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**Datasheet for the decision  
of 10 December 2010**

**Case Number:** T 1435/09 - 3.2.06

**Application Number:** 00113812.2

**Publication Number:** 1066811

**IPC:** A61F 13/514

**Language of the proceedings:** EN

**Title of invention:**  
Absorbent article

**Patentee:**  
KAO CORPORATION

**Opponent:**  
KIMBERLEY-CLARK WORLDWIDE, INC.

**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 100(c), 123(2)

**Relevant legal provisions (EPC 1973):**  
-

**Keyword:**  
"Amendment - intermediate generalisation of one example"

**Decisions cited:**  
T 0457/98, T 1063/07, T 0425/98, T 0997/06

**Catchword:**  
-



Case Number: T 1435/09 - 3.2.06

**DECISION**  
of the Technical Board of Appeal 3.2.06  
of 10 December 2010

**Appellant:** KIMBERLY-CLARK WORLDWIDE, INC.  
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**Respondent:** KAO CORPORATION  
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**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
21 April 2009 concerning maintenance of  
European patent No. 1066811 in amended form.

**Composition of the Board:**

**Chairman:** K. Garnett  
**Members:** G. de Crignis  
G. Kadner

## Summary of Facts and Submissions

- I. European Patent No. 1 066 811, granted on application No. 00 113 812.2, was maintained in amended form by decision of the opposition division posted on 21 April 2009.

Claim 1 as upheld by the opposition division reads:

"An absorbent article having a liquid permeable topsheet, a liquid impermeable back sheet, and a liquid retentive absorbent member interposed between the topsheet and the backsheet, the topsheet and the backsheet being joined by sealing to form a sealed part, wherein said backsheet has a tear strength of 120 to 500 cN, wherein said backsheet has an elongation of 3 to 35% under a load of 200 gf/10 mm, and wherein further said backsheet is made of polyolefin having a molecular weight distribution of 1.5 to 4 obtained by using a metallocene catalyst."

- II. On 30 June 2009 the appellant (opponent) 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 26 August 2009. The appellant requested that the decision of the opposition division be set aside and the patent be revoked. It was argued that the granted and the maintained version of claim 1 included an amendment which included subject matter which extended beyond the application as filed (Articles 100 (c) and 123(2) EPC), in that the application as filed did not disclose that the backsheet was made of polyolefin having a molecular weight distribution of 1.5 to 4

obtained by using a metallocene catalyst. The only disclosure of a backsheet made of polyolefin resin concerned a particular type of polyolefin, having a particular molecular weight distribution and obtained using a metallocene catalyst. Furthermore, claim 1 included features concerning parameters for the tear strength and the elongation but without indicating how to determine such parameters reliably and reproducibly. Additionally, inventive step of claim 1 was objected to having regard to:

D2 US-A-5 376 439; and

D3 US-A-5 843 267.

III. With a communication dated 6 August 2010, annexed to the summons to oral proceedings, the Board indicated that the disclosure in the originally filed application of the subject-matter of claim 1 needed further discussion and pointed also to the lack of specific methods in claim 1 for determining the claimed parameters. Moreover, with regard to inventive step, it was indicated that the problem to be solved had to be specified.

IV. Oral proceedings were held on 10 December 2010. The appellant requested that the decision under appeal be set aside and that the patent be revoked. The respondent requested that the patent be maintained on the basis of the main request filed during the oral proceedings or on the basis of a first or second auxiliary request, corresponding to the seventh and eighth auxiliary requests filed with letter of 10 November 2010, respectively.

Claim 1 of the main request differs from claim 1 as upheld by the opposition division in that the elongation of the backsheet is limited to the range of from 3 to 20%, the molecular weight distribution is specified as a  $M_w/M_n$  ratio, and additionally the subject-matter of claim 5 as originally filed (corresponding to the subject-matter of claim 4 as granted) is included.

Claim 1 of the first auxiliary request differs from claim 1 of the main request in that the test method for determining the tear strength is specified to be in accordance with a named standard (JIS K 7128) and the test method for determining the elongation is stated to be in accordance with the test method disclosed on page 4, second paragraph, of the originally filed description.

