and will resist the lateral compression by the thighs of the wearer. In the same paragraph a **wet** condition is defined as a condition when the napkin is capable of absorbing more liquid. Consistently, paragraph [0062] also refers to a procedure using 15 ml of 1% saline solution having as a result a ratio of **wet**/dry thickness.
- 2.4 The ratio of lateral stiffness is claimed for the **saturated** condition (defined specifically in paragraph [0007] as a situation where almost all of the capacity of the napkin has been used up) versus the dry condition to be not less than about 0.9 in order to

obtain stability and resistance to compression when wet (during use). Also the increase in thickness of at least about 2 times is linked to saturation with liquid.

2.5 Paragraph [0063] emphasizes that the claimed ratio concerns the lateral stiffness (after cycle 1) in the **saturated** condition versus the dry condition and should be measured using the Curved Longitudinal Bending Test which is set out in paragraphs [0064] to [0068]. Neither this test nor any other procedure in the specification of the patent in suit clearly specifies the conditions for saturating a napkin.

2.6 The appellant's view that the skilled person would apply the wetness conditions set out for the ratio of **wet**/dry thickness is firstly contradicted by the wording of paragraph [0007] and secondly not supported by any evidence. Thirdly, the procedure concerning the conditions for determining the ratio of wet/dry thickness disclosed in paragraph [0062] cannot be relied upon. Although this procedure is referred to as "saturating" the napkin with liquid, the result obtained - concerning the application of 15 ml of 1% saline solution to the napkin - is disclosed as a ratio of wet/dry thickness. Therefore, this procedure concerns a procedure for obtaining a ratio of wet/dry conditions and not of saturated/dry conditions. Therefore, there is no information available as to the saturated condition of the napkin.

2.7 Accordingly, the skilled person cannot reliably reproduce any reliable data based on the saturation of the napkin and the subject-matter of the claimed patent is not disclosed in a manner sufficiently clear and

complete for it to be carried out by a person skilled in the art. For this reason the requirements of Article 83 EPC are not met.

2.8 With regard to the determination of the ratio of lateral stiffness, the opposition division held that the patent in suit lacked sufficient detail as to how to build a device for determining the lateral stiffness with the required accuracy as there was no disclosure concerning the dimensions of the curved holder with regard to the radius of curvature and the segment length.

2.8.1 The appellant considered paragraph [0065] of the patent in suit to explain in detail the shape of the curved holder and an enlarged Figure 7a annexed to the grounds of appeal was labelled according to this interpretation.

2.8.2 However, no support is present in either the description or in Figure 7a (and 7b) of the patent in suit for such an interpretation.

The curved holder is referred to on page 8, lines 50 to 53 and no information about the radius and segment length is given. The reference to a radius of the arc of 108 mm and to a segment length of 113 mm upon which the appellant based its interpretation is related to the two curved stainless steel plates mentioned in the paragraph above the paragraph relating to the curved holder.

2.8.3 Accordingly, no data are disclosed for the radius of curvature or the segment length between the clamps of the curved holder. As was convincingly argued by the

respondent III during the oral proceedings the amount of curvature of a thin article clearly influences its lateral stiffness in a substantial manner. Therefore in the absence of the value for the curvature of the curved holder, the skilled person is not capable of constructing such a test apparatus for reproducing reliably data.

2.8.4 The appellant argued that perhaps the boundaries of the claim were slightly unclear but that this would not disable the skilled person from carrying out the invention. However, it follows from the above analysis that sufficiency is lacking both as to the exact nature of the tested sanitary napkin (wet, saturated, dry) as well as the test apparatus for determining the claimed parameters. Therefore, the present case is not comparable to a case in which there is perhaps only insufficiency at the boundaries of claimed range.

2.9 For these reasons, the skilled person is not in a position to establish with sufficient certainty, and for any given sanitary napkin, whether the napkin lies within the ambit of the claim, and therefore, the disclosure of the patent in suit is to be regarded as insufficient within the meaning of Article 83 EPC.

3. Admissibility of auxiliary requests I and II

3.1 The auxiliary requests were filed after the summons to oral proceedings. According to Article 13(1) of the Rules of Procedure of the Boards of Appeal (RPBA), it lies within the discretion of the Board to admit such a late-filed request into the proceedings. In this respect, the request should be clearly allowable, e.g.

these claims should not include the same deficiencies as raised against the claims of the main request. In the present case this condition is not fulfilled, for the following reasons.

- 3.2 As set out above for the main request, the patent specification does not include sufficient information for a clear distinction to be drawn between a wet and saturated sanitary napkin. Moreover, despite that the fact that auxiliary requests I and II include in their main claim additional features concerning the Curved Longitudinal Bending Test they do not include further detail about the dimensions of the curved holder for the Test Set-up. Therefore, the objections leading to the main request not being allowed apply for both auxiliary requests as well. The amendments to the description proposed by the appellant are also not suitable to overcome this objection. Accordingly, the auxiliary requests I and II are not clearly allowable and therefore not admitted into the proceedings.
- 3.3 The appellant's request for admission of these requests was based on the view that they were filed in reply to an objection raised in the Board's communication. The objection raised by the Board concerned the lack of a determination method in the claims. It is correct that the appellant tried to overcome this objection. However, since the objection leading to the decision of the opposition division concerning the dimensions of the curved holder is not overcome by any of the requests, for this reason alone there is no reason for a different outcome in respect of the late-filed auxiliary requests. Under these circumstances no decision needs to be reached regarding the further

objections raised by the respondents concerning
Article 123(2) EPC regarding these requests.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar

The Chairman

M. Patin

P. Alting van Geusau