Claim 1 of the second auxiliary request differs from claim 1 of the first auxiliary request in that the polyolefin is specified as polyolefin resin.

- V. During the oral proceedings, and in relation to claim 1 of the main request, the parties addressed the Board on the issue of whether this request complied with Article 83 EPC having regard to the fact that there was no reference in the claim to any test methods for determining the stated parameters. After interrupting the proceedings for deliberation, the Board gave its opinion that it did not so comply. For the reasons which are given later in this decision, however, the Board was subsequently satisfied that in fact none of the requests of the respondent was allowable (including the main request) for reasons of non-compliance with

Articles 100(c)/123(2) EPC. Since, as will be seen, this latter objection forms the *ratio decidendi* of this decision, it is only necessary to recite the arguments of the parties on this issue.

- VI. The argument of the appellant (opponent) on this issue may be summarised as follows:

The subject-matter of claim 1 of all the requests was not disclosed in the application as originally filed insofar as the now-claimed combination of features is concerned. The originally filed application did not disclose that the backsheet was made of polyolefin having a molecular weight distribution  $M_w/M_n$  of 1.5 to 4 obtained by using a metallocene catalyst, but disclosed with regard to a backsheet made of such a polyolefin only one example, Example 1, which was not a general teaching of a backsheet. There was no disclosure in the originally filed application which linked the claimed parameter ranges to such an example. Hence, the requirements of Article 123(2) EPC were not met.

- VII. The argument of the respondent (patent proprietor) on this issue may be summarised as follows:

The subject-matter of claim 1 of all the requests was limited to a pure polyolefin-type backsheet obtained by using a metallocene catalyst such as disclosed in Example 1. All other characteristics generally disclosed for the claimed backsheet applied for this exemplified backsheet as well. Hence, the requirements of Article 123(2) EPC were met. Moreover, the replacement of the term "comprising of" by the term "consisting of" resulted in a limitation of the scope

of the claim and was acceptable in accordance with the jurisprudence of the boards of appeal.

### **Reasons for the Decision**

1. The appeal is admissible.
2. *Interpretation of claim 1*
  - 2.1 The wording "said backsheet is made of polyolefin ..." has to be read as "said backsheet is made of **a** polyolefin ...". Such an interpretation was accepted by the parties and is based upon claim 4 as originally filed, from which this wording originates. (Indeed, the proprietor was prepared to make a corresponding amendment to the requests if this was thought necessary.) Hence, only a backsheet containing one kind of polyolefin is to be considered as falling within the scope of the claim.
  - 2.2 Additionally, it has to be taken into account that such a backsheet could be provided in the form of either single- or multi-layered plastic film, laminates and nonwovens. This is apparent from the embodiment claimed in claim 2 (originally filed claim 6 and granted claim 5) which specifies a backsheet consisting of a *single* layer film material. It is also apparent from paragraph [0020] of the description, which specifies that a single-layered film is a preferred embodiment but that the backsheet may also "be laminated with nonwoven fabric, etc. for the purpose of improving the texture, and the like". Consequently, the subject-matter of claim 1 includes various forms of backsheet

although in all the disclosed examples single-layered blown films form the backsheet.

3. *Main request: amendments - Articles 100(c) and 123(2) EPC*

3.1 Claim 1 as granted was amended with regard to claim 1 as originally filed *inter alia* by the addition of the feature that the "backsheet is made of polyolefin obtained by using a metallocene catalyst". This feature was disclosed in originally filed claims 3 and 4 for a resin having a molecular weight distribution  $M_w/M_n$  of 1.5 to 4 in a proportion of 5 to 90% by weight based on the total resin.

3.2 Claim 1 of the present requests has been further amended with regard to this feature in that it now additionally specifies that the polyolefin is one "having a molecular weight distribution  $M_w/M_n$  of 1.5 to 4". This amendment originates from originally filed claims 3 and 4 and from page 4, line 18 to page 5, line 1, of the originally filed description.

3.3 Consistent with these references, the paragraph on page 5, lines 2 to 10, of the originally filed application concerns such a preferred embodiment wherein the resin having the claimed molecular weight distribution  $M_w/M_n$  is used in combination with other resins which are different in molecular weight distribution, and discloses the percentage of such resins in relation to other resins.

3.4 Accordingly, these passages in the description and the claims of the originally filed application disclose a



preferred embodiment of a backsheet comprising a resin composition containing a resin having the claimed molecular weight distribution  $M_w/M_n$ . However, they do not refer to a backsheet which is made (only) of polyolefin obtained by using a metallocene catalyst.

- 3.5 The respondent relied on Example 1 for disclosure of this feature. This example is based upon a commercially available polyolefin resin prepared by using a metallocene catalyst (having the trade name Evolve SP2040™, which is a particular LLDPE-resin) and is then further processed by extruding the resin under specific conditions and by blow moulding a film of a thickness of 0.03 mm. For this example, Table 1 and the corresponding description disclose that the resin pellets and the blown film have a  $M_w/M_n$  ratio of 2.1, and that the single-layered blown film used as a backsheet has a tear strength of 357cN and an elongation in MD of 11.6%.
- 3.6 Hence, this example 1 represents an embodiment which is different from the embodiment referred to on page 4, lines 18 - page 5, line 10 with its ranges for the ratio of  $M_w/M_n$ , tear strength and elongation.
- 3.7 It was not disputed that Example 1 is based on a polyolefin resin (Evolve SP2040™) which has a molecular weight distribution  $M_w/M_n$  within the claimed range and which is obtained by using a metallocene catalyst. However, in order to obtain the disclosed values for tear strength and elongation, specific treatments of this resin are disclosed, for example the extrusion of the resin under defined conditions and to form a single-layered blown film having a particular thickness

- and basis weight. Example 1 thus shows such a single-layered backsheet of a blown film.
- 3.8 Hence, Example 1 is a particular disclosure which cannot be generalized to a claim for a backsheet which, independent of the manner of extrusion of the resin and further manufacturing details, has the claimed ranges of the claimed characteristics.
- 3.9 Accordingly, there is no clear and unambiguous disclosure of an absorbent article having a backsheet with the claimed ranges of tear strength and elongation in relation to backsheets being made (only) of polyolefin having a molecular weight distribution  $M_w/M_n$  of 1.5 to 4 obtained by using a metallocene catalyst.
- 3.10 Therefore, the subject-matter of claim 1 is not originally disclosed in such a combination and is an intermediate generalization of Example 1. Hence it contravenes Article 123(2) EPC.
- 3.11 There was some discussion, both in the written part of the proceedings and during the oral proceedings, as to whether it is allowable under Article 100(c)/123(2) EPC to restrict a claim by changing the term "comprising" to "consisting of". Both sides cited decisions of the Boards of Appeal for and against such a proposition (namely T 457/98, T 2017/07, T 1063/07, T 0425/98 and T 0997/06, none of them published in OJ EPO). Quite apart from the fact that each decision must turn upon the particular facts of the case, it is not necessary for the Board to go into this question. This is because the Board can accept, in the respondent's favour, that in this case there was a clear and unambiguous

disclosure of a backsheet consisting (only) of a polyolefin in accordance with Example 1. The question, however, is whether there was a clear and unambiguous disclosure of backsheet consisting (only) of a polyolefin in accordance with claim 1. For the reasons given above, the Board concludes that there was not.

4. *Auxiliary requests*

4.1 The further amendments to claim 1 (inclusion of the test methods concerning tear strength and elongation of the backsheet and the specification of the polyolefin as a polyolefin resin) in auxiliary requests 1 and 2 do not have the effect of getting round the above finding, since the feature concerning "the backsheet is made of polyolefin ..." is also present in claim 1 of the auxiliary requests.

5. *Conclusion*

5.1 Having regard to Article 123(2) EPC, none of the requests is allowable.

**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

K. Garnett